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PRACTICE BEFORE THE COMPTROLLER OF PATENTS

BY

CARROL ROMER, M.A.

SCHOLAR CAIUS COLLEGE, CAMB., MECH. SCI. TRIPOS
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PREFACE.

THE Comptroller-General of Patents' report for the year 1910 shews that in the year 1909-1910 there were 30,603 applications for patents, and 2,829 applications for patents under the International Convention. In the same year there were 1,005 hearings to meet Office objections to acceptance; and also 4,511 hearings in opposition, revocation, amendment, and other cases fixed, of which 2,320 were heard.

It is apparent, therefore, that there is a very large practice at the Patent Office and before the Comptroller. Information on the details of and precedents for this practice have had hitherto to be sought in official documents and works treating generally of patent law, which latter are to a great extent necessarily occupied with the action for Infringement and other actions in the High Court.

It was therefore thought that a book which dealt in detail and completely with this practice only would be useful. This book is written with the object of fulfilling this want, and it is intended in it to treat of Patent Office practice exclusively and in greater detail than has before been done. To this end all the reported cases which have come before the Comptroller or Law Officer since 1883 are discussed in the following pages, save a small number which were found to be entirely unimportant. Before that date the cases are not discussed so completely, for the practice was not then the same. There will also be found quoted herein some unreported cases, in particular on the subjects of "Revocation" and "Restoration,"

which by permission of the Comptroller I have been allowed to consult. As an appendix are printed the Acts and Rules regulating Patent Office procedure and the forms to be used on applications thereto.*

A book of this description is necessarily a law book, containing references to Statutes and decided cases; but it is hoped that this book will be found useful by patentees, and others who desire information on the law of letters patent, as well as by the legal profession.

In conclusion, I wish to express my thanks to the Comptroller for his courtesy in allowing me to see some of his unreported decisions; and to Mr. E. Russell Clarke for his valuable assistance and advice.

CARROL ROMER.

11, KING'S BENCH WALK,
TEMPLE.

September, 1911.

* The Reports of Patent Cases have been consulted up to the issue of the 20th September, 1911.

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PRACTICE BEFORE THE COMPTROLLER OF PATENTS.

CHAPTER I.

INTRODUCTION.

MODERN legislation has placed the administration of Letters Patent in the hands of the Comptroller-General of Patents and Designs, and has established the Patent Office. Besides administrative functions, the Comptroller has also been given certain judicial powers enabling him to deal with matters arising out of his administration and cognate with it.

It is the object of this book to give a statement of the law and practice which obtain in questions which may come before the Comptroller and, on appeal from him, before the Law Officer. General questions of patent law, such as the validity of a patent when granted, which arise in Infringement and other actions in the High Court, are not considered herein; for all such matters reference may be made to the many larger and excellent treatises which have been written on this branch of the law. But all the information which is needed on applying for, amending, and restoring a patent; or registering documents in connection with a patent; or opposing other patents or amendments; or revoking other patents under ss. 26 & 27, will be found herein; also, there will be found all the rules and details of the Patent Office procedure and practice.

The jurisdiction of the Comptroller is purely statutory.

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The Patents and Designs Act of 1907, upon which the Law of Letters Patent depends, and upon which the jurisdiction of the Comptroller depends, is in the main a consolidation Act, and it effects little alteration of the pre-existing practice before the Comptroller, but it adds to his powers and duties in several important respects; the alterations and additions to the law made by it are indicated by an asterisk printed against the various sections new to the Act of 1907, which is printed as an appendix to this book. In addition to this Act of Parliament, the practice at the Patent Office is regulated by the Statutory Rules of 1908, which, with their accompanying forms, are also to be found in the appendix, and which are made, as directed by the Statute, by the Board of Trade. Further, the law has been interpreted to the Comptroller by the decisions of the Law Officer, as from time to time delivered, upon appeals from the Comptroller or by directions given in special cases submitted by the Comptroller to the Law Officer (under s. 74).

The main occasions upon which the Comptroller has to exert his judicial powers are:—

- A. On application for a grant.
- B. On opposition by some person to an application for a grant.
- C. On application to amend an accepted specification.
- D. On application to revoke a patent already granted.
- E. On application to restore a lapsed patent.
- F. On application to register a matter in the Register of Patents.

These matters will be considered in detail in the chapters which follow, to which have been added a chapter of miscellaneous matters concerning patents and affecting the Patent Office, and a chapter on the general procedure before the Comptroller and on appeals from him to the Law Officer. Where the appeal from the Comptroller lies to the Court the practice on appeal is not fully dealt with, but the principles on which the Court will act in deciding such appeals, being the same as those applicable to the Comptroller's decisions,

will be found herein. The discussion of the scope of disclaimers and references to prior invention, their necessity and admissibility, enters so much into all the above headings that a separate chapter has been devoted to them.

The customary abbreviations for the references to the Law Reports are used; in particular it may be mentioned that—

R. P. C. refers to the Reports of Patent Cases.

Gr. P. C. refers to Griffin's Patent Cases.

Gr. A. P. C. refers to Griffin's Additional Patent Cases.

26 R. P. C. 1909 } refer to the notes of Rulings of the
27 R. P. C. 1910 } Comptroller issued with the Reports..
28 R. P. C. 1911 }

Where a section or a rule is quoted without reference to an Act or Rules, the Patents and Designs Act of 1907 and Patent Rules of 1908 are to be understood respectively (see appendix). The date of a case quoted can be arrived at by remembering that the numbers of the volumes of the Patent Reports refer to consecutive years, and that 28 R. P. C. is the report for the year 1911. Gr. P. C. contains cases decided for the years 1884, 1885, and 1886; Gr. A. P. C. for the year 1887.

Though the practice at the Patent Office has not changed to any great extent for some years, it is well to remember that the older cases, particularly Gr. P. C. and Gr. A. P. C., which are herein quoted side by side with more recent cases, do not carry much weight when they conflict with modern needs and dicta; their authority is in comparison secondary.

CHAPTER II.

INITIAL STEPS ON APPLICATION.

WHO MAY BE A PATENTEE.

ANYBODY whether a British subject or not (*a*) may apply for a patent, provided that he is the true and first inventor, or applies jointly with the true and first inventor (s. 1), or has received the invention from abroad.

If a person has made an application for a patent in any of the foreign states or countries mentioned on page 32 he may apply to obtain priority for the date of his patent, so as to give it the same date as his patent abroad (s. 91).

Two or more persons may make a joint application for a patent, and the patent may be granted to them jointly. The persons are then treated as joint tenants (s. 37) and may use the invention independently, though they may not grant licences independently; if an applicant dies his personal representatives hold in his stead.

The true and first inventor must be a party to the application unless the application is made by one who has imported the invention from abroad, or is in possession of a foreign patent for which he is applying for protection under s. 91 as above.

Companies, firms, and partnerships may apply as joint applicants with the true and first inventor, but not as sole applicants in an ordinary application. But if the patent has been communicated to a company, etc., from abroad, or the

(*a*) *Beard v. Egerton* (1846), 2 Car. & K. 667; 3 C. B. 97; *Chappell & Purday* (1845), 14 M. & W. 310.

company is applying, as entitled to the benefit of a foreign patent, under the Convention (s. 91), the company may apply either as sole or joint applicant. In any case a company must apply under its seal.

If an inventor dies without making an application his legal representative may apply for a patent for his invention.

No person may apply as of right for the protection of letters patent.

The Comptroller does not inquire into the age, sanity or coverture of the applicant. As regards proceedings before him, any person may be a patentee. Though there are certain persons who cannot be patentees; *e.g.* an official may not be a patentee in matters relating to his official position, and (possibly) an infant may not be a patentee; the Comptroller is not concerned with any disability of the applicant. If the application is in the proper form he will inquire no further; nor can opponents set up the disability of the patentee in opposition, for they are confined to certain specified grounds of opposition in which the disability of the applicant is not included. The disability of companies, firms, partnerships, and corporations arises from the necessity that the application should be in the proper form; such bodies cannot "invent," and therefore cannot sign Form 1; consequently an application by such a body alone is not in order on the face of it, and the Comptroller will not allow it. It is different in the case of applications by such bodies alone for inventions communicated from abroad or under the Convention, for the necessary forms in these cases may be properly signed by them (b).

WHAT IS PATENTABLE (*see also* p. 22).

The *subject-matter* for which a patent will be granted must be "a manner of manufacture" within the meaning of sect. 93 of the Act of 1907 and of the Statute of

(b) *Carez' Appn.*, 6 R. P. C. 552.

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Monopolies. For example, a composer's or author's rights are protected by copyright and not by patent. A patent cannot be granted for a *discovery* as distinct from an *invention*; that is to say, to be patentable a discovery must be given a concrete form. A patent cannot be granted for a new principle or law of nature, nor can a patent be granted for a mere idea or process which is not given any concrete character, nor for mere schemes and devices, as for a new plan of arranging business cards. The idea to be patentable must suggest an act to be done and must be an act which results in a new product, or in a new result or in a new process, or in a new combination for producing an old product or an old result (c). Thus when Volta discovered the effect of an electric current on a frog's leg he made a great discovery but had no patentable invention. If a man discovers a new advantage of a machine he has no patentable invention; but if he has discovered how to use the old machine to obtain the advantage, he has a patentable invention. There may be patents for improvements of old things or combinations of old things, and the smallest quantity of invention is sufficient to be patentable. Processes for producing products are patentable and the products themselves can be claimed, though it seems that a product cannot be claimed in a specification *by itself*. Further, a patent cannot be granted for an invention unobjectionable in other respects but the use of which is contrary to law or morality (s. 75). Thus a roulette table would not be subject-matter for a patent. And a patent can only be granted for *one* invention (s. 14 (2)). Because matters are applied to or are parts of any particular apparatus they do not necessarily constitute one invention (Rule 13 (1)).

To summarise, as regards proceedings before the Comptroller, a specification may claim the invention of a *method of manufacture*; a *process*; an *improvement* in or a *combination* of old manufactures; or a *product*, so long as only

(c) *Reynolds v. Herbert Smith & Jandus Arc Lamp v. Arc Lamp Co. Co., Ltd.* (1902), 20 R. P. C. 123, 410; (1905), 22 R. C. P. 277.

one invention is claimed and that invention is not contrary to law or morality.

It is difficult to give any further concise statement of subject-matter for the purpose of applications to or proceedings before the Comptroller. To consider what constitutes subject-matter for a patent in the eyes of the law in detail is to give an exposition of almost the whole of the law relevant to Letters Patent. It will be found from the following pages and from the cases cited therein that the Comptroller will not consider on application any *question* of subject-matter; but where there can be no real argument, and it is plain that there is no subject-matter in what is put before him, he will refuse to grant a patent. In oppositions to applications and other proceedings, as for revocation or restoration, which come before him, his jurisdiction to consider subject-matter is no further enlarged, for none of the grounds for opposition (*q.v.*), revocation, or restoration are concerned with subject-matter. Subject-matter in detail is therefore beyond the scope of this book; it is only concerned with subject-matter as it will be considered by the Comptroller—that is to say, only concerned with the broad definition of what may be subject-matter of Letters Patent.

MANNER OF APPLYING.

The manner of making applications for patents, the documents to accompany the applications, the forms to be used, and the fees to be paid, are as follows :—

All communications with the Patent Office must be made in English, and applicants must apply in their real name and not under assumed or trade names. Applications for patents should be left (s. 1 (2)) at the Patent Office by hand, or sent by post addressed to The Comptroller, The Patent Office, 25, Southampton Buildings, London, W.C. Every applicant, opponent, or patentee must give an address for service in the United Kingdom (Rule 8). Applicants must use the appropriate stamped forms (Rule 10), as fees cannot be paid by cheque or money order or in cash. An application by the

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legal representative of a deceased inventor (s. 43) is made in accordance with Rule 11. The applications will be numbered in the order of receipt (Rule 12).

The application must be made clear to the Comptroller by drawings if he desires them, and, if the invention be chemical, by samples (s. 2). But no models are required.

The forms and fees relating to patents are to be found in Schedule 2 of the Rules (*see* p. 228, Rules 4 & 5).

Stamped forms can be obtained on *personal* application at the Inland Revenue Office (Room 32), The Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., or, at a few days' notice and upon prepayment of the value of the stamp, at any Money Order Office in the United Kingdom.

Patent Forms Nos. 1, 1A, 3, and 10 *already stamped* and 2 are *usually kept on sale* at the undermentioned Post Offices:—

The London Chief Office.

Eastern District Office, 206, Whitechapel Road, E.

South Eastern District, 239, Borough High Street.

Charing Cross Branch Office, W.C.

Lombard Street Branch Office, E.C.

North Western District Office, 28, Eversholt Street, Camden Town, N.W.

Post Office, 44, Parliament Street, S.W.

and the chief Post Office of the undermentioned cities and towns:—

IN ENGLAND AND WALES.

Accrington.
Altrincham.
Ashton-under-Lyne.
Bacup.
Barnsley.
Bath.
Bedford.
Birkenhead.
Birmingham.

Blackburn.
Bolton.
Bournemouth.
Bradford.
Brighton.
Bristol.
Burnley.
Burslem.
Bury.

Cambridge.
Cardiff.
Carlisle.
Chatham.
Cheltenham.
Chester.
Coventry.
Croydon.
Darwen.

Derby.	Lincoln.	Scarborough.
Devizes.	Liverpool.	Sheffield.
Dewsbury.	Macclesfield.	Southampton.
Doncaster.	Manchester.	Stafford.
Dorchester.	Middlesbrough.	Stalybridge.
Driffild.	Newcastle.	Stockport.
Droitwich.	Newport (Mon.).	Stockton-on-Tees.
Dudley.	Northallerton.	Stoke-on-Trent.
Durham.	Northampton.	Stourbridge.
Exeter.	Norwich.	Stroud.
Gloucester.	Nottingham.	Sunderland.
Goole.	Nuneaton.	Swansea.
Greenwich.	Oldbury.	Tamworth.
Halifax.	Oldham.	Truro.
Hanley.	Plymouth.	Tunstall.
Hartlepool.	Pontypriid.	Wakefield.
Huddersfield.	Portsmouth.	Walsall.
Hull.	Preston.	Warrington.
Ipswich.	Reading.	West Bromwich.
Keighley.	Redditch.	Widnes.
Kidderminster.	Rochdale.	Wigan.
Leamington.	Rotherham.	Wolverhampton.
Leeds.	Rugby.	Woolwich.
Leicester.	Salford.	Worcester.
Lichfield.	St. Helens.	York.

IN SCOTLAND.

Aberdeen.	Glasgow.	Leith.
Dundee.	Greenock.	Perth.
Edinburgh.	Inverness.	

IN IRELAND.

Belfast.	Galway.	Waterford.
Dublin.	Limerick.	Wexford.

If it should not be convenient to apply in either of the ways above specified, the stamped forms can be ordered by post from the Controller of Stamps (Room 5), Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a money or postal order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the form in a registered envelope by post, must be forwarded to

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Somerset House with the application for the form. Cheques will not be accepted.

Documents required on Application.—The application must be made on one of the seven following forms; the forms must bear the prescribed stamp fees:—

Patents Form No. 1. —For ordinary applications.

- | | | |
|---|---|---|
| " | " | 1A.—For applications for Patents for inventions communicated from abroad to some one in the United Kingdom. |
| " | " | 1B.—For applications under the International and Colonial Arrangements. |
| " | " | 1C.—For applications for Patents of Addition. |
| " | " | 1C*—For applications for Patents of Addition under the International and Colonial Arrangements. |
| " | " | 1C**—For applications for Patents of Addition communicated from abroad. |
| " | " | 1D.—For applications for Secret Patents under Section 30. |

The application must be accompanied by the provisional or complete specification. Skeleton forms of a convenient character will be found on p. 299, but these forms may be varied as long as they keep within the statutory form (p. 244). The application form must declare that the applicant is the true and first inventor of an invention of which he is in possession and for which he desires to be granted a patent; but in the case of a joint application the application form need only declare that one of the applicants is the inventor. The application is made either directly by the patentee or through an agent authorised to the satisfaction of the Comptroller, who is resident or has his place of business in the United Kingdom. The application must be signed by the applicant, and, unless an agent is employed, his address for service in the United Kingdom must be given.

Thus, in an ordinary case an application for a patent may be made in either of two ways:—

- (1) The applicant may apply in the first instance with a provisional specification, using Patents Form No. 1 (stamped £1), accompanied by two Patents Forms

No. 2 (unstamped); and may leave his complete specification (stamped £3) at any later period within six months, or, with application for extension of time on Patents Form No. 6 (stamped £2), within seven months.

- (2) The applicant may leave his complete specification at the time of making his application, using Patents Form No. 1 (stamped £1), accompanied by two Patents Form No. 3 (one copy stamped £3 and one unstamped).

Communication from Abroad.—The importer of an invention is treated in all respects as the actual applicant. Form 1A is to be used.

Convention Applications (see p. 32).—A foreign patentee who applies to have a British patent dated as of the date of his foreign patent, under sect. 91, must make his British application within twelve months from the date of his first foreign or colonial application. His application on Form 1B must be accompanied by a complete specification. The application must be in the name of and signed by (Rule 9) the person or persons by whom the first foreign or colonial application is made, and should be accompanied in addition by copies of the specification and by the drawings or documents filed previously in the foreign patent office (Rule 15). These latter documents should be duly certified as being such copies. If the specification be in a foreign language it should be accompanied by a translation verified to the satisfaction of the Comptroller by declaration or otherwise. The declaration accompanying the application must declare that a foreign application has been made, and must specify the countries in which applications have been made and the dates thereof.

The complete specification if not accepted within twelve months shall be open to public inspection (Rule 17). The date of the patent so granted (Rules 18 and 83) shall be the date of the foreign application, and the payment of renewal fee and the expiry of the patent shall be reckoned from that date (Rule 83).

Save as above, the procedure of a Convention application should be the same as of ordinary applications.

Patent of Addition (see p. 35).—An improvement or modification of a patentee's or applicant's invention may be protected by a "patent of addition." An application for a patent of addition is made on Form 1c, 1c*, or 1c** (p. 240). If a patent of addition is granted it will be granted for the unexpired term of the original patent, and no renewal fees are payable on such patent of addition (s. 19). A patent of addition should be where possible in Form B, given in Schedule 3, Rule 50 (see p. 280). A patent of addition will be granted for an improvement or modification of the original invention, but the subject-matter of a patent of addition must be an invention and a manufacture, for a patent can only be granted for an invention and a manufacture (Stat. of Monop. 36). The general purpose of the patent of addition must be the same as that of the original patent. The Comptroller's decision that there is a proper subject-matter for a patent of addition is final, and the matter therefore lies entirely within his discretion (s. 19, sub-s. 4). The patent of addition remains in force as long as, and no longer than, the original patent; hence it may be bad policy to adopt this machinery, though it is economical, for should the main patent be revoked or lost so will the patent of addition. Whether the main patent is "in force" if declared invalid by the Court has not been decided; presumably it is.

Cognate Inventions.—When several specifications for cognate inventions, or inventions which are modifications of the same thing, and concurrent provisional protection for them has been obtained, a complete specification may be put in in respect of all such applications. If the whole of the inventions constitute a single invention a single patent may be obtained thereon (s. 16). The test whether the patents are cognate will be that of "one general object." Before taking out such a combination patent for cognate inventions it should be remembered that, as the invalidity of one portion of a patent renders the whole patent invalid, the patentee will be in the

position of having put all his eggs in one basket by this procedure.

Revoked Patent.—Where a patent is revoked on the ground of fraud on the true inventor's rights, the Comptroller may grant a patent to the first and true inventor in lieu of the patent so revoked (s. 15). The patent so granted bears the date of the fraudulent application, so protecting the true inventor against anticipation in the interval. He cannot, however, recover for infringements committed before the actual grant to him. There are no special rules for applications hereunder.

REGULATIONS FOR DOCUMENTS AND DRAWINGS.

The Office rules and regulations regarding the form of and times for leaving the various necessary documents are given hereunder. They are taken, with a few additions and corrections, from the "Instructions to Applicants" issued by the Patent Office.

The Specifications and all other documents, except drawings (Rule 6), must be written or printed in large and legible characters with deep permanent ink on one side only of sheets of strong white paper measuring approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand side thereof; and the signatures of the applicants or agents must be written in ink in a large and legible hand, and the several sheets should be fastened together at the top left-hand corner. At the top of the first page of a specification a space of about 2 inches should be left blank. The work of the Office is facilitated when specifications are printed or typewritten.

Provisional Specification.—The provisional specification must contain the full name, address, and calling of each applicant, and commence with the title (s. 2 (4)) of the invention, all of which must be identical with those given on the application form.

It must be begun on Patents Form No. 2, and continued if necessary on foolscap paper. It must fairly describe the

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nature of the invention (s. 2 (1)) and be accompanied by drawings if required. The applicant should in this document give a clear description of the invention, but he need not enter into minute details as to the manner in which the invention is to be carried into effect, and no claims are necessary (s. 2 (4)). The specification must be dated at the end, and signed by each applicant or by the authorized agents. The duplicate must be an exact copy.

Unless a complete specification (stamped £3) is left within 6 months, or with extension of time, 7 months (Patents Form No. 6) from the date of application, an application for a patent is deemed to be abandoned.

Complete Specification.—The complete specification must contain the full name, address, and calling of each applicant, and commence with the title of the invention (s. 2 (4)), all of which must be identical with those given on the application form, and, if a provisional specification has been filed, with those on Patents Form No. 2.

The complete specification must be begun upon Patents Form No. 3 (stamped £3), and continued, if necessary, on foolscap paper. The duplicate must be an exact copy, but unstamped. The specification should contain a full and detailed description of the invention (s. 2 (2)), of such a nature that the invention could be carried into practical effect by a competent workman from the directions of the document alone. The specification must be accompanied by drawings if required (s. 2 (3)).

A complete specification left after a provisional specification should refer to the number and date of the provisional specification, should contain a full and detailed description of the invention, independent of the description given in the provisional specification, and should be confined to substantially the same invention as described in the provisional specification, and must be left within six months of the date of application (s. 4; Rule 27), though an extension of time of one month may be granted.

It is necessary at the end (s. 2 (4)) of the complete

specification to make a distinct and proper statement of claims, which must be clear and succinct (Rule 14) as well as separate and distinct from the body of the specification. The claims should be preceded by the prescribed preamble given on Patents Form No. 3, and should form in brief a clear statement of that which constitutes the invention, and inventors should be careful that their claims include neither more nor less than they desire to protect by their patent. Any unnecessary multiplicity of claims or prolixity of language should be avoided.

Claims should not be made for the efficiency or advantages of the invention.

The specification must be dated at the end, and should be signed by each applicant or by the authorised agents, but the patent will not be stopped because all the applicants have not signed the complete specification (*d*).

DRAWINGS.—As the drawings are printed by a lithographic process, the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of such process and calculated to give the best results in the interest of inventors, of the Patent Office, and of the public. The following requirements should, therefore, be strictly observed, as non-compliance therewith will cause delay in the progress of an application for a patent.

Drawings, when furnished, should accompany the provisional or complete specification to which they refer (Rule 19), except in the case when those left with a provisional are referred to in the complete specification (Rule 26). No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself (Rule 19).

Drawings may be made by hand or lithographed, printed, etc. They must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness, without washes or colours,

in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings must not be used (Rule 20).

Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to $8\frac{1}{4}$ inches or from 16 inches to $16\frac{1}{2}$ inches wide, the narrower sheets being preferable (Rule 21).

If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets, and should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct, and should be placed in an upright position on the sheet (Rule 21).

Drawings must be prepared in accordance with the following requirements (Rule 22):—

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines, should be as few as possible, and must not be closely drawn.
- (d) Shading lines must not contrast too much in thickness with the general lines of the drawing.
- (e) Sections and shading should not be represented by solid black or washes.
- (f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, etc., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words.

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct, and not less

than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines (Rule 22).

Drawings must bear the name of the applicant (Rule 23) (and, in the case of drawings left with a complete specification after one or more provisional specifications, the numbers and years of the applications) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings.

A facsimile (Rule 24) or "true copy" of the original drawings must be filed at the same time as the original drawings, prepared strictly in accordance with the above rules, except that it may be on tracing cloth and the reference letters and figures should be in blacklead pencil.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet (Rule 24).

Drawings (Rule 25) must be delivered at the Patent Office so as to be free from folds, breaks, or creases, which would render them unsuitable for reproduction by photography.

If an applicant (Rule 26) desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he should refer to them in the complete specification as those "left with the provisional specification."

CHEMICAL SAMPLES.—If the Comptroller require samples (s. 2) in order to comprehend the invention they must be left in duplicate (Rule 36): that they have been furnished will be advertised. They must be provided in accordance with Rule 36.

Applications, notices and other documents may be left or served by letter; an address given in the Register of Patents being sufficient (Rule 7).

CHAPTER III.

APPLICATION.

THE application must be made in the prescribed manner as detailed in Chapter II. (ss. 1 & 2), and must be accompanied by a provisional or complete specification. The specifications filed with the application must follow certain rules as to conformity of the title with the subject-matter, conformity of the provisional and complete specifications, and sufficiency of description ; also the Office is empowered to refuse to accept a specification, or any part of a specification, which has been anticipated by an earlier grant. The machinery provided by the Act for securing accordance with these and other rules is an examination of the application and specification by official examiners, who report on the application to the Comptroller.

EXAMINATION OF APPLICATION.

The Comptroller will refer every application to an examiner, who will report on it (s. 3). If he reports that the application is not prepared in the prescribed manner, or that the invention is not fairly described, or that the title does not indicate the invention, the Comptroller will require amendment or refuse to accept the application (s. 3 (2), (3)), unless he disagrees with the examiner.

If the complete specification is left after the application (s. 5) the Comptroller will, upon receiving it again, refer the whole matter to an examiner (s. 6), who will again report. If he reports that the complete specification is not prepared in the prescribed manner (s. 2 (2)), the Comptroller may require amendment thereof. If he reports that there is

disconformity between the provisional and the complete, the Comptroller may refuse to accept the complete; or, with the consent of the applicant, may accept the complete; but, in the latter case, will date the patent from the date of the complete; or, in a third alternative, may split up the complete into two patents, one of which contains the matter of the provisional and is of that date, the other of which contains the matter in excess and is of the date of the complete (s. 6; Rule 13).

But these are not all the duties of the Office. As soon as and whenever a complete specification has been left, the examiner to whom the matter is referred must report, in addition to what has gone before:—

A. . . . *Whether the matter of the complete specification is to be found in any other complete specification published before the date of application* (s. 7).

This search extends to specifications “published” before the date of the application and within 50 years of that date. “Published” here does not mean the same thing as published with regard to want of novelty. “Publication” is effected if the Office advertises that the document is open to public inspection even if nobody inspects it, or if it be under the charge of officials and not in the Patent Office library. Sects. 68 and 69 do not affect sect. 7 in this respect (a).

The applicant is informed of the result of this examination, and he may amend within two months (Rule 30) or disclaim the anticipating matter; the amended specification is investigated again by an examiner and, if no further difficulty is made, the specification is accepted. The examiner may object that the invention is not sufficiently defined to enable him to so report, when the Comptroller may post-date the application to the date of compliance with this requirement (Rule 28).

If the applicant does not amend or the Comptroller is not

(a) *Parsons & Stoney's Appn.*, 27 R. P. C. 491. For the further meaning of “published,” see *Plimpton &*

Malcolmson, L. R. 3 Ch. 531; *Plimpton v. Spiller*, L. R. 6 Ch. 412; *Harris v. Rothwell*, L. R. 35 Ch. 416.

satisfied with the amendments, the Comptroller will determine if any references should be inserted to the prior anticipating specifications (s. 7 (4)). The reference must be in the form of Rule 32.

After the expiration of the two months allowed to the applicant for amending, if the applicant has taken no notice of the Office objection under sect. 7, the Comptroller will inform him that the objection still exists and will appoint a hearing to decide the matter (Rule 21).

If the complete specification has been entirely anticipated the application will be refused (proviso to s. 7 (4)). But for the Comptroller to refuse absolutely, the invention must have been claimed in the prior specification. That it is to be found in the description thereof will not do (*ibid.*). The section is so framed that the Comptroller shall not have to decide on the novelty of the invention. The examiner will report complete anticipation, if it so appears to him, without going any further; and this is a final report until answered to the satisfaction of the Comptroller (Rule 29).

B. . . . *Whether the matter of the complete specification is claimed in any specification deposited on a prior application but not published at the date of the applicant's application* (s. 8 (1), (3)).

The procedure here is much the same as in A, above. The applicant may amend within two months, and the Comptroller will appoint a hearing if he does not amend (Rule 33). When the applicant does not appear, or when he amends, the Comptroller will consider the matter, or the amendment, and will determine if a reference is necessary to the prior specification. If a reference is inserted it will be in the form of Rule 34. The amendment or reference will be advertised in the Illustrated Official Journal (Rule 35).

Sect. 8 provides that the Comptroller will allow or require amendments or references, as the result of this extended search, whether or not the patent has been granted or the complete accepted. This makes the acceptance under sect. 7 only provisional on the extended search. If the patentee

will not make the alterations demanded, the Comptroller may refuse to grant, and if the invention is wholly anticipated by the result of the investigation in this extended search, the grant may be refused altogether under proviso of sect. 7 (4). But if the patent has been granted he cannot enforce his decision nor revoke, for the section gives him no power to do so.

It will be noticed that the applicant may be forced, under this section, to amend because of specifications which are never followed up. No real hardship is however caused, especially as he may afterwards amend away the alteration under sect. 21. For this reason the references ordered will be by way of notices to the public and not disclaimers; for otherwise future amendment under sect. 21 might widen the claims and so become impossible.

An appeal lies from the Comptroller's decision in all the foregoing matters to the Law Officer.

Object and Effect of the Search as to Anticipation.—In order to prevent the sealing of patents which are not novel, and which, if sealed, would be useless to the patentee and deceptive to the public, the Legislature has empowered the Comptroller to make the searches detailed above for anticipations of the applicant's invention by prior specifications. The object of the search, extended by the Act of 1902 and further enlarged by the Act of 1907, is to prevent a patentee getting a prior date for an invention which is not his own, and which he has obtained from another specification (b).

The effect of the search is not in any way to guarantee the validity of the patent when granted (s. 7 (6)); but the public may rely on the Office to examine into the state of the art since 1902 (c); nor in any way to fetter the decision of the Comptroller, but to assist him in his decision (d).

(b) 26 R. P. C. 1909, I.; 27 R. P. C. 1910, A.

(c) 28 R. P. C. 1911, A.

(d) *Re C.*, 7 R. P. C. 250; this case was decided under a similar provision of the Act of 1883.

OFFICE PRACTICE.

The actual practice under the Act and Rules is as follows :— The search having been performed, the examiner intimates his objections to the specification by letter to the applicant or his agent. If the complete specification has been left, the letter will include the list of anticipations found by the examiner: if the examiner thinks he has found a complete anticipation he will stay the search and quote this anticipation alone to the applicant. The applicant has now two months, from the date of the first official letter he receives, in which to amend (for extension of time see Rule 1; Notice of Procedure, p. 286); if he does not wish to amend, or cannot and does not want to settle the matter by correspondence, he may apply for an interview with the examiner or a hearing before the Comptroller. The interview with the examiner is informal, and often by it the matter can be settled in some way satisfactory to both the applicant and the Office. The applicant then amends as agreed at the interview and re-submits his specification.

The above practice is controlled by Rules 30 and 31, and a Notice of Procedure (Appendix, p. 286) explains in detail the Office practice under sect. 7. The formal details to be followed in amendment of specifications to meet objections by the examiner will be found in a further Official Notice of Procedure (p. 288).

SUBJECT-MATTER OF THE APPLICATION.

As has been pointed out on p. 5, the subject-matter of an application is not in general a question for the Comptroller's consideration, unless the application offends *clearly* against the legal definition of a patent. It is only possible to define the limits of patentable subject-matter as considered by the Comptroller by means of examples, and the following remarks and examples are inserted for the purpose of illustrating this. Further examples will be found in the chapter on Opposition (p. 52 *et seq.*).

There may be invention, and an application will therefore succeed, in combining well-known parts in a certain manner; but the mere improvement of two members of a combination and then combination in the old manner will not be allowed on application (*e*).

The alteration of shape and the substitution of simple mechanical equivalents will not be "invention" in the eyes of the Comptroller (*f*). It is not the Comptroller's province to enter into the question of mechanical equivalents generally, but only in obvious cases where there is substantial identity (*g*). As to what are distinct and patentable advances, see further (*h*).

The grant may be refused if the application is a mere selection without invention from the claims of a prior patent (*i*).

The application will not be stopped on the ground that the invention is not new; it must have been claimed before to be refused, unless it be obvious common knowledge. Nor is it sufficient to stop a patent that the range of directions indicated in an earlier patent is wide enough to include the applicant's directions (*k*).

An improvement on an existing machine is perfectly good subject-matter for an application, and any application may contain the essential features of an old machine if by addition, omission, or alteration different processes and results are obtained. The Comptroller will not consider very closely whether such results are in reality very different, nor will he consider whether the carrying out of the improvement will infringe the prior patent, though he may direct a reference or disclaimer (*l*). The claims in improvement patents must not

(*e*) *Bridges' Appn.*, 18 R. P. C. 257; *Fried. Krupp*, 25 R. P. C. 810, distinguishes this.

(*f*) *Re Bailey*, 13,397 of 1887, unrep., *Goodeve*, P. C. 57; *Re Aire & Calder*, 5 R. P. C. 345; *Re Daniel*, 5 R. P. C. 413.

(*g*) *Stubbs' Pat.*, Gr. P. C. 298; *Haythornthwaite*, 7 R. P. C. 70; *Whittaker*, 13 R. P. C. 580.

(*h*) *Taylor & Scott v. Annand*, 17 R. P. C. 126; *Hickton's Syndicate*, 26 R. P. C. 339.

(*i*) *Wylie & Morton*, 13 R. P. C. 97. See p. 58.

(*k*) *Nahnsen*, 17 R. P. C. 203.

(*l*) For consideration of what is an improvement, see *Linotype & Machinery, Ltd. v. Hopkins*, 25 R. P. C. 665.

contain general words which may be taken to include something not specifically claimed, and so deceive the public into thinking that the specification is for a wider invention than is actually the case (*m*).

The Comptroller must also be satisfied that the subject-matter of the application is a manner of new manufacture within the Statute of Monopolies. Though sect. 93 provides that "invention" shall include an alleged invention, this section does not mean that an allegation will enable an applicant to obtain a grant for matter which is in no way a manner of manufacture, nor does it relieve the Comptroller of the duty of satisfying himself on this point (*n*).

The Comptroller will consider subject-matter, however, in a wider manner than do the Courts in judging if there be subject-matter in a patent. Examples of cases where the subject-matter was considered are: *Cooper's Appn.* (*ante*), where the provision in a newspaper of blank spaces for folding and the reader's convenience was held to be subject-matter; and *Johnson's Appn.*, 19 R. P. C. 56, where a system of arrangement for business cards was held not to be subject-matter.

Sect. 14 (2) provides that one invention only shall be included in the specification; further, Rule 13 (1) provides that distinct matters cannot be included as one invention merely because they are parts of the same "existing" thing. These provisions are largely for the convenience of the Office, and the Law Officer will not interfere with the Comptroller's decision hereon unless he has acted unreasonably. A certain amount of discretion is here permitted to the Comptroller. The word "existing" in Rule 13 can be construed thus by way of example: If a steam engine were novel to-day it would all be patentable in one specification; but things being as they are, separate improvements in the piston and the crankshaft would require separate specifications (*o*).

The question whether the matter put forward is *one*

(*m*) *Hamilton*, 19 R. P. C. 35.

(*o*) *Z.'s Appn.*, 27 R. P. C. 285.

(*n*) *Cooper's Appn.*, 19 R. P. C. 53.

invention or more is to be considered with regard to the general object of the invention. There must be a common purpose to be found in the separate matters claimed. Cognate or analogous devices for the accomplishment of the general object of the invention are allowable, but to claim one matter in substitution of another where the purposes of the two matters are not the same will not be one invention; the two matters must be alternative devices (*p*).

If the patent asked for be for a combination, then, in so far as they relate to the combination, all the combining parts may be claimed separately, and there will be only one invention claimed. But a claim for the use of a subordinate part for a purpose independent of the combination will be a second invention (*q*); and where the combination invented is claimed for a particular purpose it cannot, in the same patent, be claimed generally for other purposes (*r*).

THE SPECIFICATIONS.

Contrast between the Provisional and Complete Specifications.—The object of a provisional specification is to provide a fair description of the invention for the information of the public, the consideration for which is the provisional protection given to the inventor. As the full rights of a patentee are not given to the inventor on filing a provisional it is only fair that less should be demanded of him, in the matter of information, in the provisional than in the complete. In his provisional the inventor need not disclose details so that a workman could use his patent: he need only disclose his invention roughly, though fairly (*s*). He need only describe his invention, and need not enter into any method of carrying it out. If he does describe such a method in his provisional he may describe a different method in his complete, if the

(*p*) *Jones' Pat.*, Gr. P. C. 265.

(*q*) *Ibid.*; *Hearson's Pat.*, Gr. P. C. 266.

(*r*) *Robinson's Pat.*, Gr. P. C. 267.

(*s*) *Moseley v. Victoria Rubber Co.*,

4 R. P. C. 248; *Stoner v. Todd*, L. R. 4 Ch. 58.

new method can be said to have been included in the provisional (*t*).

No claim is made in a provisional specification. The patentee states the nature of the invention generally, so that the identity of the subject-matter so described, and afterwards described and claimed in the complete specification, may be ascertained (*u*). The advantages of the invention need not be detailed in the provisional (*x*), nor indeed in the complete.

Disconformity.—The disconformity of the provisional and the complete specifications reported by the examiner and considered by the Comptroller on application is not now so important after the Act of 1907, since under sect. 6 (3) the Comptroller has new powers to allow the complete specification or to separate up the matter in it into two patents.

The Comptroller will not refuse the application unless the remedies of sect. 6 (3) (b) and the proviso to sect. 6 (3) are inapplicable.

The following shows what degree of disconformity will bring the proviso into operation or entail refusal or amendment :—

There is no need for the complete to include everything which was in the provisional. Their relationship only entails that the complete must contain nothing not foreshadowed in the provisional, and nothing different from the provisional. No further agreement between the specifications is required (*y*). It does not matter that the inventor has discovered fresh matter which makes his invention more workable, and inserts this in his complete ; nor does it matter if he inserts improvements in arrangements or adaptations or substitutes mechanical equivalents, if such matters were foreshadowed in the provisional (*z*). Except in cases of fraud any part, which is not an essential part of the invention and

(*t*) *Woodward v. Sansum*, 4 R. P. C. 174.

(*u*) *Cassel Gold v. The Cyanide Gold* (1895), 12 R. P. C. 257.

(*x*) *The Pneumatic Tyre Co. v. East*

London Rubber Co., 14 R. P. C. 98.

(*y*) *Penn v. Bibby*, L. R. 2 Ch. 133.

(*z*) *Bailey v. Robertson*, L. R. 3 A. C. 1055.

which is included in the provisional, may be omitted from the complete without disclaimer (*a*).

THE COMPLETE SPECIFICATION.—The customary form of a complete specification is the title and description of the invention followed by claims. The drawings attached to a specification are read as a part of it.

The Title.—The title formerly took the place of a provisional specification, but since 1852 it has merely performed the function of a label. Objections to the title are not now of any substance, and patents are never refused on such objections. An amendment of the title may possibly be ordered by the Office where the title is at variance with the claims. But, if the title be in agreement with the claims, it is no ground for objecting to the title that the body of the specification describes something not included in the title (*b*).

The Claims.—The statement of the invention in the claims must be clear and succinct (Rule 14). Although each claim may be in itself clear and succinct, if the claims are not really and substantially separate, the claims taken as a whole are not clear and succinct. Each claim must be unobjectionable and there must not be repetition. There must not be a second claim for the same thing; for example, if one claim includes the invention, a second claim may not be made for the use of the invention in an old way, if there be no invention in such use (*c*). The claims are not allowed to be prepared on the American system, where the patentee by claiming in a large number of claims seeks to protect himself against every contingency. Thus (*d*), a specification contained 23 claims and was refused for repetition; but, as was there pointed out, there is no reason to refuse merely because of the number of the claims, for a specification may have a very large number of claims quite justifiably made as long as there is not repetition.

(*a*) *Thomas v. Welch*, L. R. 1 C. P. 201; *Pneumatic Tyre v. East London Rubber Co.*, 14 R. P. C. 98, 582; *Ward v. Hill* (1903), 20 R. P. C. 200; *Dart's Pat.*, Gr. P. C. 307.

(*b*) *Brown*, Gr. A. P. C. 1.

(*c*) *Re Webster*, 6 R. P. C. 163.

(*d*) In *Re Bancroft's Appn.*, 23 R. P. C. 89.

Such a claim as, "I claim the invention described in the specification, or in a former specification," will not be allowed (e).

The Specification Generally.—The specification should be prepared in as perfect a form as possible; but the powers of amendment given to the Comptroller may be a reason for not preparing the claims in too meticulous a spirit (f).

As a rule, patentees should be allowed to describe their inventions in their own words. Provided that such description is clear and sufficient, it is the practice to interfere as little as possible with the language either of the description or of the claims in cases where anticipation is avoided. The Comptroller will only interfere when he is quite clear that he should do so (g). The obligation of search (s. 7) has imposed since 1902 a duty on the Comptroller, in the interests of the public, of seeing that the specifications as they leave the Office are clear and accurate in fact and as far as possible free from doubt and ambiguity. This duty carries corresponding powers, and the Comptroller has a discretion to require at any stage, when the case comes before him, any amendment which he considers necessary to prevent ambiguity, to make the invention clear and definite, and the claims clear and succinct within the meaning of Rule 14 (h).

The Comptroller will require the amendment of obscurities (i) whether of the description or of the claims. A specification and its claims must not be so framed that it becomes necessary for the Comptroller to undertake the task of elucidating its ambiguity and eliminating what is irrelevant or cannot be subject-matter (k). A specification that contains irrelevant matter does not contain a fair description of the invention within sect. 3 (2), and the Comptroller will refuse to accept a specification offending badly in this respect. Thus, where

(e) Rule 14; *Smith's Pat.*, Gr. P. C. 268.

(f) *Bancroft's Appn.*, 23 R. P. C. 89.

(g) *Re Webster*, 6 R. P. C. 163.

(h) *Francis' Appn.*, 27 R. P. C. 86; 26 R. P. C. 1909, II.; see pp. 84, 90.

(i) *Francis' Appn.*, 27 R. P. C. 86.

(k) *Thomas v. Prevost*, 16 R. P. C. 71.

the invention is confined to a small detail of a machine or process, it is irrelevant to describe a type of the machine or include matter wholly irrelevant to the claims. But it is always permissible to describe a method of carrying the invention into effect and to describe the connection of the method with the invention (*l*). It is not irrelevant to describe the state of the art: this is in the nature of disclaimer. Even if the patentee refer in the specification to defects of former methods which, rightly or wrongly, he alleges exist, the specification does not contain irrelevant matter (*m*). So long as the patentee is fair in his statement of the art there is no objection to such statement. But he must not put forward an interpretation of written documents, as his construction of them, for they speak for themselves (*n*). An applicant must not insert matter which is disparaging to a prior patentee (*o*) with no other purpose than to advertise himself or disparage others. The Comptroller will not hold himself bound to seal a patent on a specification, proper in other respects, but which contains upon its face a statement untrue in fact or injurious to a prior patentee (*p*).

There are many evils in widely drawn specifications though they are restricted by disclaimers and references:—

1. It is difficult to see what the invention really is.
2. The public may believe that the invention is for a wider and more important invention than is the case.
3. There may be disputes and oppositions concerning matter which is in the specification but is not in the claims.

It should further be remembered by patentees that, unless they originally frame their specifications with reasonable skill and knowledge, they may fail to recover damages in infringement actions and suffer otherwise (*q*), even after the specification has been amended. It is for these reasons to the patentee's advantage to frame his specification properly.

(*l*) *Francis' Appn.*, 27 R. P. C. 86;
26 R. P. C. 1909, II.

(*m*) *Guest & Barrow*, 5 R. P. C.
313.

(*n*) *Atherton*, 6 R. P. C. 547.

(*o*) *Wadham's Appn.*, 27 R. P. C.
172.

(*p*) *Hetherington*, 7 R. P. C. 419.

(*q*) *Wenham & Carpenter*, 5 R. P. C.

68.

30 PRACTICE BEFORE COMPTROLLER OF PATENTS.

The Consideration of the Specification.—It is not in general the Comptroller's duty to consider the novelty or utility of the specifications submitted to him or the validity of the patent asked for. This appears from the sections dealing with applications and the definition of "invention" in sect. 93. But if the official search reveals complete anticipation, it is his duty to refuse the patent; or if partial anticipation, it is his duty to see that the public are adequately protected by the insertion of references and disclaimers against thinking that what is really old is a novel invention of the applicant. He must further see that there is not disconformity between the provisional and complete specifications (s. 6 (3)).

If on the face of the specification it appears clear, by the light of ordinary knowledge, that the claimed invention is incapable of practical use, then utility may be considered; but such consideration is strictly confined to clear cases of what the documents themselves disclose (*r*). With this exception the only questions which come before the Comptroller on application are the form of the application, the relation of the invention therein described to former British letters patent, and the correspondence between the provisional and the complete specifications.

It is only in the very clearest cases that the Comptroller should refuse to seal a patent, and if any modification which could be called an improvement on previous patents appears, which is not shewn to be worthless, he will seal the patent (*s*). As to the amendments which may be required, see further p. 83. And he will not refuse a patent in a case where anticipation depends on the result of scientific controversy, even if he have an expert who advises against the patent (*t*).

It should be repeated, that to be considered by the Comptroller the anticipation reported by the examiner must be found in the *claims* of a patent applied for before the application in question, but published after the date of the

(*r*) *Hopkins' Pat.*, 3rd Aug. 1909,
unreported.

(*s*) *Chandler's Pat.*, Gr. P. C. 270.
(*t*) *Lake's Pat.*, 6 R. P. C. 548.

application (s. 8); but may be found either in the *description* or claims of a patent published before that date (s. 7). The grant can only be refused completely on patents published before the application, and then only when the invention is found in the *claims* of such patents.

The specifications will sometimes shew that the minimum of invention claimed by the applicant was not put forward by him as invention at the time when the provisional was filed. When such a conclusion is arrived at the Comptroller's duty to refuse will be clearer (*u*). This comparison of the provisional and complete has nothing to do with any question of disconformity (see p. 26). Again, it may be that there is not disconformity between the provisional and complete, and yet it may appear that the applicant has used others' inventions, published in the interval between leaving his two specifications, upon which to frame his complete. In such a case the complete specification would not be allowed (*v*).

After considering the specification as above if, and if only, the Comptroller is clear that beyond all reasonable doubt no tribunal entitled to deal with the matter could reasonably find that there was any invention in it, he will refuse the application (*x*). Also if after eliminating anticipated matters there is nothing left, the seal will be refused (*y*). But if the objections can be amended away by omission, disclaimer, or reference, and the applicant makes the necessary alteration, then the specification will be accepted in an amended form and a patent granted.

NOTES ON THE PROCEDURE ON APPLICATION.

As has been stated, the requirements and procedure of an application for a patent are included in sects. 1 to 8 of the Act of 1907 and the Rules of 1908, 10 to 14; applications under the International Convention are dealt with by sect. 91

(*u*) *Re Aire & Calder, etc.*, 5 R. P. C. 345.

(*x*) *Fried. Krupps' Appn.*, 25 R. P. C. 810.

(*v*) *Everitt*, Gr. A. P. C. 28.

(*y*) *Hedges*, 12 R. P. C. 136.

and Rules 15 to 18, and applications for patents of addition by sect. 19. For the various sections and Rules, see Appendix.

The word "application" in the Act of 1907 should always be read as referring to application in this country, except where it is expressly said to mean application abroad, and except in sect. 21, though the further meaning in this case is possibly covered by the "except as otherwise expressly provided" with which the section opens (z).

The appropriate form should be used on application, as otherwise the application may be refused (a); and the rules generally observed—*e.g.* the office hours being from 10 to 4 at the Patent Office (Rule 110), an application not left till 5.50 p.m. will bear the date of the next day (b).

The production of chemical samples provided for in sect. 3 (2) is to prevent successful applications for blocking patents where the applicant endeavours to fetter others by claiming something which he cannot really produce. If the sample is not produced the Comptroller may proceed under sect. 3 (2).

CONVENTION APPLICATIONS (see p. 11).

A statutory right is given by sect. 91 to an applicant for protection, or to a patentee, in any of the following states to apply for a patent in this country to be dated as of the date of his application abroad. The states are:—

Austria.	Mexico.
Belgium.	Netherlands with the Dutch East Indies, Surinam, and Curaçoa.
Brazil.	Norway.
Cuba.	Portugal with the Azores and Madeira
Denmark with the Farøe Islands.	Santo Domingo.
France with Algeria and colonies.	Servia.
Germany.	Spain.
Great Britain with Australia, Ceylon, New Zealand, and Trinidad and Tobago.	Sweden.
Hungary.	Switzerland.
Italy.	Tunis.
Japan.	United States of America.

(z) See *Johnson's Appn.*, 24 R. P. C. 694.

(a) *Société Anonyme du Temple*, 13

R. P. C. 54.

(b) *Matthews & Strange's Appn.*, 27 R. P. C. 288.

By Order in Council other states may be added to this list.

If, by an Order in Council, another state is added to this list, an applicant applying for priority of date under sect. 91 will only have so much of the 12 months, allowed generally under sect. 91, as remains unexpired after the order (c).

Any one who has obtained registration or protection abroad according to the law of a state within the Convention comes within this section (d). The Convention application when made is treated in the same way as an ordinary application as regards the examiner's searches. The applicant for Convention patent can only include in his patent for this country what has been protected abroad (e). To this end the foreign specifications must be considered on the same principles as those of a British patent; but where different principles apply in a foreign country there will be an onus on the applicant to show that this is so before such different principles are considered. It will be sufficient if the applicant establishes a *primâ facie* case for the application of different principles, without strict proof.

The Convention applicant has the privilege of an early date, but otherwise he is subject to the same restrictions as an ordinary applicant (f).

The questions to be asked in considering an application under sect. 91 are:—

(1) What is patented by the foreign patent?

(2) Does the British application apply to that and to nothing more? (g)

The regularity of the procedure in a Convention application should be carefully attended to, as it seems that the discretion given to the Comptroller to waive irregularities, under Rule 108, will not be so readily extended to applications under sect. 91 as to applications under other sections. The requirements of the Rules and Statutes should be looked

(c) *Re Main*, 7 R. P. C. 13.

(d) *Carez' Appn.*, 6 R. P. C. 552.

(e) 27 R. P. C. 1910, B.; 26 R. P. C.

1909, V.

(f) *Vidal's Pat.*, 15 R. P. C. 721.

(g) *Ibid.*

upon as conditions precedent; if they are not complied with the Comptroller must refuse to grant or exert his discretion (*h*). Thus where an incorrect date of the foreign application was given in a Convention application, which further was not accompanied by a certified copy of the foreign specification and translation as required by Rule 14 of 1903 (Rule 16 of 1908), the Comptroller decided that the Rules not having been complied with and, as a result of the error in date, the complete specification not having been *open to public inspection* at the expiration of 12 months from the date of the foreign application, the priority claimed under the Convention could not be given (*i*). The meaning of "open to public inspection" was explained on p. 19.

The applicant for a Convention patent must be the foreign patentee or his agent, and the patent must be taken out in the name of the foreign patentee. The right given by sect. 91 is personal; and its object is to encourage inventors to come to this country. The right given by the section cannot be obtained by a person who comes to take out a patent in his own name but is not the foreign patentee: such a person may take out the patent as the first importer, but he cannot then claim to date back the patent taken out in his own name. If he were allowed to date back under the Convention, as having authority from the foreign patentee, there would be let in vexed questions of the sufficiency of the authority and opportunities for fraud (*k*). Even if the foreign patentee signs the application, praying for the patent to be sealed in another's name, the application will not be granted (*l*).

Where the formalities and requirements demanded by the Act and Rules are attended to, the applicant under sect. 91 is entitled to a patent and is entitled to have it ante-dated. Hence the Comptroller has no jurisdiction to impose terms for the protection of another who will be injured by the prior

(*h*) *In re Appn. under Sect. 103, Act of 1883*, 23 R. P. C. 788.

(*i*) *Ibid.*

(*k*) *Shallenberger's Appn.*, 6 R. P. C. 530.

(*l*) *Re Carez*, 6 R. P. C. 552.

date given. Yet if there is *mala fides* in the application under sect. 91, the right to a patent and to ante-dating free from terms does not arise and terms may be imposed (*m*).

A Convention application must bear the date of the foreign patent. There is no discretion in the Comptroller in this respect in dealing with applications under sect. 91; and the decisions under Rule 28 are for a different matter: they apply to purposes under sect. 7, and do not affect applications under sect. 91 (*n*). But where the apparent date of application abroad is not the real date of application abroad, this may be shown by declarations and the real date allowed. For example: in America an abortive application had been first made, and it was shewn that the second application in America, the date of which was asked for on the Convention patent, was in all respects the same as if no prior application had been made; upon these facts the date of the second application was allowed (*o*). Though Convention applications bear the date of the foreign patent, they can claim on application no other treatment than the treatment given to ordinary British applications of the same date of application (see p. 11). The Convention gives priority of date, but does not give priority of application (*p*).

The patentee can only recover for infringements committed after the date of his application in this country; but the patent will not be invalid by reason of prior publication by others within the time allowed, from the date of the foreign patent, for application here.

PATENTS OF ADDITION (see p. 12).

Sect. 19 of the Act provides for the grant of a patent having the same term as the original patent, and for any improvement or modification of the invention; no renewal fees are payable on such patent of addition.

(*m*) *L'Oiseau & Pierrard*, Gr.

A. P. C. 36; *Re Main*, 7 R. P. C. 13.

(*n*) *Scott's Appn.*, 27 R. P. C. 298.

(*o*) *Van de Poele*, 7 R. P. C. 69.

(*p*) *J. Y. Johnson's Appn.*, 24 R. P. C. 694.

A patent of addition must be merely appendant to the original patent, and the additional specification must not disclose a separate or a different invention; that is to say, a patent of addition will only be granted for an invention which could have been included as an improvement or addition in the original specification (*q*). As a patent of addition is to be granted "when a patent for an invention is applied for or granted" (s. 19), it follows that a patent of addition cannot be granted on a patent of addition (*r*).

ACCEPTANCE OF APPLICATION.

The complete specification must be accepted within 12 months (s. 6 (5)), or with extension of time 13, 14, or 15 months from the date of application, and if not so accepted the application becomes void and cannot be further proceeded with. Application for extension of time is made on Form 7 (Rule 37).

On the acceptance of a complete specification, the Comptroller gives notice thereof to the applicant, and the acceptance is advertised (s. 9) in the Illustrated Official Journal of Patents (Rule 38).

Any person (other than the applicant) wishing to be informed as soon as a complete specification is accepted, should forward a Patents Form No. 31 requesting such information.

Effect of Acceptance of Application.—As soon as a specification has been filed with the application, provisional protection (s. 4) is conferred on the applicant (s. 10). That is to say, he may work at his invention in any way without invalidating the patent, subsequently granted him, for want of novelty. And he cannot be anticipated by an application made, or patent granted, subsequently to his application but before the time for sealing his patent. Provisional protection does not, however, confer full rights: and the patentee thus

protected cannot bring an infringement or other action, in respect of this provisional protection before sealing, either before or after the publication of his complete specification (s. 13). Nor can he style his invention "patent," though he may use such a phrase as "patent applied for" (s. 89) (s).

SEALING OF PATENT.

The form of the patent when granted is to be found in Forms A and B of the 3rd schedule of the Patent Rules (p. 278). These forms are to be used whenever applicable (Rules 5, 49, 50); they are to be modified in the case of a grant to the legal representative of a deceased inventor, or where the applicants ask to be treated as joint tenants.

Except in cases of appeal to the Law Officer, of opposition, or of the death of the applicant, a patent must be sealed within 15 months, or, if extension of time has been allowed for leaving or accepting a complete specification, 19 months from the date of the application for the patent (s. 12). A sealing fee of £1 is payable, and should be paid by leaving at the Patent Office Patents Form No. 10, stamped £1 (Rule 48).

Great care must be taken to ensure that the form, duly stamped, is left at the Office at such a date as to permit of the sealing of the patent within the prescribed time. The applicant for a patent is advised to pay the sealing fee after the date of the acceptance of the complete specification and before the expiration of the period allowed for opposition. If this be done, the patent will as a rule be sealed about 10 weeks after the date of the acceptance of the complete specification. If the payment has been omitted, application may be made to the Comptroller on Patents Form No. 11 for an extension of time for one, two, or three months to make such payment, but no extension can be allowed beyond three months (Rule 48).

(s) *R. v. Wallis*, 3 R. P. C. 1; *R. v. Crampton*, 3 R. P. C. 367.

38 PRACTICE BEFORE COMPTROLLER OF PATENTS.

A patent may be sealed to a deceased applicant's legal representative within 12 months of the applicant's death (s. 12 (2) (c)).

If the patent be not sealed within the prescribed time it can only be sealed by direction of the Law Officer (see p. 146).

CHAPTER IV.

OPPOSITION.

It would be unfair to rival traders and other persons interested in the subject of an applicant's application to allow a patent to be obtained and the freedom of manufacture narrowed without giving them an opportunity of opposing the grant of a patent. Hence the Act allows opposition to an application. But, to prevent multitudinous grounds of opposition, and grounds of opposition which are only an attempt to preserve advantages to the opponent, the Act has provided certain specified grounds of opposition. The section of the Act dealing with opposition is as follows:—

“11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—

- (a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or
- (b) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or
- (c) that the nature of the invention or the manner in

which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification ; or

- (d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,

but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case ; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine."

PROCEDURE ON OPPOSITION.

A notice of opposition to the grant of a patent must be made on Patents Form No. 8 (Rule 40), and must state the ground or grounds on which the person giving such notice intends to oppose the grant, and must be signed by him. Such notice must state his address for service in the United Kingdom, and be accompanied by an unstamped copy to be transmitted by the Comptroller to the applicant.

If the opponent does not desire refusal of the patent applied for, but desires the insertion of a disclaimer or other alteration in the specification, he may state this, and

particularly what he requires in his notice of opposition (Rule 40), but it may be bad policy to do so. If the opponent alleges that the applicant obtained the invention from him, he must leave evidence in accordance with Rule 41 (1). If he alleges that the invention is not sufficiently or fairly described he must make a statement showing this: this statement must accompany his notice of opposition (Rule 41 (2)). In other cases the opponent need not leave declarations in support of his notice of opposition, but he may do so if he wish (Rule 42). The provisions as to further evidence will be found in Rules 42 to 46.

After the completion of the evidence the Comptroller will appoint a hearing (Rule 47). Either party desiring to be heard must leave Form 9 at the Office. A party may refer to any publication not mentioned in his notice of opposition by giving notice that he intends to do so. At the hearing the Comptroller decides the case (for further details see p. 130).

The opposition is confined in fact and not only in form to the specified grounds of opposition (a), (b), (c), and (d), and the Comptroller is not to stop a patent at the instigation of an opponent because some general question of patent law is infringed (a).

But the opponent is not confined to the *remedy* he asks for; that is to say, if he opposes on any ground and asks for a specific reference he may, if the facts warrant it, obtain a refusal of the applicant's grant (b).

The applicant may answer the opposition in any manner he thinks fit; for example, he may endeavour to limit the construction which an opponent puts on a prior patent, which is said to be in anticipation (c).

A consideration of the various grounds of opposition, and of the qualifications necessary to be heard in opposition, will be found below. The Rules governing the procedure on opposition are numbered 40 to 47 inclusive, and give detailed directions for proceeding (see p. 210). The opposition will

(a) *Newman*, Gr. A. P. C. 40.

(b) *Brownhill*, 6 R. P. C. 135.

(c) *Re Welch*, 8 R. P. C. 442.

either be dismissed by the Comptroller, or he will order an amendment of the patent, or he will refuse to grant the patent. If the opposition is established and could be disposed of by the amendment of the patent this will be ordered; but not as a matter of course, for the Comptroller may, during the opposition proceedings, find other defects in the specification which are not amendable and would justify him in refusing the patent (*d*). Much of the practice which has already been dealt with under "Application" in Chapters II. and III. may come before the Comptroller on opposition, for upon the grounds of opposition specified by the Act many of the objections which might have been put forward by the Comptroller on application may be urged by the opponent. Further details will be found on p. 130.

WHO MAY OPPOSE.

Grounds of opposition (*a*) and (*d*) of sect. 11 show clearly who may oppose under them, and that the opposition can only be taken by certain persons.

Though the section does not clearly say so, it is well established that "the man in the street" cannot oppose under sect. 11 (*1*) (*b*). The opponent must have an interest. This was early established under the section (11 (*1*)) of the Act of 1883, for which the present section is substituted; it was decided thereunder that the intention of the provision for opposition on this ground was to give those interested an opportunity of opposing (*e*).

The ground of opposition, sect. 11 (*1*) (*c*), was not included in the older Statute; but the wording of the section discriminates in no way between (*b*) and (*c*), and hence it seems that the same interest must be shown under (*c*) as is shown under (*b*); the *ratio decidendi* of *Glossop's Case* (*infra*) points to this. The point has not yet been definitely decided.

(*d*) *Thomas v. Prevost*, 16 R. P. C. 71.

Hookham's Pat., Gr. A. P. C. 32; *Ex parte Tomlinson*, 16 R. P. C. 233, *per*

(*e*) *Glossop's Pat.*, Gr. P. C. 285; *Heath & Frost Pat.*, Gr. P. C. 290;

Smith, L.J.

The grounds of opposition given in sect. 11 are distinct, and if an opponent has a right to be heard on one ground, it does not follow that he has a right to be heard on another ground. He must establish proper locus for each ground of opposition. Thus to give evidence that the invention was obtained "from him" (ground (a)) does not give him a locus to oppose on the ground of a prior patent (ground (b)) (*f*).

The attention of the applicant should therefore be first directed to the—

Locus Standi of the Opponent.—If the opposition ground is (a) or (d) there is no difficulty. What follows refers to ground (b), and it is submitted to ground (c) also.

Upon this point it seems that the decisions before 1907 are as valuable as those after that date.

The Comptroller or Law Officer must be satisfied that there is a locus to oppose, and the Law Officer is the final authority on the question (*g*). The opponent must have an interest in some way either under a patent in force or lapsed (*h*), or expired (*i*), or a manufacturing interest (see p. 45).

The matter is put very clearly in *Glossop's Patent* (*j*), *per* Herschell, Sol.-Gen. : "I shall hesitate very much before I say that a member of the public can come in and oppose a patent and raise an inquiry and cause an appeal of this sort who has no interest in it, and simply says, 'Do not ask me what my interest is, because I have none, except that I am going to show you that this patent is the same as that.' Because that system might be used so as to cause a vast amount of annoyance and expense, of a most objectionable character, to patentees. I know it was intended to prevent that."

Whether an interest in a revoked patent would establish the opponent's locus has not been decided. As a locus may be obtained on an expired or lapsed patent it would seem probable that a revoked patent would be on the same footing :

(*f*) *J. & J.'s Appn.*, 19 R. P. C. 555.

(*i*) *Lancaster's Pat.*, Gr. P. C. 293 ;

(*g*) *Ex parte Tomlinson*, 16 R. P. C. 233.

Nahnsen, 17 R. P. C. 203.

(*j*) Gr. P. C. 285.

(*h*) *Glossop's Case*, Gr. P. C. 285.

no doubt in most of such cases the opponent would establish his locus as a manufacturer; he could then, it is submitted, oppose on a revoked patent. The question is of interest, since an applicant fearing opposition might obtain the revocation of a patent, anticipating his invention, before applying, or even after applying, for his own grant; or he might obtain a stay of opposition proceedings, and proceed to revoke an opponent's patent. It is sufficient that the opponent is the person for the time being entitled to the benefit of the patent cited in opposition to establish his locus (*k*), *e.g.* the opponent may be an assignee or a licensee (*l*).

A complete specification must have been lodged—a provisional is not sufficient—but a patent need not have been granted on it (*m*). Also, the opponent's application must have been made in the United Kingdom of prior date to the date of the applicant's patent; for, although the foreign applicant gets most valuable rights under the Convention and sect. 91, he does not get the right to oppose if his application in this country is subsequent to the application opposed (*n*). The right to oppose arises as soon as the complete specification has been accepted; the patent need not be sealed (*o*).

An agent must oppose in his principal's name where the principal has the interest but the agent has none; he has no locus if he oppose in his own name, though he be the agent of an interested principal; nor may such a difficulty be cured by amendment of the notice of opposition (*p*). This decision was under the Act of 1883, which provided for the "person giving notice" to be heard; but the substitution of the word "opponent" in the 1907 Act can make no difference.

As soon as a *locus standi* is secured on one patent, other patents in which the opponent has no interest may be cited and opposed on (*q*). He secures his locus by showing an

(*k*) *Gascoigne's Pat.*, 27 R. P. C. 79. R. P. C. 694.

(*l*) *Re Hill*, 5 R. P. C. 599.

(*o*) *L'Oiseau & Pierrard*, Gr. A. P. C.

(*m*) *L'Oiseau & Pierrard*, Gr. 36.

A. P. C. 36 (see p. 3).

(*p*) *Heath & Frost's Pat.*, Gr. P. C.

(*n*) *Ibid.*; *Re Everitt* Gr. A. P. C. 288.

28; *J. Y. Johnson's Appn.*, 24

(*q*) *Glossop's Pat.*, ante; *Heath &*

interest in one prior patent (*r*). How far the opponent may go when citing less relevant patents in which he is interested, in order to gain the right to be heard, while he really bases his opposition on another patent in which he has no interest, it is difficult to say; presumably he cannot gain a locus on an entirely irrelevant patent which he *alleges* to be a prior grant of the applicant's invention. The case does not seem to have arisen.

The Office may be said to have an interest in, and therefore a *locus standi* on, all patents; so that the Comptroller may refuse the patent under this section by reason of the patents cited by the examiner under sect. 7 and not cited by the opponent. He is empowered to consider the bearing upon the question at issue of any patent which might have been relied on by the opponent and to which his attention is directed (*s*). He may, in fact, proceed under sects. 7 and 8 in proceedings brought by an opponent under sect. 11 (see p. 25).

The Law Officer has no wider jurisdiction than has the Comptroller, and cannot hear people who have no *locus standi* before the Comptroller (*t*).

A *manufacturing interest* will also serve to establish the locus of the opponent. To make out this interest the opponent must prove a *bonâ fide* manufacture which appears to come within the claims of the specification of the applicant (*u*).

The question of a manufacturing interest has been often raised. *Glossop's Case* is one of the earliest (*x*): this case seems to decide that it is sufficient (*y*). Later, in *Macevoy's Case* (*z*), this interest was held to be insufficient; but it was expressly mentioned that *Glossop's Case* was not overruled.

Frost's Pat., Gr. P. C. 288; *Re Hookham*, Gr. A. P. C. 32; *Re Lancaster*, Gr. P. C. 293; *Morgan's Pat.*, 5 R. P. C. 186; *Stewart's Appn.*, 13 R. P. C. 627.

(*r*) *J. & J.'s Appn.*, 19 R. P. C. 555.

(*s*) *Hughes & Kennaugh's Appn.*, 27 R. P. C. 281.

(*t*) *Stewart's Appn.*, 13 R. P. C. 627.

(*u*) 23 R. C. P. 1911, B.

(*x*) Gr. P. C. 293.

(*y*) See also *Hookham*, Gr. A. P. C. 32.

(*z*) 5 R. P. C. 285.

Finally, in *Meyer's Case* (a) the case of Macevoy was overruled, though not in terms, and the limits of a manufacturing interest were defined.

This last case shews that a *bonâ fide* attempt to carry out an invention sought to be protected, by a person who desires to oppose a patent, is a proof that he may be damnified by the application that he desires to oppose, and entitles such person to oppose the grant.

Thus manufacturers who have an interest include :—

(A) Manufacturers under a prior patent, whether the prior patent be in force, lapsed, or expired (b).

(B) Any manufacturers who will be hindered or obstructed.

Thus a manufacturer of similar machines, so that it can be said that there is a risk that the patent if granted can be used to restrain his manufacture, has a locus (c).

But a mere proposal to manufacture will not be sufficient (d). The evidence must show—

1. A *bonâ fide* manufacture.

2. A manufacture of the special articles claimed, and not only of the type of those claimed.

For example, a watch-maker cannot necessarily oppose a patent for watches. Identity is not necessary of course; the question to be asked is: "Has the opponent attempted the same problem?" (e). If the opponent can establish such a case as, "I have commenced to manufacture under a certain expired patent and now find myself stopped for a further period," he will be heard. But each case must be determined on its merits (f).

It must be remembered that this manufacturing interest only gives a locus; the opponent must find also relevant specifications.

Bogus oppositions are severely dealt with (see p. 147).

(a) 16 R. P. C. 526.

(d) *Meyer's Case*, ante; *Bairstow's Appn.*, 5 R. P. C. 286.

(b) 28 R. P. C. 1911, B.; *Lancaster's Pat.*, Gr. P. C. 293; *Glossop's Pat.*, ante.

(e) 28 R. P. C. 1911, B.

(f) *Meyer's Case*, ante.

(c) 28 R. P. C. 1911, B.

THAT THE APPLICANT OBTAINED THE INVENTION FROM THE
OPPONENT (SECT. 11 (1) (a)).

The opponent has here to establish two conclusions:—

- (1) That the applicant's invention is the same as that which, he says, the applicant obtained from him.
- (2) That the invention was in fact obtained from him.

Usually the applicant and opponent will first explain their inventions at the hearing; the Comptroller will then be able to decide whether (1) is established, and can then either stop the case or allow it to proceed if (1) is established (*g*).

It will be seen that the section does not clearly state whether any other remedy but refusal is possible upon this opposition. It is the practice to treat the section as if *any* remedy were allowable, and therefore to allow disclaimers and references as upon other oppositions (*h*).

It is a personal right which is here given to the opponent; the invention must have been obtained from the opponent or a person of whom he is the legal representative. Thus persons holding a power of attorney or assignees are not included under sub-sect. (1) (a) (*i*). But when the invention has been obtained from several inventors jointly it is unnecessary for them all to oppose; the remedy is personal, and the right to oppose joint and several (*k*). The right to oppose under this sub-section is unassignable; the Statute intends it to be a personal remedy; also by the assignment of an invention nothing passes (*l*). The Comptroller is not concerned here with questions of property, but only with the right to have the patent; for example, the beneficiary of an invention or patent cannot prevent the trustee from taking out a patent by saying to the Comptroller that the right to it is his (*m*). Also, there is no need for the opponent to be the first and

(*g*) *Field & Burns' Appn.*, No. 2282 and 2283 of 1910; 20 July, 1911, unrep.

(*h*) *Ibid.*

(*i*) *Gascoigne's Pat.*, 27 R. P. C. 79; *Spiel's Pat.*, 5 R. P. C. 281; *Ed-*

mund's Pat., Gr. P. C. 281.

(*k*) *David & Woodley*, Gr. A. P. C. 26.

(*l*) *Gascoigne's Pat.*, *ante*.

(*m*) *MacNeil & Pearson Fire Appn.*, 24 R. P. C. 680.

true inventor; the words "obtained the invention from him" serve only to identify the invention (*n*).

The opponent must show clearly that the invention was obtained from him or from his agent, or by evidence of notice or estoppel or otherwise must bring the applicant into a legal relation with himself. It will not do if the invention goes through A, B, C, to X, and that X, the applicant, did not know of its origin in A; there must not be a mere casual connection between A and X, but a direct connection or one known to the law (*o*).

Master and Servant.—An invention made by an employee in his employer's time or with his employer's material is the employee's property, and cannot be opposed on this ground by the employer, provided that the employee is the first and true inventor (*p*). It is otherwise if the employment is for the special purpose of the invention. An employee employed for the purpose of making a model or otherwise in his employer's invention cannot take out a patent for the invention: even the improvements which he may suggest in the course of the work are the property of his master. Hence a patent asked for by an employee can be successfully opposed by the employer on this ground; and one of many employers may so oppose alone (*q*). Confidential, friendly relations are analogous to those of employer and employee (*r*). It will go a long way towards proving the opponent's case that the applicant was employed by him, or had the opponent's invention constantly before him (*s*). For the applicant to prove that he has expended original thought on his modification will not alone be a sufficient defence against refusal or the insertion of a specific reference.

It must be remembered that the Comptroller is not here deciding who is the first and true inventor (*t*), and that the allegation "obtained from the opponent" does not necessarily

(*n*) *Re Thwaite*, 9 R. P. C. 515.

(*o*) 27 R. P. C. 1910, A.

(*p*) *Heald*, 8 R. P. C. 429.

(*q*) *David & Woodley*, Gr. A. P. C.

(*r*) *Gascoigne's Pat.*, 22,479 of 1907,

22 July, 1909, unrep.

(*s*) *Hoskins' Pat.*, Gr. P. C. 291.

(*t*) *Ibid.*

imply fraud (*u*). If fraud is alleged it must be alleged particularly, and evidence filed in support (*x*) ; otherwise it will not be considered.

The applicant may be estopped from raising the question of public user, as to the part objected to, if he obtained that part in confidence from the opponent (*y*). And it will be no defence to opposition on this ground to say that the invention obtained from the opponent is not included in the applicant's claims, but is only to be found in the body of his specification ; for the function of the specification is to describe and ascertain the invention (*z*).

Objections taken to the validity of the opponent's patent or the propriety of his grant will not be listened to ; the Comptroller has no jurisdiction to consider the matter (*a*). Such objections must be taken under other sections. If a serious objection of this kind were made, such as an allegation that the opponent's complete contained matter not in his provisional, proceedings could be taken under sect. 26, and an application made for the opposition proceedings to be stayed pending the result of the application.

The following rules were pronounced in *Ashton & Knowles' Appn.* (*b*) :—

1. Where an invention has been obtained from an opponent the novelty of such invention must be considered in the light of prior specifications. If that part obtained from the opponent is wholly anticipated by prior specifications the opposition will fail, though the Comptroller may demand a disclaimer on the part of the applicant.
2. The remedy will differ according to the importance or novelty of the part communicated. It may either take the form of giving a share of the patent to the opponent, or of deleting the part obtained from him, or of making a complete disclaimer of such part (*c*).

(*u*) 27 R. P. C. 1910, A.

(*x*) *Huth's Pat.*, Gr. P. C. 292.

(*y*) *Ashton & Knowles' Appn.*, 27 R. P. C. 181.

(*z*) *Re Hetherington*, 7 R. P. C. 419.

(*a*) *Green's Pat.*, Gr. P. C. 286.

(*b*) 27 R. P. C. 181.

(*c*) See *Thwaite's Appn.*, 9 R. P. C. 515.

3. In the case of prior public user the opponent has no personal remedy. The Comptroller's jurisdiction is then limited to confining the applicant, when necessary, to his special improvements; this is done by disclaimer or omission of the parts publicly used.
4. In the present case, where the opponent submitted a novel design to the applicant, who incorporated it in his specification, the opponent had a *primâ facie* right to protection.
5. The opponent was not disentitled to protection because things were made in accordance with his novel design, and were sold to the applicant and commercially used by him.
6. The applicant was here restricted to claiming the improvements which he had made on the opponent's design.

The Comptroller has no jurisdiction to enter into allegations of communication from abroad, whether fraudulent or not, nor will he consider allegations of fraud abroad (*d*). This follows from the decision of the Courts that, no matter how the applicant got the invention from abroad, he is entitled to be protected as the importer (*e*). There is no reason why a mere importer should not get knowledge of an invention abroad, either before or after a patent has been taken out there, and then forestall the inventor, even if the latter would have been entitled to prior protection had he been prompt (*f*). But, though the Comptroller will not enter into the question of communication from abroad, the applicant must be prepared to give some particulars to establish the contention that the invention was communicated from abroad raised by him as a defence; such as some document to show the communication or the date thereof (*g*). If the applicant

(*d*) *Baird's Pat.*, 5 R. P. C. 286; *McNeil & Pearson's Fire Appn.*, 24 R. P. C. 680; *Edmunds' Pat.*, Gr. P. C. 281; *Re Higgins*, 9 R. P. C. 75.

(*e*) *Ibid.* See also *Edmunds' Pat.*, ante; *Spiel's Pat.*, ante.

(*f*) See also *Everitt's Pat.*, Gr. A. P. C. 28; *Re Lake*, 5 R. P. C. 415; *Higgins' Pat.*, 9 R. P. C. 74; *Johnson's Pat.*, 24 R. P. C. 694; *Meurs Gerkins' Pat.*, 27 R. P. C. 565.

(*g*) *Re Griffin*, 6 R. P. C. 296.

has committed some breach of contract or trust made abroad in endeavouring to take out a patent here, the opponent may take any legal remedy he can for such a breach; but it is not a matter for the Comptroller to consider hereunder (*h*). But if the applicant endeavours to obtain a patent as the representative of the original inventor, and not in his own right, and this is shown to be wholly untrue by the declarations filed, the latter may be heard on this ground (*i*), even though the communication of the invention was from abroad.

Where the Comptroller considers that the opponent did communicate some substantial part of the invention to the applicant, it will be a proper course to seal the patent to both the applicant and the opponent as joint patentees (*k*). If both the applicant and the opponent have made applications in such a case, the best course will be to abandon the smaller application and join both their names in the larger (*l*). And this conclusion of making the parties joint patentees, or of making the applicant assign a share of the patent to his opponent, is often come to (*m*). But if this is done the parties cannot come afterwards and ask for the abandoned patent to be granted to one of them, for their interests are now equal as joint inventors (*n*).

Where opposition was taken under this head (*a*), and it appeared to be impossible to ascertain whether the applicant obtained the invention from the opponent or not, cross conditions were imposed on the applicant and opponent (*o*). But in such cases the grant will be allowed unless the opponent establish his opposition. In these cases the Law Officer will not sanction such terms as an agreement that each party shall make an application unopposed by the other party, for this might be to the damage of the public. But there is no

(*h*) *Edmunds' Pat.*, ante.

(*i*) *Fiechter's Case*, No. 2485 of 1882, considered Gr. P. C. at pp. 283 and 284.

(*k*) *Eadie's Pat.*, Gr. P. C. 279; *Garthwaite's Pat.*, Gr. P. C. 284.

(*l*) *Garthwaite*, ante.

(*m*) *Luke's Pat.*, Gr. P. C. 294.

(*n*) *Ibid.*

(*o*) *Evans & Otway's Pat.*, Gr. P. C. 279; *Garthwaite's Pat.*, Gr. P. C. 285.

reason why he should not adjourn the case to allow such an arrangement to be carried out (*p*).

Sometimes a certain invention may be on the borderland of "patent" and "design"; in such a case, if the opponent has registered a design and the applicant desires to obtain a patent, opposition cannot be taken upon ground (b), but must be taken upon ground (a) (*q*).

In conclusion, the Comptroller ought not to be too astute to see that the part communicated by the opponent to the applicant was anticipated (*r*).

THAT THE INVENTION HAS BEEN CLAIMED IN A COMPLETE SPECIFICATION OF PRIOR DATE (SECT. 11 (1) (b)).

The preliminary question of the right of the opponent to be heard is considered on page 42.

Oppositions on this ground may be divided as follows:—

1. Opposition to a concurrent application.
2. Where a master patent is cited in opposition.
3. Where no claim is made to a master patent and the applicant's and opponent's patents are not concurrent.

1. *Concurrent Applications*.—That is to say, when the opposing patent has not yet been sealed. Opposition on such a patent is usually confined in remedy to the insertion of disclaimers and references. The special practice in such cases for references will be found on page 97. A patent may under sect. 11 be refused when the opposition is only a concurrent application, but such action is harsh and is rarely enforced, since there is no guarantee that the opposed concurrent application will be sealed, and therefore no reason to be sure that the substance of the opposition will continue. Otherwise the opposition of concurrent applications proceeds as an ordinary opposition (see below).

(*p*) *Hatfield's Pat.*, Gr. P. C. 288.

(*r*) *Ashton & Knowles' Appn.*, 27

(*q*) See *Homan's Pat.*, 6 R. P. C. R. P. C. 181.

2. *Where the Opponent Claims to Cite a Master Patent.*—

Where a claim to a pioneer patent is made by the opponent, and therefore a broad construction of the claims is asked for, a clear and definite statement of this and of the subject-matter of the alleged invention should be furnished to the Office and to the applicant. Such a statement should be made either in a declaration under Rule 42 or in a statement under Rule 40. A further statement as to any search or investigation made is not strictly necessary, but the opponents who claim that there is a master patent must be prepared to deal, if challenged, with the prior state of the art, and with any suggested anticipations of the alleged pioneer patent (s). The onus of establishing that, *primâ facie*, the prior patent is a master patent is on the opponents (t). It is open to the applicant or to the Office to produce evidence against the claim to a master patent, and although it does not matter whether the opponents' patent be good or bad, and arguments directed to its validity are irrelevant, it is open to the applicant or to the Office to say, and to produce evidence, that the opponents' patent should be read in a particular way (u), and so to negative the suggestion of a master patent. To negative the suggestion it is permissible to cite foreign publication and specifications (x).

The question of master patent should be considered *quoad* the applicant's process (y); and the question should not be considered narrowly when the applicant shows matter which, saving only for a minimum of invention, is clearly anticipated (z).

Though the opponent hereunder may attempt to show that the patent cited in opposition is a master patent, and that, therefore, a general construction should be given to it which will include the applicant's invention, he cannot merely by the general language of his claims establish that his is

(s) 28 R. P. C. 1911, C.

(x) 28 R. P. C. 1911, C.

(t) *Southwell v. Head*, 16 R. P. C. 361.

(y) *Meyenberg's Appn.*, 22 R. P. C. 353.

(u) *Thornborough & Wilks' Pat.*, 13 R. P. C. 115.

(z) *Sachse's Appn.*, 18 R. P. C. 221.

a master patent. When he does claim that his is a pioneer invention or a master patent he must be ready to support the view by evidence (*a*) (see further p. 94).

3. The special cases of concurrent applications and where a master patent is cited against the applicant are in the above respects apart from other cases; but the following are the *general considerations which apply to all cases of objection on ground (b)*.

A patent on the opposed specification need not have been granted; if when granted the anticipation will be of prior date to the applicant's it can be cited. But *the opposing specification must be a complete*—a provisional will not do—and must be the complete specification for a British patent (s. 11 (1) (b)); foreign applications for provisional protection cannot, therefore, be cited in opposition before a patent is granted on them (*b*).

It is the Comptroller's duty to see that the *public are properly protected*—that is to say, to refuse the patent if it is a mere repetition of a prior patent, or to see that the public are warned in the applicant's specification that the invention of the applicant is foreshadowed in any British patents which indicate it. And in opposition proceedings the Comptroller is entitled to consider the rights of the public apart from those of the opponent: this is more clearly his duty now that the obligation of search is laid upon him (*c*). This is only right when it is remembered that the opponent can always obtain a remedy by means of an infringement action if he does not succeed in opposition, while the public are not in so good a position.

The Comptroller has to decide whether the invention of the applicant has been the subject-matter of a prior claim in this country; therefore it is not his duty to consider *foreign patents*, and these will only be permitted to be cited within very narrow limits (*d*).

(*a*) *Southwell & Head*, 16 R. P. C. 22 R. P. C. 573; *Lorrain's Pat.*, 5 362. R. P. C. 142.

(*b*) *Bailey's Pat.*, Gr. P. C. 269.

(*d*) 28 R. P. C. 1911, C.

(*c*) *Kempton's & Mollan's Appn.*,

The Act declares that the patent on which opposition is based must *claim* the applicant's invention. Hence, if the opponent alleges that by piecing together two or more claims of a prior patent or patents the applicant's invention is arrived at, he will have to establish a particularly clear case before he will succeed. For the combination of the claims may well involve invention (*e*). Hence also, matter in the description and not in the claims of a prior patent is usually irrelevant. Even if it appears that the applicant's specification is, in substance, a repetition of the whole or part of the opponent's specification, save that the claims are different, the application cannot be refused (*f*). In the case quoted a reference by name and number to the opponent's specification was directed, but without any disclaimer. Still less will opposition succeed which asserts that the applicant makes by his process an article, the subject-matter of the prior patent, for the consideration for a patent is the information given to the public in a new method of manufacture (*g*).

It seems, therefore, that if the part objected to is in no way connected with the claims or with the invention claimed, then *primâ facie* the opponent has no *locus standi* under sub-sect. 1 (*b*), and his opposition will be dismissed with costs (*h*). But in exceptional cases matter may be objectionable though unconnected with the claims (*i*). In the words of the Law Officer in *Hetherington's Pat.* (*j*): "I am not bound to seal a patent which bears on its face a statement untrue in fact and injurious to the interests of a person to whom a prior patent had been granted." When the matter complained of relates to the claims, though it is not actually a part of them, the jurisdiction of the Comptroller indisputably arises (*k*); anything in the nature of a disclaimer or of an opening statement does affect the claims; but where the objectionable statement is a statement of prior knowledge

(*e*) *Re Ross*, 8 R. P. C. 477.

(*f*) *Von Buch*, Gr. A. P. C. 40.

(*g*) *Nahnsen's Pat.*, 17 R. P. C. 203.

(*h*) *Wadham's Appn.*, 27 R. P. C.

(*i*) *Teague's Pat.*, Gr. P. C. 298;

Hetherington's Pat., 7 R. P. C. 419.

(*j*) *Ante*.

(*k*) *Wadham's Pat.*, *ante*.

or a statement of the art the opponent should rely on sect. 11 (1)(c), and object that the invention is not fairly or sufficiently described (*l*).

It is not the Comptroller's duty to consider whether the patent asked for is *novel* or will be valid if granted. Therefore it will not do for the opponent to attempt to show that the applicant's patent is *substantially the same* as a former patent, he must show that it has been claimed previously. The words in italics go to good or bad subject-matter, which is not for the Comptroller, and such words must not be included in the notice of opposition (*m*). It is true that if the proposed patent is completely anticipated by a British patent, by common knowledge or by publications and specifications British or foreign, which amount to common knowledge, it will be refused. For this purpose it would be relevant to cite British and foreign matter not otherwise relevant. But such cases are rare, and generally no matter is relevant save British specifications, as it would only go to the question of validity which is immaterial.

If it can be said that the proposed patent is only for an *obvious modification* of a patent cited in opposition, an opposition hereunder will succeed; but if the Comptroller is satisfied that the proposed patent may go further than this—it is not his business to decide that it actually does or does not do so—the opposition will fail (*n*). As to what is a patentable advance, see *Taylor & Scott v. Annand*, 17 R. P. C. 126, and *Hickton's Syndicate*, 26 R. P. C. 339 (p. 23). It is the Comptroller's duty to satisfy himself that the differences claimed by the applicant, to what has gone before, are sufficient to differentiate the patent; otherwise it is his duty to refuse the patent (*o*).

If the applicant's invention is a mere *mechanical equivalent* of a former patent to the extent that there is substantial identity, the grant to the applicant will be refused (*p*).

(*l*) *Wadham's Pat.*, ante.

(*m*) *Jones*, Gr. A. P. C. 34.

(*n*) *Re Sielaff*, 5 R. P. C. 484.

(*o*) *Todd*, 9 R. P. C. 487.

(*p*) *Whitaker*, 13 R. P. C. 580. In the case quoted mechanical equiva-

The Comptroller should consider the doctrine of mechanical equivalents when it bears on the identity of the two inventions (*q*); but it seems not otherwise (see p. 23).

It is not the Comptroller's duty to consider subject-matter or the usefulness or the workability of the invention sought to be protected (r), or of the patents cited in opposition (s), nor any question of infringement, if granted (t). For this reason the notice of opposition (Form 8) must not state that the patent asked for, or material parts thereof, is the same or substantially the same as a patent produced in opposition (u); for it is not for the Comptroller to consider the subject-matter of the patent asked for as relating to anticipations. The Comptroller is not to stop patents at the instigation of an opponent because some general principle of patent law is infringed (x).

In any event, no patent should be refused unless it is perfectly clear that there is no invention disclosed (*y*), and the applicant will have the benefit of a doubt. Thus, in cases where the anticipation of the patent is a matter of scientific controversy, the opponent may obtain a disclaimer, but will not obtain refusal even if the Comptroller is assisted by an expert who advises against the patent (*z*). But in cases where the main claim of the applicant is shown to have been anticipated and the very *minimum of invention* is left, every precaution should be taken to limit the patent to so much of the claim as is in reality invention. In such a case the question of master patent is not to be discussed in any narrow spirit (*a*).

It does not matter whether the patents cited in opposition are good or bad, or that their validity is in dispute (*b*). Yet

lence alone was sufficient for refusal, but it is doubtful if this decision would be followed.

(*q*) *Smith*, 13 R. P. C. 200; *Haythornthwaite*, 7 R. P. C. 71.

(*r*) 27 R. P. C. 1910, D.

(*s*) *Van Gelder*, 9 R. P. C. 325.

(*t*) *Newton*, 17 R. P. C. 125; *Re Sielaff*, 5 R. P. C. 484.

(*u*) *Re Fawcett*, April 16, 1889, un-

rep. Goodeve, 10; *Re Jones*, Gr. A. P. C. 33.

(*x*) *Re Newman*, 5 R. P. C. 271.

(*y*) *Van Wye's Appn.*, 26 R. P. C. 491.

(*z*) *Lake's Pat.*, 6 R. P. C. 548.

(*a*) *Sachse's Appn.*, 18 R. P. C. 221.

(*b*) *Green's Pat.*, Gr. P. C. 286; *Thornborough & Wilks*, 13 R. P. C. 116.

the applicant may cite patents or other matter, not to show the invalidity of the opponent's patent, but to show that the opponent's patent is itself anticipated or is to be construed narrowly. The effect of this will not be to prevent refusal, but to narrow any reference which may be required to be inserted from a specific reference and disclaimer to a general but clear reference without a disclaimer (see p. 90) (c). Or the applicant may cite any matter to show that with reference to prior knowledge the opponent's patent must be read in a particular way, and may urge that the opponent's claim should have a particular construction of two possible constructions put upon it; for otherwise the opponent must have known he was framing an invalid patent, which is unlikely (d).

The question before the Comptroller is: Is there a new and patentable invention in the specification placed before him by the applicant? If parts only are new, he will be able to protect the public by inserting references and disclaimers, and if there is any invention disclosed he will grant a patent. If the opponent's specification does not describe the applicant's invention the applicant is entitled to a patent, if there be no other objection (e); but it does not remove the objection taken by the opponent, that the matter objected to is to be found in the body of the specification only and not in the claims of the applicant (f).

The following decisions will help to show what is sufficient to oppose a grant on this ground. Further examples will be found in Chapter III. (p. 30).

When a particular variation of a prior invention is claimed, it can only be supported when there is a real invention in such an arrangement (g). For example, there was no invention

(c) *Low's Pat.*, 18,628 of 1908, Feb. 21, 1911, unrep.

(d) *Haythornthwaite*, 7 R. P. C. 70; *Thornborough & Wilks*, 13 R. P. C. 115; 28 R. P. C. 1911, C.

(e) *Hill v. Evans*, 31 L. J. Ch. 463.

(f) *Francis' Appn.*, 27 R. P. C. 86.

(g) *Aire & Calder's Appn.*, 5 R. P. C. 345; *Wallis & Ratcliffe's Appn.*, 5 R. P. C. 347; *Todd's Appn.*, 9 R. P. C. 487; *Wylie & Morton's Appn.*, 13 R. P. C. 97; *Van Wye's Appn.*, 26 R. P. C. 491.

in reducing the number of supports of an insulated vessel to a single support, and a patent was refused (*h*).

A patent may be granted for using the best material for an old process, or for the process of the opponent's invention, the suitability of which material was not previously known; but the test is, Does the selection involve invention? (*i*) But the opponent is not necessarily restricted to the things or materials specified by him by way of example (*k*); and where the opponent's patent specifies an alternative use of things no patent can be granted to the applicant for discovering which is the better (*l*). For example, a claim for an armature of non-magnetisable material was not restricted to the materials specified by way of example, and included the use of a special non-magnetisable steel selected by the applicants (*m*). Again, where all the applicant had done was to take one of the many salts of iron and one of the many salts of chromium, from those covered by the prior patent, and use them as they were used in the prior patent and could show no advantage, a patent was refused (*n*). Still, that the opponent's patent is wide enough to include the applicant's is not usually ground for refusal, but is for disclaimer (*o*). The Comptroller must be satisfied before refusing that the prior patentee grappled with the difficulties and dangers grappled with by the later patentee, and that, in claiming a range of processes, the prior patentee had indicated the particular difficulties and dangers of the later patentee (*p*). Further, if the selection made by the applicant is more than mere selection and involves invention, so that particular advantages may be shown, the applicant's patent will not be refused, though some sort of reference may be inserted (*q*).

Again, if the patent cited in opposition specifies a certain

(*h*) *Van Wye, ante*.

(*i*) *Bosch's Appn.*, 26 R. P. C. 710.

(*k*) *Deutsche Gasgluhlicht*, 26 R. P. C. 101; *Lane Fox v. Kensington*, 9 R. P. C. 419.

(*l*) *Bosch's Appn.*, *ante*; *Deutsche Gas.*, *ante*.

(*m*) *Bosch's Appn.*, *ante*.

(*n*) *Wylie & Morton*, 13 R. P. C. 97.

(*o*) *Nahnsen's Pat.*, 17 R. P. C. 203.

(*p*) *Wylie & Morton*, 13 R. P. C. 97; *Nahnsen's Pat.*, *ante*.

(*q*) *Hills v. London Gas Co.*, 1 Goodeve, P. C. 244, [1884].

thing "A," and the applicant specifies by way of example a patentable variation of that thing "B," but claims generally a class of things to which both "A" and "B" belong, the opposition will succeed (r). Similarly, there will be no invention if the applicant's form of a machine is nothing more than a new disposition or spacing of the opponent's parts; for example, where the opponent had used certain rollers in a patented machine at distances apart of between $\frac{7}{8}$ " and 14", this fact was held to be conclusive against an applicant who wished to take out a patent for the machine with rollers at a distance of $2\frac{1}{2}$ ", though the opponent's specification did not specify this distance (s).

As has been pointed out, a combination is patentable if a new object be attained though the parts of the combination are old. But if the applicant puts forward a combination claim which is patentable but the parts of which are anticipated and the combination claim is badly expressed, the claim will be amended on opposition. Thus, "I claim A, B, C, and D combination" is a loose form of combination claim, and does not show how much is in the combination, and may be required to be altered to, "I claim the combination of A, B, C, D" (t). But there is no invention, and the application will be refused if the old parts of the combination are to possess their old functions in combination (u).

It may be that, if there are certain operations performed in the opponent's process which are not found in the applicant's process, there is no ground for refusal or for a reference (x); but this must not be taken to extend to a mere omission.

The opponent opposing on this ground may point out that a claim of the applicant is mere repetition without invention;

(r) *Heath & Frost's Pat.*, Gr. P. C. 288, where "A" and "B" were semi-fluid compounds, and the applicant's claim was for a gelatinous compound.

(s) *Kay v. Marshall*, 2 Webs. 34.

(t) *Stell's Pat.*, 8 R. P. C. 235.

(u) *Bridge's Appn.*, 18 R. P. C. 257, following *Gaulard & Gibbs*, 7 R. P. C. 367; see also *Morgan v. Windover*, 7

R. P. C. 131; *Thomas & Prevost*, 15 R. P. C. 257; *Crane v. Price*, 12 L. J. C. P., 81; *Murray v. Clayton*, L. R. 7 Ch. 570; *Hinks v. Safety Co.*, L. R. 4 Ch. 607; *Maxim & Silverman's Pat.*, 11 R. P. C. 314.

(x) *Meyenberg's Appn.*, 22 R. P. C. 353.

as where a second claim claims the use of the invention in an old way and there is no invention in this manner of use (*y*).

It will be seen from what has gone before that the general rule is that the opponent can only obtain relief under subsect. (1) (*b*), if he can show that the whole specification of the applicant when read together, description and claims, puts forward an invention which, either wholly, partly, or in some definite way, is embodied in, foreshadowed by, or dependant on a prior specification (*z*). He will obtain refusal of the grant to the applicant only where there is no difference amounting to invention between the applicant's and the prior patent (*a*); otherwise he will obtain disclaimer or amendment of the applicant's specification.

THAT THE NATURE OF THE INVENTION IS NOT SUFFICIENTLY OR FAIRLY DESCRIBED OR ASCERTAINED (SECT. 11 (1) (*c*)).

The interest to be established before the opponent can be heard is treated on page 42.

The invention will not be fairly and sufficiently described if the specification contains misleading or irrelevant matter, and will then also offend against sect. 3 (1) and Rule 14 (*b*). The case which the opposition must establish on this ground will always depend on the particular circumstances of each opposition.

DISCONFORMITY OF THE PROVISIONAL AND COMPLETE SPECIFICATIONS (SECT. 11 (1) (*d*)).

The opponent can only rely on disconformity if the invention claimed in the complete, but not claimed in the provisional or foreshadowed therein (*c*), has been the subject of an application made by him in the interval between the leaving of the applicant's provisional and complete specifications. As soon

(*y*) *Re Webster*, 6 R. P. C. 163; see p. 27.

(*z*) *Wadham's Appn.*, 27 R. P. C. 172; 26 R. P. C. 1909, VII.

(*a*) *Smith*, 13 R. P. C. 200.

(*b*) *Wadham's Appn.*, 27 R. P. C. 172.

(*c*) *Edwards' Pat.*, 11 R. P. C. 461.

as these conditions are established, the Comptroller must consider whether the patent ought to be allowed (*d*). He must consider the matter carefully, as his decision to grant the patent will affect the question of disconformity if subsequently raised in the superior Courts (*e*). When the opponent's and applicant's provisional specifications are left on the same day it cannot be said that the opponent's was left in the interval (*f*). The object of the sub-section is to prevent a patentee getting a prior date for an invention which is not his own and which he has obtained from an invention of later date: this would not occur in such a case as where the specifications were left on the same day (*g*).

Fair development of the complete from the provisional cannot be objected to (*h*). It should be remembered that one of the reasons for the time allowed between the filing of the provisional and the complete specifications is to allow the applicant to cut down his claims to a proper form (*i*). The opponent will succeed if, and if only, it is decided that the part of the complete specification objected to is not fairly within or a fair development of the provisional specification (*k*).

It will not help the patentee who is opposed on the ground of disconformity that he has included matter in the complete to colour his divergence from the provisional to the form of a resemblance; it will not assist him to feed his complete specification for this purpose (*l*).

(*d*) *Arthur Hudson's Pat.*, 22 R. P. C. 218; *Edwards' Pat.*, 11 R. P. C. 461.

(*e*) *Arthur Hudson's Pat.*, *ante*.

(*f*) 27 R. P. C., 1910 A.; 26 R. P. C., 1909, I.

(*g*) *Ibid.*

(*h*) *Edwards' Pat.*, *ante*, *Gaunt &*

Greenhalgh, 14 R. P. C. 387.

(*i*) *Miller & Millar*, 15 R. P. C. 718.

(*k*) *Re Birt*, 9 R. P. C. 489.

(*l*) *Arthur Hudson's Pat.*, 22 R. P. C. 218.

CHAPTER V.

AMENDMENTS.

THERE are various occasions when amendments may be asked for and required. The sections treating amendments particularly are sects. 21 and 22, and provide for amendments made at the request of the patentee; but amendments may also be required or asked for in the course of other proceedings discussed in this volume. The object of amendments made under sects. 21 and 22 is to prevent the patentee being robbed of his grant by his misfortune in having infringed technicalities or not expressed his meaning (*a*).

The general principle of amendment is that the patentee may be allowed to improve his position as regards third parties, but that it would be unfair to allow the patentee to improve his position as regards a present adversary (*b*). Sect. 21, therefore, provides that amendment may not be made by application to the Comptroller when any action for infringement or legal proceeding is before the Court. Amendment can then be made only by order of the Court.

There are therefore three broad classes of amendment:—

- (1) Those applied for by the patentee under sect. 21.
- (2) Those applied for by the patentee under sect. 22.
- (3) Those required by the Comptroller, or offered by the applicant and accepted by the Comptroller, in the course of application, opposition or revocation proceedings.

(*a*) *Re Hall & Others*, 5 R. P. C. 309.

(*b*) *Bray v. Gardiner*, for R. P. C. 43; *Perry v. Skinner*, 1 Webs. 250.

(1) AMENDMENTS APPLIED FOR BY THE PATENTEE AND
CONSIDERED BY THE COMPTROLLER.

Sects. 21 and 22 provide that the applicant may apply to amend any part of his specification by way of DISCLAIMER, CORRECTION, OR EXPLANATION; but while infringement or revocation proceedings are before the Court the amendment must be made by order of the Court, and the amendment then must only be by way of disclaimer.

No amendment in any case will be permitted which would make the invention claimed in the amended specification substantially larger or different from that claimed in the un-amended specification (ss. 21 & 22). Neither, on the other hand, can an amendment be allowed which would elevate what was before a matter of detail into the main claim (see p. 67, 77).

An application to amend may be opposed by any one in the Comptroller's opinion entitled to be heard. And, to inform possible opposition, the Comptroller must advertise the application to amend in accordance with Rule 60.

Manner of Applying to Amend.—A request (Rule 60) for leave to amend must be made on Patents Form No. 17 and signed by the applicant or the registered proprietor of the patent, and must be accompanied by a certified printed copy of the specification showing clearly in red ink the proposed amendments. A printed copy of any published specification may be obtained from the Patent Office, 25, Southampton Buildings, W.C., price 8d., including inland postage. The fee for certifying the printed copy is one shilling. Care should be taken to indicate clearly what part of the printed description it is proposed to omit, and at what points inter-lineations are to be inserted. Additional matter which cannot be written upon the printed copy should be written upon a separate sheet and attached to the print.

It should be remembered that the proposed amendments, whether allowable or not, are made public and advertised (Rule 60), and that this publication may be a bar to obtaining

a valid patent for matter disallowed by way of amendment. No amendment of a provisional specification is allowed under sect. 21; but clerical errors therein may be corrected.

Anyone wishing to be informed as soon as an application for amendment of a specification is entered, should forward a Patents Form No. 31 with a request for such information.

A notice of opposition (Rule 61) to the amendment of a specification must be made on Patents Form No. 18, and must be accompanied by a unstamped copy, which the Comptroller will transmit to the applicant.

As to further proceedings and evidence, see Rules 62 to 65; the procedure is the same on opposition to amendment as on opposition to a grant. The Comptroller may require the successful applicant to leave a new specification and drawings as amended (Rule 66). The amendment will be advertised by the Comptroller (Rule 67).

GROUND OF OPPOSITION TO THE AMENDMENT AND LOCUS STANDI OF THE OPPONENT.—The grounds of opposition to amendments are not defined in the Act, as are the grounds of opposition to a grant, and therefore an opponent may fill in his Form 18 and oppose on any grounds he thinks fit. If his opposition is considered by the Comptroller to be frivolous or irrelevant the remedy will be to penalise him in costs.

Sub-sect. 6 of sect. 21 provides that no amendment shall be granted which would make the amended specification claim an invention substantially larger or different from the unamended specification; but this is not to be taken as excluding other grounds of opposition (*c*); for delay in amending, where used for such purposes as the issue of threats (*d*), or the damage of trade (*e*); or indefiniteness of language (*f*); or the extensive nature of the amendment; or that the amendment involves the re-writing of the specification (*g*), are all good grounds of opposition.

But the opposition is confined to opposition *to the amendment*, and an opponent may not under pretence of opposing

(*c*) 28 R. P. C. 1911, A.

(*d*) *Ainsworth's Pat.*, 13 R. P. C. 76.

(*e*) *Allison's Pat.*, 15 R. P. C. 409.

R.P.

(*f*) *Parkinson's Pat.*, 13 R. P. C.,

509.

(*g*) *Nairn's Pat.*, 8 R. P. C. 444.

the amendment set up an opposition which would properly come under sect. 11 as an opposition to the grant. Thus opposition to the amendment on the ground that the amended patent would be anticipated by prior patents will not be listened to, particularly if the opponent has no interest in the prior patent cited (*h*). Such an opposition should have been taken before under sect. 11 (1) (*b*), and if it is only possible to take it on amendment by reason of the addition of new matter to, or alteration of, the specification, the opponent is protected by the proviso that amendment shall not make the patent different from what it was before.

That the patent has been held by the Court to be void is in itself no ground for opposing an amendment, for the object of amendment is to allow a patentee to make good his patent; but in the case where the patent has been held to be void for want of subject-matter, it seems from sect. 21 (6) that an amendment should be refused (*i*). If the House of Lords (or the Court) has arrived at the conclusion that the matter described in the specification is not proper subject-matter for a patent, then an amendment ought not to be allowed (*k*). But if it has been decided that the claims are bad, the patentee may be allowed to excise or amend them. In this connection it would seem that the Comptroller's discretion is not fettered by the decision of any Court, though such decision should be followed or considered by him (*l*), and though he is bound by the construction put on the specification by the Court (*m*).

The Law Officer is the final authority to decide whether a person is entitled to be heard in opposition to an amendment (*n*); and he cannot be controlled by mandamus of the High Court. Any person who will be injuriously affected by the amendment may oppose. A very slight, if *bonâ fide*, interest is sufficient.

(*h*) *Bell's Pat.*, Gr. A. P. C. 10.

(*i*) 28 R. P. C. 1911, A.

(*k*) *Hennebique's Pat.*, 28 R. P. C.
41.

(*l*) *Ibid.*

(*m*) *Parkinson's Pat.*, 13 R. P. C.
509.

(*n*) *Ex parte Tomlinson*, 16 R. P. C.
233.

SCOPE AND LIMIT OF THE AMENDMENT.—The Comptroller or Law Officer has the power to allow an amendment, whether of the letterpress of the specification or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification (*o*). Whether the amendment be opposed or not, the following are the considerations and rules upon which it will be allowed or refused.

In amendment cases the Comptroller will deal with the specification in the same way as he deals with it in opposition cases under sect. 11 (*q.v.*). There, though subject-matter is not directly considered, if, after clearing away anticipated matters, nothing but detail and common general knowledge remains, the patent is refused. Thus, where the principal claim is for an at present unclaimed invention, a minor claim may pass unnoticed without suggestion of anticipation; but if then the main claim is sought to be amended away, and what was previously a minor detail becomes the whole invention, it may require greater consideration in the light of prior knowledge before it is allowed (*p*). The public rely on the Office to examine into the state of the art before grant, and this will extend to certain cases of amendment (*q*).

In all applications to amend it must be remembered that it rests with the applicant to take the responsibility in case the proposed amendment will invalidate the patent (*r*). While it is the Comptroller's duty to see that the amendment does not make the patent substantially larger or different from the original specification, and if there is "fairly clear and substantial evidence" that the result of the amendment will be to do so, the Comptroller or Law Officer ought to decline to allow the amendment. Yet if there is any doubt the amendment ought certainly not to be disallowed, for the patentee may thereby be deprived of valuable right (*s*).

Amendments are never granted as a matter of course, and

(*o*) *In re Lang*, 7 R. P. C. 469, *per* Clarke, S.-G.

(*p*) 28 R. P. C., 1911, A. (see p. 77).

(*q*) *Ibid.*

(*r*) *Lake's Pat.*, Gr. A. P. C. 16, *per* Webster, A.-G.

(*s*) *Ibid.*

they must be amendments in the real sense; they must not amount to a re-writing of practically the whole specification and the formation of some new claim (*t*). The applicant must not alter the scope of his invention by amendment (*x*). If a specification claims generally a certain set of operations without specifying the details, and it is proposed to amend by inserting all the details of a particular set of these operations in the description, but not to claim this particular set in the claims, the amendment will not be allowed; for it is not explanation or disclaimer, but is a re-writing of the specification (*y*). Further, an amendment is not to be used solely for the purpose of turning an insufficient into a sufficient specification, though it is its proper function to clear up ambiguities (*z*). But where there is some large amendment asked for which in the ordinary course would be refused, the applicant may obtain the amendment if he satisfies the Comptroller that it arises from some mistake for which he is not to blame, as a mistake in writing out the description. Such circumstances are particularly applicable to foreign communications, where errors of translation are difficult to check. These circumstances must be clearly established, and the Law Officer must be satisfied that the mistake was an original mistake (*a*). The alteration of a phrase, such as the alteration of "process for" to "manufacture of," will sometimes be disallowed: in this case the objection is that the latter phrase is wider (*b*).

The words "disclaimer, correction, or explanation" refer to disclaiming or correcting something which was wrongly inserted, or to explain something which requires explanation having regard to the specification as first filed, subject to the proviso that the amendment must not make the invention larger or different (*c*). The limits of disclaimer, correction, or explanation are considered below (p. 75 *et seq.*).

(*t*) *Crist's Appn.*, 20 R. P. C. 475;
Thomas & Prevost's Appn., 16 R. P. C.
 71.

(*x*) *Johnson's Appn.*, 26 R. P. C.
 780.

(*y*) *Nairn*, 8 R. P. C., 444.

(*z*) *Johnson's Pat.*, 13 R. P. C. 661.

(*a*) *Ibid.*

(*b*) *Vidal's Pat.*, 15 R. P. C. 721.

(*c*) *Johnson's Pat.*, 13 R. P. C. 660.

Amendments are liable to the same objections as is the matter of an application; thus, for example, an amendment may not claim a new advantage of an old apparatus (*d*). But sometimes statements which might have been allowed in the original application will be improper as amendments: thus an amendment pointing out the defects of a prior patent will not be allowed (*e*).

It is not conclusive, in answer to the objection that the amendment makes the invention claimed "larger or different," to say that the claims have not been altered, for the claims may be so wide as to cover entirely fresh matter inserted in the description (*f*). The insertion of a qualifying adjective before the words defining the invention may not only correct or explain, but may enlarge or make different, and so be disallowed, *e.g.* the addition of the word "adjustable" may not be allowed, as it may import an idea not originally embodied in the invention (*g*).

Amendments are granted when there is a defect in the specification, but the defect must be consistent with the patentee intending to fulfil the conditions of the grant by properly describing his invention (*h*). But when the defect in the specification is the invention itself, or the invented element of an otherwise old combination is found to be old also, and then an attempt is made to disclaim the invention of an old element and retain an amended patent for something which is now seen to be no novelty or novel combination, the amendment will be refused, as it would so lay claim to an invention different from that originally claimed (*i*). In the case quoted the applicant had a patent for what he thought was a new construction of wire rope in combination with an old machine: he then found that the construction was old, and failed when he attempted to amend by disclaiming the novelty of the rope construction.

(*d*) *Parkinson's Pat.*, 13 R. P. C. 509.

(*e*) *Hampton & Facer*, Gr. A. P. C. 13.

(*f*) *Lake*, Gr. A. P. C. 16.

(*g*) *Walker*, Gr. A. P. C. 22.

(*h*) *Nordenfelt*, Gr. A. P. C. 19.

(*i*) *Re Lang*, 7 R. P. C. 469.

Since the decision in *Moser & Marsden* (*k*) the Comptroller has been more particular about allowing amendments, since that case decided that his decision or the Law Officer's is final. Formerly it was the practice to give the applicant for amendment the benefit of the doubt (see p. 85).

CONDUCT OF THE PATENTEE.—It is material in amendment proceedings to consider the intention of the patentee at the time of filing his complete specification: the patentee should make a declaration showing what his intention was at that time if he wishes it to be considered. Thus, if the patentee desires to disclaim certain parts and it is shown that, at the time of filing the complete, he set great store by those very parts, there is good ground for saying that the proposed disclaimer will make the invention different and for refusing it (*l*). Or if the patentee desires to amend by way of correction or explanation, then, if his specification is ambiguous, his intention at the time of filing his specification is relevant (*m*). But the intention of the patentee will not be sufficient to make possible the substitution of a claim by an entirely different claim (*n*); and it is in all cases better to come to the conclusion on the documents, if that be possible, than to rely on evidence of the patentee's intention (*o*).

The fact that the patentee has called things by their wrong names is not to be taken against him in amendment proceedings (*p*). Whether the patentee has filed a provisional or a complete in the first instance may be a point to be mentioned; for if the invention is in such an advanced stage as to warrant a complete, amendments of a wide character should not be necessary. It is the patentee's duty to describe his invention as precisely as possible, and he should have made clear the nature of the invention in his original claims. And he will not be allowed to make out a different invention, from that first disclosed, by amending; nor will be allowed to insert an amendment selecting or describing in detail some of

(*k*) 13 R. P. C. 24 [1886].

(*l*) *Alsop's Pat.*, 24 R. P. C. 684.

(*m*) *Johnson's Appn.*, 26 R. P. C. 780.

(*n*) *Allen*, Gr. A. P. C. 3.

(*o*) *Ashworth*, Gr. A. P. C. 6.

(*p*) *Johnson's Pat.*, 13 R. P. C. 661.

the alternative devices, originally specified, which he now finds work better; though he may disclaim those which he finds will not work at all (*q*). It is clear that a sufficient description in the first instance is necessary in order to obtain amendment, as others who act upon the original specification may be damaged by a subsequent amendment which alters the whole character of the specification.

If the patentee has delayed to amend while using the unamended patent for the purpose of issuing threats or to the damage of trade (see page 72), or if he has deceived another into constructing a business because his specification as unamended was obviously bad, leave to amend will be refused or special conditions will be enforced to the amendment (*r*). Even if the patentee has merely delayed to amend so that he is asking for the amendment of an old patent the amendments allowed will be narrow (*s*). But if the patentee seeks to amend immediately after the Court has pronounced his patent to be bad, there will be a *primâ facie* indication that the patentee has not allowed trade to be set up in the face of a patent which he knows to be bad (*t*). It requires a strong case to amend an old patent, for the Comptroller must be satisfied that the mistake sought to be amended was an original mistake. He must try to put himself in the position of the patentee at the time of filing his unamended specification (*u*).

The patentee's reasons for asking for an amendment are a part of his request, but such reasons are not usually relevant to the question of allowing the amendment (*v*).

RESULTS OF AMENDMENT PROCEEDINGS.—In applications to amend, the Comptroller may call for disclaimers or references or other amendments in the interests of the public; he may also impose conditions to the grant of the amendment by sect. 21 (4); the conditions may be of any sort (*x*).

(*q*) *Nordenfelt*, Gr. A. P. C. 19 (see p. 3).

(*r*) *Hennebique's Case*, 28 R. P. C. 41; *Allison's Pat.*, 15 R. P. C. 408.

(*s*) *Morgan*, Gr. A. P. C. 17.

(*t*) 28 R. P. C., 1911, A.

(*u*) *Johnson's Pat.*, 13 R. P. C. 661. It is doubtful if this is good law.

(*v*) *Ashworth*, Gr. A. P. C. 6.

(*x*) 28 R. P. C., 1911, A.; *Ainsworth's Pat.*, 13 R. P. C. 76.

Sect. 21 (5) makes this jurisdiction to impose conditions clear. Sect. 23, which restricts the recovery of damages by the patentee to damages for the infringements committed after amendment, unless he has framed his original claim with reasonable skill and knowledge, is always a term of the amendment granted, and the Comptroller may impose further conditions (*y*).

Certain conditions should not be imposed on amendment. A condition that the amended specification is not to be used in a future action is one of these, because sect. 23 makes such a condition unnecessary, and because the Court can do everything to protect the opponent (*z*). But if the Comptroller is satisfied that the patentee has been acting so as to obtain a monopoly larger than the amended specification claims, for instance, by obstructing trade or by issuing threats, special circumstances will have arisen which make such a condition allowable (*a*). Conditions protecting the opponent from attack or interference will not be attached to the grant of an amendment without the consent of the applicant, except under special circumstances, as when the patent had been used to obtain a monopoly greater than that claimed by the specification as amended. For example, if the patentees have been threatening and endeavouring to prevent persons from making what was within the unamended but not within the amended specification, a proper condition would be that no action should be brought for anything done at any time before the amendment (*b*). And where the applicant has allowed the opponent to build up a big business on the obvious weakness of the applicant's unamended patent, sufficient causes for such a condition will again arise (*c*). If the opponent had notice that the patentee intended to amend or disclaim, a condition protecting him will not be inserted (*d*). If the applicant has delayed to amend after the patent has

(*y*) *Allison's Pat.*, 17 R. C. P. 301, 516.

(*z*) *Davies' Pat.*, 28 R. P. C. 50; *Ainsworth's Pat.*, 13 R. P. C. 76.

(*a*) *Ashworth's Case*, Gr. A. P. C. 6; *Dixon's Pat.*, Eng. Rep. [1881], 16.

(*b*) *Ashworth*, Gr. A. P. C. 6.

(*c*) *Allison's Pat.*, 15 R. P. C. 409; but see *Allen's Case*, Gr. A. P. C. 3; *Ashworth*, ante; *Ainsworth's Case*, 13 R. P. C. 76, for special circumstances; *Cheesbrough Pat.*, Gr. P. C. 303.

(*d*) *Cheesbrough Pat.*, ante.

been declared bad by the Court, a condition will be inserted protecting manufacture in the interval; but the patentee is entitled to have particulars of the extent of the manufacture in the interval (*e*).

The following opposition cases show the principles applicable to the conditions imposed in amendment cases: *Van Wye's Appn.*, 26 R. P. C. 490; *Bridge's Appn.*, 18 R. P. C. 257; *Hedge's Appn.*, 12 R. P. C. 136; *Lupton & Place's Appn.*, 14 R. P. C. 261; *Ashworth*, Gr. A. P. C. 6.

The Comptroller can now order the applicant to pay money to the opponent by way of condition on the amendment; formerly he could not do so, but since 1907 he has a general power over costs which alters the matter (*f*). Conditions affecting the payment of the costs of prior distinct proceedings will never be inserted; the Comptroller is in no way concerned with such a matter (*g*).

Before the insertion of conditions it must be remembered that, although the patentee may desire to amend, perhaps because he feels that it would be unsafe to go into Court on his specification before amendment, it does not follow in the least that he has not a very meritorious invention. Therefore sympathy should not be extended to, and conditions imposed for the advantage of, persons who have been availing themselves of those defects in the patentee's specification which the law allows to be amended (*h*). If such persons have only availed themselves of the part of the unamended specification removed by amendment, or have not infringed the real invention, they will be safe without the insertion of conditions.

Under the old practice, when the application to amend was made when an action was pending by leave of the Court to apply to the Comptroller, the Comptroller made no condition as to the use of the amended specification in the action before the Court, for the Court would do so if necessary (*i*). But other conditions were imposed in these cases (*k*),

(*e*) *Westinghouse Pat.*, Gr. P. C. 315.

(*h*) *Ashworth*, Gr. A. P. C. 6.

(*f*) See *Pietschmann's Pat.*, Gr. P. C. 314; sect. 39 of 1907.

(*i*) *Hearson's Pat.*, Gr. P. C. 266.

(*g*) *Bell*, Gr. A. P. C. 10.

(*k*) *Hearson's Pat.*, 1 R. P. C. 213.

though usually for the above reason conditions were not imposed (*l*). Special circumstances had to be shown which were not constituted by delay in applying to the Comptroller, or by the Court imposing the conditions asked for up to the time at which liberty to apply had been given (*m*). When there were two or more opponents, conditions were inserted affecting each of them separately (*n*).

PARTIES UNDER SECT. 21.—The applicant or the patentee must be the party seeking to amend. There is little difficulty in determining whether a party claiming to be the applicant is or is not the “applicant”; the “patentee” presents more difficulty. The word patentee is defined for the purposes of the Act in sect. 93, and was further explained in an amendment case to mean—any person or persons who can lawfully claim, by any act or assurance known to the law, an actual interest in or right to the monopoly granted. Not only the beneficial owners are included, and the definition, though it would not include an exclusive licensee, would include the owner of an equitable interest (*o*).

In applications to amend, therefore, it may be objected by the opponent or the Office that the right parties, or all the right parties, are not appearing. All who have an interest should join in the application. It is enough, however, if the Comptroller is satisfied by clear evidence of the assent of all the parties interested. If he is not so satisfied, he should delay the proceedings until he is clear that all the parties who should be are before him. Where the application is originally made by one party, and is thus defective for want of parties, but, while pending, the unjoined party, by contract or otherwise, drops out, then such an application is not bad *ab initio*, and as it has been made good it may proceed (*p*).

It should be remembered that a person may be entitled to be joined as a party in amendment proceedings and yet, owing to neglecting to see that he is registered under

(*l*) *Pitt's Pat.*, 18 R. P. C. 480;
Allen's Pat., Gr. A. P. C. 3.

(*m*) *Pitt's Pat.*, *ante*.

(*n*) *Codd's Pat.*, Gr. P. C. 305.

(*o*) *Goldstein's Appn.*, 27 R. P. C. 289.

(*p*) *Ibid.*

sect. 71 (1) or (2), render himself liable to be disregarded under s. 71 (3).

DISCLAIMER, CORRECTION, OR EXPLANATION.—It should be remembered that if the applicant applies to amend by way of disclaimer it can be objected that his proposed amendments are by way of correction or explanation, and similarly *mutatis mutandis*. In the application under sect. 21 leave to amend the notice of amendment will usually be granted, and the difficulty so cured. But in the case where amendment is asked for by order of the Court under sect. 22, during legal proceedings, the objection if established is incurable; since amendments can be only made thereunder by way of disclaimer. It is therefore material to consider what are the distinctions between and limits of the expressions “disclaimer, correction, and explanation.”

Amendment by Disclaimer.—Some cases of disclaimer do remove objections to the validity of the specification, which is the purpose for which amendments are granted; but it is not every disclaimer which will be allowed. A disclaimer is distinct from and does not include a correction or an explanation (*q*). The patentee cannot be allowed to disclaim the major part of his invention so that he only claims after amendment what was before a mere matter of detail (*r*). He may be allowed to excise claims while not allowed to excise description (*s*). Nor may the patentee disclaim down to an obvious alternative, so as to leave no subject-matter at all (*t*). But there is no reason why he should not disclaim any amount of his invention if what is left is invention and was a part of his original specification (*u*), and he may disclaim any amount of theory which he has put forward (*v*). The disclaimer may be too extensive, so that it would amount practically to re-writing the specification, and in this case it would

(*q*) *Owen's Pat.*, 15 R. P. C. 759.

(*r*) *Alsop's Pat.*, 24 R. P. C. 684; *Crist's Appn.*, 20 R. P. C. 475; but see *Ralston v. Smith*, 11 H. L. Cas. 233; *Lang's Pat.*, 7 R. P. C. 469; *Re Serrell*, 6 R.P. C. 101

(*s*) *Alsop, ante*.

(*t*) *Heath & Frost's Pat.*, Gr. P. C. 311.

(*u*) *Dellwick's Pat.*, 15 R. P. C. 682.

(*v*) *Ibid*.

not be allowed. Thus where the patentee has claimed an improved method, originally without specifying the particular means, he cannot be allowed to come and say that he will disclaim his general method and proceed to specify all the particular means he can think of by way of amendment (x). Amendment by disclaimer under sects. 21 or 22 is not confined to a disclaimer affecting the claims; other matters of the specification may also be disclaimed (y). A party must not claim and disclaim in the same breath (z). Amendment by disclaimer cannot be used to turn an insufficient into a sufficient description (a). It is not amendment, by way of disclaimer, to substitute for a claim for an improved general method of construction, so as to obtain a product thought to be new but actually old, a claim for the use of old machinery to obtain this product. That the machinery had never before been used for this purpose does not alter the case (b). Such an amendment would not be allowed indeed by way of correction or explanation.

When it is proposed to strike out one element in a specification it is very material to consider whether that element has been claimed separately; if so, it may be struck out; but if it is claimed in a combination claim and it is of real effect in the combination it cannot be disclaimed. "If you have got a claim for A, B, C, D, E and F, and you confine it to F, that is a narrower claim than the original, and it is not different because it is included in the old claim" (c). In this case the inventor sought to substitute a claim for a particular article, for a claim for a general type, and the statement of the S.-G. above must be read in conjunction with what follows here. This decision was explained in *Hattersley & Jackson* (d), as follows. In *Cochrane's Case* A, B, C, D and F

(x) *Nairns' Pat.*, 8 R. P. C. 444.

(y) *Woolfe v. Auto Picture Gallery*,
19 R. P. C. 425; 20 R. P. C. 183.

(z) *In re P.'s Appn.*, 23 R. P. C.
644.

(a) *Johnson's Pat.*, 13 R. P. C. 659.

(b) *Re Lang*, 7 R. P. C. 469.

(c) Davey, S.-G., in *Cochrane's Pat.*,
Gr. P. C. 304.

(d) 21 R. P. C. 233.

referred to different forms and shapes of the articles claimed; an amendment is then clearly allowable. Thus a claim to an article of general shape may be confined to a claim to the article with a particular front and back; but when A, B, C, D, E and F are distinct articles claimed in combination, it will not be disclaimer to strike out all but F, unless a claim to F alone was contemplated in the original specification. Where two things are originally claimed separately it will usually be a proper amendment by disclaimer to combine the two claims into a combination claim. There can be no doubt that this is limitation; the only question that can arise is, Does it make the invention claimed different? (e) Such amendment is allowable if the two features were clearly intended to be used together (f); but the amendment will not be allowable if the combination does not seem to have been meditated in the unamended specification, for the proposed amendment may make the invention different. As has been pointed out, if the amendment proposed is the simple deletion of one of the original claims it may be improper, as widening the scope of the invention; for the deletion of one claim may cause another claim to appear a much more general statement than it was in combination (g). So that such amendments as striking out a member A of the two claims for A and B, or the substitution of a combination claim A B for A and B, are allowable if nobody could claim before the amendment what the patentee now wishes to claim. It may be said that if this amended claim was within the scope of his original specification it will be allowed, and that such amendments are *primâ facie* allowable (h).

The object and limit of a disclaimer was stated in an early case to be as follows: "Amendment by disclaimer cannot be made use of for the purpose of converting a barren

(e) *Hattersley & Jackson, ante.*

(g) *Hattersley & Jackson's Pat.,*

(f) *Goldstein's Pat.*, 27 R. P. C. *ante.*

(h) *Ibid.*; see p. 67.

289; *Kelly v. Heatham*, 7 R. P. C. 343; 45 Ch. D. 256.

and unprofitable generality in a specification into a specific practical description, nor to convert that to which the description in the specification is not applicable, in any definite form, into a description applicable to a specific and definite mode of proceeding. The object of the Act authorising disclaimers is—that where a specification containing a sufficient and good description of a useful invention is imperilled by reason of the description having something annexed to it which is capable of being severed, leaving the original description good and sufficient, without the necessity of addition (except of such slight additions only as may be required to render intelligible that which remains), the vicious excess may be lopped off by a disclaimer” (i).

Amendment by Correction or Explanation.—What is intended to be the subject of amendment under the term “correction” scarcely needs elaboration, and appears sufficiently from what has gone before and from what comes immediately below. Put shortly, the questions which the Comptroller must consider are (j) :—

What in fact was the invention ?

What was the intention of the patentee when he filed his specification ? (k)

And next: Has he used ambiguous words which he can reasonably ask to amend ?

And finally : Would the proposed amendment make him claim an invention substantially larger than or substantially different from the invention claimed ?

The amendment is not allowable by way of *explanation* when, by means of it, an endeavour is made to put in subsequently ascertained knowledge or knowledge ascertained in the working of the unamended specification (l).

LIMITS OF JURISDICTION UNDER SECT. 21.—The sub-section states that the jurisdiction of the Comptroller ceases when

(i) *Ralston v. Smith*, 35 L. J. C. P. 49; 11 H. L. C. 223.

(j) As stated in *Johnson's Appn.*, 26 R. P. C. 780.

(k) See also *Beck & Justice*, Gr. A. P. C. 10.

(l) *Beck & Justice*, ante.

any action for infringement or other proceeding is *before the Court*.

It was doubted in *Deeley's Patent* (m) whether the Comptroller can go on with an amendment application when revocation proceedings, commenced subsequently to that application, are before the Court. In this case no rule binding on the Comptroller was expressed; but in *Woolfe v. Auto Picture Gallery* (n) it was decided that such proceedings or other proceedings, as for infringement, do not suspend the right of the patentee to apply to amend under sect. 21, if those proceedings are commenced after the application to amend. An amendment may be made by the Comptroller under sect. 21, in spite of sub-sect. 8, when proceedings are pending before the Comptroller or Law Officer. Such proceedings are not proceedings before the Court (s. 92 (1)). So that when an opposition proceeding is pending a patentee may apply to amend before the hearing of the opposition and may have his application to amend taken first (o). Similarly cases under sects. 26 and 27 for revocation before the Comptroller do not stop amendment under sect. 21. Also proceedings before the Court on appeal under sects. 26 and 27 are not within sub-sect. 8 of sect. 21; leave need only be obtained when action is pending in the High Court, when the High Court is a Court of first instance. These views are strengthened by the decision in *Cropper v. Smith* (p), that a pending action means an action in a Court of first instance. When the judgment of the Court has been declared, the patentee may amend without leave, and an appeal is not a pending action (q). This sub-section (21 (8)) is directed to the protection of the patentee's opponent, who will not be harmed by amendment pending appeal as regards that appeal, since facts arising after the Comptroller's decision will not be therein considered.

But if an order for the revocation of the patent has been

(m) 11 R. P. C. 75.

(p) 1 R. P. C. 254.

(n) 19 R. P. C. 425; 20 R. P. C. 183.

(q) See also *Lawrence v. Perry*, 2 R. P. C. 180; *Winter v. Baybut*, 1

(o) *Cochrane's Pat.*, Gr. P. C. 304.

R. P. C. 76.

made, or the patent has been in any way determined, and this fact has been entered on the register, no amendment can be allowed either under sect. 21 or 22, for there is nothing to amend (*r*).

Any amendment before acceptance and before the specification is advertised cannot be proceeded with under sect. 21, but must be effected under the earlier sections (*s*). Before the patent is sealed, and when the specification is in the Patent Office, proceedings before the Comptroller are the only proceedings which can be taken for amendment (*t*).

(2) AMENDMENT BY ORDER OF THE COURT UNDER SECT. 22.

When an action for infringement of a patent or proceeding for revocation is pending *before the Court* (see page 78) an order of the Court must be obtained to amend (*s*. 22). The patentee will only be allowed in this case to amend by way of disclaimer, and the Court may impose any terms it thinks fit on making the order. In allowing amendments under sect. 22 the Court follows the same rules as have been given under (1) above, and the amendment made under this section must not make the specification claim an invention substantially larger than or different from that claimed in the unamended specification.

The Court has hitherto always allowed the amendment itself under this section; but it seems that there is nothing in the section to prevent the old practice being followed of giving leave to apply to the Comptroller to amend, for the section states that the order may be made in such manner as the Court thinks fit. At the same time, as a matter of practical convenience, it is unlikely that the old practice would now be followed: it never has been.

As there is no proviso in this section (as in sect. 21) that leave to amend is conclusive as to right to amend, and in view of sect. 21 (8) limiting the application of sect. 21 (*u*),

(*r*) *Deeley v. Perkes*, 13 R. P. C. 590.

(*s*) *Jones' Pat.*, Gr. P. C. 313.

(*t*) *Gares' Pat.*, Gr. P. C. 309.

(*u*) *Owen's Pat.*, 15 R. P. C. 755.

amendments made under sect. 22 are simply orders of court, and may be set aside like any other order of court on appeal (*x*) or otherwise (p. 85). They may also be questioned on appeal in the same action (*x*) (see p. 85).

In making the order to amend under sect. 22 the Court will consider what are proper conditions to impose (*y*). Examples of conditions are: that the patentee pays costs up to the time of the amendment (*z*), or that the amended specification should not be receivable in evidence in the action (*a*), or other terms; but a condition that no action should be taken for infringement against certain people after amendment is unreasonable, as it practically gives them a license to infringe (*b*). Other cases exemplifying conditions imposed by the Court under the old practice in giving leave to apply to amend, and which show the conditions which the Court will now impose on amending are: *Vesta v. Bryant & May*, 4 R. P. C. 71; *Allen v. Doulton*, 4 R. P. C. 380; *Haslam Foundry Co. v. Goodfellow*, 5 R. P. C. 28; *Gaulard & Gibbs v. Lindsay*, 5 R. P. C. 192; *Hall and Others*, 5 R. P. C. 309; *Lang v. Whitecross Wire Co.*, 6 R. P. C. 570; *Meyer v. Sherwood*, 7 R. P. C. 283; *Dellwick*, 13 R. P. C. 591; *Chatwood*, 16 R. P. C. 374; *Corrigall v. Armstrong*, 20 R. P. C. 523; *Scott*, 20 R. P. C. 263; *Geipel's Pat.*, 20 R. P. C., 558, 21 R. P. C. 387; *New v. Edinburgh Gas*, 21 R. P. C. 147; *Jandus Arc Lamp Co. v. Arc Lamp Co.*, 21 R. P. C. 116.

If there is more than one action pending before the Court the patentee can obtain the amendment by application in one action only (*c*). This works no injustice, as the defendant or plaintiff, as the case may be, in the second action may question the validity of the amendment thus made under sect. 22; the amendment made under this section is not conclusive, as it would be under sect. 21 (see page 85 and *supra*).

(*x*) *Gaulard & Gibbs*, 6 R. P. C. 121; *Codd v. Bratby*, 1 R. P. C. 209. 215; 7 R. P. C. 367; *Gaulard & Gibbs v. Lindsay*, 5 R. P. C. 192.

(*y*) *Allison's Pat.*, 17 R. P. C. 516.

(*z*) *Chatwood*, 16 R. P. C. 449, 370; *Winter v. Baybut*, 1 R. P. C. 76.

(*a*) *Singer v. Stassen*, 1 R. P. C. R.P.

(*b*) *Tranter's Pat.*, [1873] Johnson's Pat. Manual, 5th ed., 182; *Medlock's Pat.*, [1865] Newton: Lond. Jour., N.S., vol. 22, p. 69.

(*c*) *Re Hall & Others*, 5 R. P. C. 309; but see *Codd's Pat.*, Gr. P. C. 305.

When the Judge is applied to for amendment it is not clear whether third parties interested may oppose. In the absence of rules it seems that their opposition should be made by application in Court, when the Judge, if he thought there was substance in the application, might impose terms as empowered under sect. 22 by the words "or otherwise."

The Judge has an absolute discretion to amend or refuse to amend under sect. 22, and the Court will not disturb his amendment or refusal to amend unless satisfied that he exercised such discretion wrongly (*d*); neither *Deeley v. Perkes*, 13 R. P. C. 581, nor *Moser & Marsden*, 13 R. P. C. 24, take away from this discretion (*e*). In general it may be said that the Court will amend on conditions or not, as the case may be, provided that the other parties to the action before it will not be damaged in the matter or can be protected; but if it seems impossible to make a valid patent out of the specification, or it is impossible to gather what the invention is, leave to make the amendment will be refused (*f*).

The practice of the High Court in considering amendments pending an action under sect. 22 is to be found in Order 53A, Rule 23, but does not concern this book.

Under the old practice it was decided that the Court would not go into the admissibility of the proposed amendment, when giving leave to apply to the Comptroller to amend; that duty was left to the Comptroller or Law Officer (*g*), who had to be satisfied as to the propriety of the amendment; the Court's leave was no argument for allowing the amendment. After leave to amend had been given by the Court the amendment proceeded as an ordinary application before the Comptroller (*h*). The Order of the Court giving leave to amend did not expire because an application for leave to amend had been made under it and refused, if such application had been refused on a technical point and

(*d*) *Lang v. Whitecross Wire*, 7 R. P. C. 389. Romer, J.

(*g*) *Dellwick's Pat.*, 13 R. P. C. 591.

(*e*) *Dellwick*, 13 R. P. C. 591.

(*h*) *Hall & Others*, 5 R. P. C. 309.

(*f*) *Klaber*, 22 R. P. C. 416, *per*

not on its merits (*i*). When leave to amend had been obtained in the course of an action and application to amend had been made, and where the action was discontinued and the application was withdrawn, the order of the Court giving leave to amend had no effect on any subsequent application to amend (*j*).

This book is not concerned, however, in greater detail with these amendments by the Court.

(3) AMENDMENT REQUIRED OR ALLOWED BY THE COMPTROLLER IN THE COURSE OF APPLICATION, OPPOSITION, OR REVOCATION PROCEEDINGS.

What may be done by way of amendment on application will be found in the chapter on Applications (p. 27).

Revocation proceedings under sect. 26, in which amendments may be made, are an extension of opposition proceedings under sect. 11, and the class of this heading, therefore, is reduced to:—

Amendments imposed in Opposition Proceedings.—The same general principles apply as apply to amendments under sect. 21, but extensive amendments should be discouraged in such proceedings; for the patentee should not set his net as wide as he pleases, thus having included a prior patented invention, and then seek to excise surplusage by amendment (*k*). Amendments are not a matter of course, and must not amount to the re-writing of the specification and the forming of new claims; the applicant must take the trouble to frame his specification properly when he files it. It is not the fault of the Office if he lose his grant through having muddled his invention up with extraneous matter (*l*). And it is a gross abuse of the opportunity of amendment in opposition proceedings if the applicant frames an amendment altering his invention to something which he had not in view when he filed the specification (*m*). If this is done, the applicant will

(*i*) *Codd's Pat.*, ante.

(*j*) *Bell*, Gr. A. P. C. 10.

(*k*) *Garnett*, 16 R. P. C. 154.

(*l*) *Crist*, 20 R. P. C. 475.

(*m*) *Harrild v. Parkins*, 17 R. P. C. 617.

run the danger of a refusal; but in a proper case, if something new can be found in the invention, a patent may even then be sealed so amended as to claim something entirely different from the complete specification as originally framed (*n*).

When the applicant's invention is a mere improvement of prior patents, general words in his claims will be struck out by amendment on opposition, for they are deceptive (*o*). Amendments of the body of the specification are sometimes asked for by the opponent; in such cases the Comptroller must be satisfied that the part asked to be amended does in some way affect the scope or meaning of the applicant's claims before he imposes the amendment (*p*). The question of whether amendments of the body of the specification should be allowed usually arises in opposition under (*b*); it may arise under (*d*), but can be only of academic interest when arising under (*c*) (*g*).

The Comptroller when he finds that all the applicant's claims are bad must not then look about for something which may be claimed and which is not in the provisional (*r*). Nor can the applicant be heard to say that what he had originally claimed is anticipated in prior patents, but that he will now show that there is something else in addition, in the specification, which is not anticipated. It would be unjust to allow such an amendment, for the attention of possible opposition would not have been directed to it (*s*). The specification will not be amended so as to limit the patent to the one point on which reliance can be placed, when before amendment the claims were all the subject-matter of a prior patent. Such an amendment would make the patent difficult to construe (*t*). The Comptroller should not make any order for an amendment which merely embodies his construction of the specification (*u*). In an opposition case, if the subject-matter of the

(*n*) *Harrild v. Parkins*, 17 R. P. C. Appn., 27 R. P. C. 86; see also p. 58. 617.

(*o*) See pp. 84, 90; *Hamilton*, 19 R. P. C. 35.

(*p*) *Wadham's Appn.*, 27 R. P. C. 172; 26 R. P. C. 1909, VII.; *Francis'*

(*q*) *Wadham's Appn.*, ante.

(*r*) *Lancaster*, 20 R. P. C. 368.

(*s*) *Mills*, 18 R. P. C. 322.

(*t*) *Lupton & Place*, 14 R. P. C. 261.

(*u*) *Anderton*, Gr. A. P. C. 25.

applicant's and opponent's invention is almost identical and the applicant claims "substantially as described," the word "substantially" should be struck out (*x*).

If the Comptroller makes an order for amendment in an opposition (say) case, then the opponent must oppose the amendment before the Law Officer by way of appeal on the opposition case, and not in opposition to the amendment (*y*).

EFFECT OF AMENDMENT.

It is well to remember the general effects of amendments. It has been decided by the House of Lords that when an amendment has been obtained under sect. 21, by order of the Comptroller, the regularity of the amendment cannot be questioned except on the ground of fraud. The specification amended under sect. 21 is a complete substitute for the original specification, and is to be construed by itself (s. 21 (7)) (*z*). Thus to object that the amendment was not properly advertised will not be sufficient to enable the High Court to go behind the Comptroller's decision (*a*). But an objection that legal proceedings are pending within the meaning of sect. 21 (8) will be listened to, as that goes to the Comptroller's jurisdiction (*b*). The effect of the decision in *Moser & Marsden* as to the finality of the amendment has been to cause fewer amendments to pass the Law Officer, as he is the final authority; previously an applicant for an amendment was given the benefit of the doubt (*c*).

Amendments made under sect. 22 by order of the Court are, as has been pointed out, on a different footing; their regularity may be questioned like that of any order of court, *e.g.* by appeal (see page 80). This distinction is

(*x*) *Cummings' Pat.*, Gr. P. C. 277.

(*y*) *Cooper & Ford's Pat.*, Gr. P. C.

276.

(*z*) *Moser & Marsden*, 13 R. P. C.

24; *Perry v. Société, etc.*, 13 R. P. C.

670.

(*a*) *Farbenfabriken v. Bowker*, 8 R. P. C. 393.

(*b*) *Ibid.*; *Brooks v. Lycett*, 21 R. P. C. 655.

(*c*) *Parkinson's Pat.*, 13 R. P. C. 509.

only fair, as it would be unjust to allow an amendment which affects the public to be made in any particular action so that only one person, a party to that action, had an opportunity of objecting to any irregularity. Nevertheless, if no objection be so taken to an amendment under sect. 22, an amendment made under this section stands completely in the place of the unamended specification.

However the amendment may have been made, in construing the amended specification a reference to the unamended specification is precluded (*d*), except where reference is made to the unamended specification to instruct the mind (*e*). Even when an amendment is sought by the reinclusion of something struck out by a previous amendment it may be refused as making the invention substantially larger; for it is not in the specification before the Comptroller, and he may not look at the original (*f*).

Though amendments must be read as if part of the original specification they have not a retrospective effect (*g*). No damages will be recoverable for the use of the invention before amendment unless the patentee's original *claims* were framed in good faith and with reasonable skill and knowledge (s. 23). This may be paraphrased as, "unless he intended in his original specification to claim what he had really invented and no more." (*h*) It will be noted that the section does not refer to the specification, but to the claims. This section (23) is a check on a patentee who finds that his specification is bad, and either amends before bringing an action or else discontinues an action already commenced, amends his specification, and then brings a fresh action against the same parties (*i*). Damages for breaches before amendment are very unusually given; they were given

(*d*) *Jandus Arc v. Arc Lamp Co.*, 22 R. P. C. 277; *Hattersley v. Hodgson*, 21 R. P. C. 517; *Inglis v. Buttery*, L. R. 3 App. Cas. 552.

(*e*) *Jandus, etc.*, *ante*, distinguish on this ground *Moser & Marsden*, 13 R. P. C. 24; and *Reason Manufacturing v. Moy, Ltd.*, 20 R. P. C. 205.

(*f*) *Hattersley & Jackson*, 21 R. P. C. 233.

(*g*) *Perry v. Skinner*, 2 M. & W. 471.

(*h*) *Kane v. Boyle*, 18 R. P. C. 338.

(*i*) *Dudgeon v. Thomson*, 3 App. Cas. 34; *New v. Edinburgh Gas*, 21 R. P. C. 1, 147.

in *Hopkinson v. St. James' Light Co.*, 10 R. P. C. 46, and *Brooks v. Lycett*, 20 R. P. C. 390.

Proceedings for amendment terminate when leave for amendment is obtained from the Comptroller, or after appeal. The Patent Office should not issue the unamended specification thereafter without notice that it has been amended (*l*).

The fact that a specification has been amended is indicated by an asterisk printed after the number, thus:—1974* of 1910.

(*l*) *Andrew v. Crossley*, 9 R. P. C. 165.

CHAPTER VI.

DISCLAIMERS AND REFERENCES.

THE form and general manner of framing the complete specification has been already treated in Chapter III. As was therein explained, it is often found necessary for the protection of the public and prior patentees, in order that a patentee may not claim more than he is entitled to claim, or seem to claim more than he does claim, to insert a statement of what was, before his patent, matter of public knowledge. These statements are so important that a special chapter has been devoted to them, in which will be considered when they will become necessary and what form they will take.

DISCLAIMING CLAUSES GENERALLY.

Disclaiming clauses are either general or specific. That is to say, they consist either in the statement that the patentee is aware that a certain operation has been performed before, and that he lays no claim to it; or else they consist in a specific reference by name and number to a patent which anticipates him and the operations of which he disclaims. The rule is that a specific reference is inserted where there is clear infringement of *one* patent which is alone in the field, and that in all other cases general disclaimers only will be inserted. This rule, however, does not mean that a specific reference will only be inserted to a "master patent" (p. 94); because the one anticipating patent need not be the embodiment of a new and important principle, and so need not be a master patent. Sometimes a reference either general or specific is ordered without any following disclaiming clause: this is an unsatisfactory form of reference, as it does not inform

the public on the face of it that matter is disclaimed; it is employed on occasions when the prior patent is itself anticipated.

Disclaiming clauses whether general or specific will not be inserted in a specification unless it appears clear that, in that specification, there is a repetition of a claim to the invention claimed in an earlier specification, and unless in addition it appears that the public would be misled by the later specification without disclaimer (*a*). They are inserted both to protect the public and in the patentee's own interest, in order that his patent may not subsequently be considered to be too wide. But they will not be inserted to turn an insufficient into a sufficient description (*b*).

It is only after disclaimers are seen to be ineffectual that a grant will be refused. For the risk of injury to the patentee is less in the case of a disclaimer. Disclaimers will always be inserted and the patent allowed if it is possible to protect the interests of a prior patentee by means of a disclaimer (*c*). Thus if an applicant admits that he lays no claim to the invention of the opponent, but it is not clear from his specification that he does not, a disclaimer will be inserted (*d*), but not necessarily a specific reference; and the disclaimer will often be best effected by adding particular words to the claims and descriptions (*e*). Again, where an applicant describes another's invention by way of explanation to his own, but does not claim it, he will be required to state that he does not claim it, or else to cut out the vital parts of the other invention from his specification (*f*). But where the description does not describe another's invention it cannot be contended that a claim which properly relates to that other's description, and which ends with the words "substantially as described," makes a reference or disclaimer necessary (*g*).

It is not because a particular patentee or a prior inventor

(*a*) *Stell's Pat.*, 8 R. P. C. 236, *per* Webster, A.-G.; see also *Re Hill*, 5 R. P. C. 599.

(*b*) *Johnson*, 13 R. P. C. 659.

(*c*) *Re Tattersall*, 9 R. P. C. 150.

(*d*) *Cooper & Ford's Pat.*, Gr. P. C. 276.

(*e*) *Guest & Barrow*, 5 R. P. C. 313.

(*f*) *Teague's Pat.*, Gr. P. C. 298.

(*g*) *Re Lorrain*, 5 R. P. C. 142.

has made a broad claim that he is entitled to have limiting words inserted in another's patent; he has to show that upon a fair view of the evidence before the Law Officer or before the Comptroller such words are really necessary to protect him (*h*). If the later patent covers a portion of the former and it is fair to the earlier patentee, fair to the later patentee, and fair to the public, a disclaimer will be inserted (*i*).

In cases where there is an anticipation by a prior patent, but that prior patent is shown to be itself generally anticipated, a clear and unmistakable reference to the prior patent will be inserted without any disclaiming clause. Such a reference is widely distinguished from a general disclaimer (*k*).

It was said in *Curtis & André* (*l*) that the Law Officer must consider subject-matter, when considering the question of anticipation by a prior patent, for the purpose of disclaiming clauses; but it is submitted that this decision is incorrect. It is his duty and the Comptroller's duty only to compare the prior and later specifications, and subject-matter *per se* does not concern him (see *ante*, pp. 57, 22).

Disclaimer will be required of such parts of the description as are irrelevant to the claims (*m*). But this will only arise in very badly drawn specifications where the omission of the irrelevant matter is impossible without re-writing or recasting the specification, which should not be ordered (*n*).

Where a disclaimer consists in identifying certain machines, which are not claimed, it is the proper course for the parties to settle the form of it between themselves and submit it to a Comptroller (*o*).

The onus is upon the party who asks for a disclaiming clause to be inserted to show that it is necessary (*p*).

(*h*) *Guest & Barrows' Pat.*, 5 R. P. C. 1911, unrep. 312.

(*i*) *Clarke, S.-G., in Re Hoffman*, 7 R. P. C. 92.

(*k*) *Newton's Pat.*, 17 R. P. C. 123: *Low's Pat.*, 18,628 of 1908, Feb. 21,

(*l*) 9 R. C. P. 497.

(*m*) *Francis' Appn.*, 27 R. P. C. 86.

(*n*) *Ibid.*

(*o*) *Haddan*, Gr. A. P. C. 12.

(*p*) *Stell's Pat.*, 8 R. P. C. 235.

The following cases show the principles which the Comptroller will set before himself in deciding whether a disclaimer or reference should be inserted. Sir R. Finlay, S.-G., in *Marsden's Pat.* (q): "I think that a reference ought, speaking generally, to be allowed only if, in the case of the insertion of that reference being refused by the applicant, the Comptroller or the Law Officer would be justified in saying that the patent should not be sealed at all." But in *Brockie's Appn.* (r) Sir S. T. Evans, S.-G., said that this statement was too broad and that the criterion was that if the Law Officer (or Comptroller) was in such doubt that he said to himself, "I am not at all sure that I ought to allow this patent to go, but if I do allow it to go I must direct the applicant to insert a specific reference," then, if the applicant refuses to do so, the patent might be refused.

SPECIFIC REFERENCE.

The most complete form of disclaimer is that effected by a specific reference by name and number to a prior specification. This is never inserted, except with the consent of the patentee or unless a patent to which a reference is asked is alone in the field. If this rule were not adopted it would be inferred that the patentee intended to exclude a reference to others, or did not know of others (s). A specific reference may be either demanded by the Office or asked for by an opponent. The principles applicable in either case are the same.

This matter of specific reference was fully discussed in *Hopkins' Patent* (t), in which will be found what follows in this chapter, save where another case is given.

Before the powers of search and of amendment were conferred on the Comptroller it was not the practice to call on the patentee to alter his description or his claims to any considerable extent. The specification used to be left, as far

(q) 14 R. P. C. 174.

(r) 25 R. P. C. 813.

(s) *Guest & Barrow*, R. P. C. 313.

(t) 27 R. P. C. 72.

as possible, in its original form ; therefore a specific reference often became necessary, both in the interests of the public and of a prior patentee ; for this was the only way of distinguishing what was old from what was new. At the present time, owing to the extension of the Comptroller's powers to search and amend, the need for the insertion of a specific reference more rarely arises. It should be the aim of the Office to secure that the specification should be so framed as to obviate the necessity for inserting references and disclaimers, which in many instances can only be inserted as a rough and unscientific method of defining the real scope of the invention and its relation to former invention and discovery. In cases where this is done and where the objectionable part of the specification is removed by amendment (under sect. 7), there will be no need for a specific reference (*u*). It has been recognised for many years by the Office that it is best to alter the language of the specification in order to avoid a claim to a prior grant and the necessity for a reference (*x*). At the same time a specific reference will be inserted, if necessary, in the earlier examination stages to penalise patentees who cannot or will not meet the objections of the Office. Where a specification is properly and scientifically drawn, there would appear to be as a rule no need for a specific reference or disclaimer. The ideal specification would claim, and only claim, in clear and succinct language, the patentee's invention, and distinguish it from what had gone before and show its relation to previous inventions. Matter which is irrelevant would be excluded, and only such matter inserted as is reasonably necessary for showing the best form of, or the best method of, carrying out the invention sought to be protected. In a specification so framed there could be no ambiguity and no need, as a rule, for further protection of the public or prior patentees.

The object of a specific reference is not to advertise a prior patentee, but the aim of references and disclaimers is

(*u*) *Gaunt & Greenhalgh's Appn.*, 11 H. L. Cas. 223.
 14 R. P. C. 387 ; *Ralston & Smith*, (*x*) *Adams' Pat.*, 13 R. P. C. 548.

the guidance of the public, to define the true scope of the invention, and to make clear the relation of one patent to another. For this reason, when a specific reference is ordered to be inserted, the patentee must also disclaim; the mere mention of the other patent does not inform the public (*y*). For the same reason the object of the opponent in asking for a specific reference is immaterial; for example, it is immaterial if he says that he requires it for the purposes of subsequent litigation (*z*). A specific reference may be desirable for the purpose of explaining what the claim of the applicant is: "I insert a reference, not for the purpose of making the prior patentee known, but solely for the purpose of showing clearly that the claim, which is in general terms here, is not to be read as involving a claim to anything which was covered by the prior patentee" (*a*).

It is immaterial to the question of the insertion of a specific reference whether the prior patent is good or bad (*b*). Utility is equally immaterial (*c*), except in such cases as mentioned *ante*, page 30. The question to be asked before insertion of a specific reference is: "Is the governing idea or basic principle, of the invention sought to be protected, claimed or protected by a specific earlier patent?" (*d*). That is to say, the first condition of insertion is that the new invention should be based on a definite invention already protected, and that the earlier invention should be clearly and unequivocally involved or repeated in the new specification. And the second condition is that the public must be protected, and the specification not left so that it would mislead them without a disclaimer: so that the jurisdiction to insert this form of reference does not arise unless it would be wrong to let the patent be sealed without the reference (*e*).

If the prior patent has only been described in the

(*y*) *Welch's Pat.*, Gr. P. C. 300.

(*z*) *Marsden's Pat.* No. 2, 14 R. P. C. 175.

(*a*) Findlay, A.-G., in *Re Adams*, 13 R. P. C. 549.

(*b*) *Thornborough & Wilks*, 13

R. P. C. 116.

(*c*) *Spinneri Weberei*, 11 March, 1910, unrep.

(*d*) *Hopkins' Pat.*, *ante*.

(*e*) *Marsden*, 13 R. P. C., 89; 14 R. P. C. 175.

applicant's provisional, it may, in a bad case, be necessary to insert a reference in the complete (f). But if the claims of the applicant's specification include a claim to a prior patented invention, the applicant's specification will be considered an improvement patent and not an independent invention. The practice is well established in this case to call on the applicant to refer by name and number to the prior patent (g). Where the applicant's claim includes something merely subsidiary to the prior patent, it is submitted that no specific reference should be demanded, though in *Levinstein's Pat.* (h) it was decided otherwise (i).

The fact that the dates of the earlier and later patents are close together may be put forward, and will sometimes prevent the insertion of a reference (k).

Four classes of cases arise on the insertion of a specific reference :—

1. Where the question of a master patent is involved.
2. Where there is no claim to a master patent.

These two classes, 1 and 2, are the general classes to which all cases of specific references belong; but the rules given under them are to be modified in cases—

3. Where the applications are concurrent.
4. Where an application under the Convention has been made.

If the specification is clear and unambiguous the method of applying the principle in 1 and 2 is the same.

1. MASTER PATENT.—That is to say, the discovery of a new and important pioneer principle embodied in practical form and shape and claimed in general terms. It should be noted that there must be a wide and governing new principle to constitute a master patent (see p. 53).

(f) *Hookham*, Gr. A. P. C. 32.

(g) *Maxim & Silverman*, 11 R. P. C. 316; see also *Hoskins' Pat.*, Gr. P. C. 291; *Welch's Pat.*, Gr. P. C. 300; *Newman's Pat.*, 5 R. P. C., 271;

Newman's Pat., 5 R. P. C. 279.

(h) 11 R. P. C. 349.

(i) *Hopkins' Pat.*, ante.

(k) *Marsden*, 13 R. P. C. 89.

In this case the specific reference is rightly inserted—

- (a) If the new invention is merely an improvement or amendment of the master patent.
- (b) If a specific reference is needed to prevent the public being deceived into thinking that the later patent is alone in the field.

The later invention must be found by implication or directly in the master patent, and it is only when a wide and generous construction of the latter appears to foreshadow or involve the later invention that a reference will be inserted. There must be substantial identity between the two patents in fundamental portions, though a certain difference may be justified on the ground of improvement (*l*). Thus, where the later patent is for a special modification of the earlier patent, a specific reference is rightly inserted to show that this is so; it is so inserted for the protection of the public, but it is also to the advantage of the later patentee to define properly his patent (*m*). This doctrine of master patent was first definitely laid down in *Welch's Pat.* (*n*), where the Law Officer stated that he was not prepared to insert a specific reference in the applicant's specification, unless the applicant admitted that the governing principle of his invention was first disclosed in the opponent's specification. And before a specific reference to a patent, alleged to be a master patent, is granted the Comptroller should be satisfied that the opponent's is a master patent *quoad* the applicant's process (*o*).

Even when these conditions are fulfilled time and notoriety may make it superfluous to insert a specific reference to the master patent; in which case a specific reference should not be inserted, for the public does not need it.

When a master patent is claimed proper notices should be given under the Rule (40) so that an adequate search may be made by the Office and the applicant. The Office search at

(*l*) *Newton*, 17 R. P. C. 125.

(*m*) *Re Newman*, 5 R. P. C. 279.

(*n*) 8 R. P. C. 443.

(*o*) *Meyenberg's Pat.*, 22 R. P. C. 353.

the examination stage must not be relied upon as conclusive on this point.

2. NO CLAIM TO MASTER PATENT.—The conditions are in this case stricter and more severe. Specific references are here allowed when—

- A. The former patent is clear and distinct in its own field and is free from anticipation: the Office search will raise a *primâ facie* case on this head.
- B. The invention of the former patent is clearly and unequivocally claimed or included in the latter specification.
- C. The invention is so claimed or included substantially as a whole, and not merely in part.
- D. The improvement or addition claimed in the later patent is small, and the governing principle came from the earlier patent.

The danger to be guarded against in all cases is the undue preference given by the naming of one patent which is not alone in the field. Examples of the insertion of a specific reference when no claim is laid to a master patent are: *Tattersall*, 9 R. P. C. 151; *Van Gelder*, 9 R. P. C. 327.

Where the conditions for the insertion of a specific reference have not arisen according to 1 and 2 above, general disclaimers and not specific references should be inserted. For example, where an opponent asks for a specific reference and shows that his patent effects a certain object with great precision, but it is admitted that the object has been effected before, if not so perfectly, it will be sufficient to insert a general disclaimer to that object without inserting a specific reference, even when the claim of the later patent is to effect the object of the earlier patent with precision (*p*). But cases often arise where it cannot be said that there is any question of master patent, nor that a case for the insertion of a specific reference has properly arisen, and where, owing to the obscurity and ambiguity of the specification, it is impossible to introduce amendments and disclaimers. In such cases, to save time and

to protect the public, it is found necessary to insert specific references. But this is bad practice.

All that has gone before is of course subject to the fact that complete anticipation will mean refusal. And that though in general it is no part of the Comptroller's duty to consider questions of infringement, yet it is his duty to see that the public are warned of what is special and of what is common general knowledge. It follows from this point of view that a specific reference may be inserted to another patent of the patentees (*q*).

CONCURRENT APPLICATIONS.—Applications made before the sealing of the patent on the earlier application are concurrent with it; they cease to be concurrent when the earlier patent is sealed (*r*). Special principles are applicable to the question of specific references in the case of concurrent applications.

The International Convention and sect. 8 make the matter of concurrent applications more prominent, because Convention applications are often concurrent with other applications, and sect. 8 gives the Comptroller power to examine concurrent anticipations on the search before grant (see pp. 20, 98). Under the old practice, before 1907, it was held that, the function of specific references being to warn the public that the field of invention of the patent asked for was already occupied by the publication of another patent, there was no room for a specific reference to a concurrent application. The applicants might agree to a reference for their mutual advantage, but the Office could not require it (*s*). But under sect. 8 the Comptroller is empowered, apart from any question of opposition, to place any reference in a specification if the official investigation discloses a specification of an earlier application claiming the same subject-matter, even though such earlier specification was not published when the later application was made (*t*). Similarly, sect. 11 (1) (b) gives,

(*q*) *E.g.*, *Hearson's Pat.*, Gr. P. C. 266.

(*s*) *Gaunt & Greenhalgh's Appn.*,
14 R. P. C. 387.

(*r*) 27 R. P. C. 1910, G.

(*t*) 27 R. P. C. 1910, G.

by the words "will be of prior date," a right to an opponent to ask for a reference to a concurrent application. In this connection it may be mentioned that the Comptroller is not debarred, when the matter comes before him under sect. 11, from acting under sect. 8; indeed, it is often more convenient to deal with the whole matter in proceedings under sect. 11, especially if the opposition be made before objection be taken under sect. 8, for thus a duplication of proceedings is avoided (*u*). The proceedings are the same whether under sect. 11 or 8, and, as has been indicated, it makes no difference whether the earlier application has or has not been granted. That is to say, concurrency is no ground, *per se*, for objecting to a reference.

It should be noted that if the later application be made before the sealing of the prior application, the patent of the later application cannot be voided for prior publication as far as the documents are concerned. Further, if no patent be sealed on the prior application, the patent of the later application is in no way prejudiced or invalidated by the existence of the earlier specification. Hence the order for the insertion of a specific reference in a concurrent application should be made conditional on the sealing of a patent on the earlier application (*x*). The question of concurrency does not arise where the patent on the earlier application is sealed before the question of the grant of the later application comes up for consideration in opposition proceedings. In many cases the references would be made as follows: A general disclaimer where the applications are concurrent, and a reference, by name and number, where the earlier patent has been sealed (*y*).

CONVENTION APPLICATIONS.—Sect. 91 gives a foreign patentee the right to claim the date of his foreign patent for his British patent, though he does not apply in this country for some time after that date. But this does not

(*u*) 27 R. P. C., 1910, G.
(*x*) *Ibid.*

(*y*) *Donge's Appn.*, unrep., referred to in 27 R. P. C. 1910, G.

carry with it the power to elude all notice of applications made at the British Patent Office between the date of his application abroad and here. Should there be any anticipation of the matter of his specification in an application left at the British Patent Office before his application in this country he will have to refer thereto (z). The word application in sect. 8 (1) means application at the British Patent Office (a). The applicant under the Convention is in the position, as regards references and disclaimers, of one who has made an ordinary application on the date of the Convention application in this country.

FORM OF REFERENCE.—A specific reference may be made either with or without a disclaimer. A specific reference with a disclaimer as thus—"I am aware of the specification of letters patent No. of , granted to , and I make no claim to anything described or claimed therein"—is a very stringent disclaimer, and greatly damages the commercial value of the patent. Practically it indicates that the patentee's claim may be construed to include something which is claimed in a prior patent (b). It leaves a purchaser in doubt whether he can make use of the patent without paying a royalty to the prior patentee.

A specific reference without a disclaimer will be inserted if the patentee describes something which is in terms included in the prior patent, though his claims cannot be construed to include the prior patent. The reference will then be in some such form as—"another type of such machine is shown in the specification of letters patent No. of , granted to .". He has chosen to describe something not new, and it is fair and due to the public that in his statement of the art he should refer to the particular source of his information, if that source shows the particular thing. Similarly, he must refer in this manner to an expired

(z) *Deutsche Gold, etc., Rossler's* A. P. C. 28.
Appn., 24 R. P. C. 209.

(b) *Van Gelder*, 9 R. P. C. 325.

(a) *Ibid.*; *Everitt's Case*, Gr.

patent if that shows the particular thing. It is bad practice in most cases to insert a specific reference without a disclaimer (c).

To insert a disclaimer substantially in, or in the very words of, the prior patent is not equivalent to disclaimer by specific reference citing name, number, and date; the former is merely a statement of general knowledge, and allows no inference that the ambit of the two inventions is the same. On the contrary, it leaves the question of invention to be determined from what the two patents have described (d). The public may be entitled to more information than they get by being told thus, or in any other way, that there is some limitation on the generality of the invention; they may be entitled to have the specific inference indicated by a specific reference.

As has been stated, a disclaimer by a specific reference giving name and number is usually in this form: "I am aware of such and such a patent, and I do not claim the mechanism therein described and claimed." It will not be sufficient, if such a special disclaimer is ordered, to refer in a qualified form as thus: "I do not claim *broadly* the mechanism—" (e). Nor will it be sufficient to disclaim a particular part of the prior patent, or something mentioned in the prior patent; the whole matter of the claims of the prior patent must be disclaimed. Thus: "I do not claim—a *specific machine* described in—some other specification" will not do, but some such form as—"I do not claim *the mechanism* described and claimed in—some other specification" must be used (f). Also if a reference is made to a prior patent, whether another's or the patentee's own, which contains a disclaimer by specific reference, it will not do to insert only such a statement as—"The operation is the same as described in my patent No. . ." The disclaimer inserted in that prior patent must be reinserted in the later patent;

(c) *Anderson & Mackinnell*, Gr.

A. P. C. 23.

(d) *Newton*, 17 R. P. C. 125.

(e) *Re Airey*, 5 R. P. C. 348.

(f) *Re Gozney*, 5 R. P. C. 397.

for anything imported from the old to the new specification must be imported with its protecting reference (*g*).

If a reference be required under sect. 7 of the Act by the Comptroller, it must be in the form given in Rule 32, and if under sect. 8 in the form given in Rule 34. No material departure from these forms will be allowed. The Comptroller's duty to the public forbids him allowing an innocuous form of reference, and the applicant must not claim and disclaim in the same breath (*h*).

(*g*) *Re Wallace*, 6 R. P. C. 134.

(*h*) *In re P.'s Appn.*, 23 R. P. C. 644.

CHAPTER VII.

RESTORATION.

SECT. 20 gives power to the Comptroller to restore patents which have lapsed owing to omission to pay fees. The application to restore must be made without delay, and the omission to pay fees must have been unintentional (sub-s. 3).

The procedure under this section is governed by Rules 55 to 59. The application for restoration is to be made on Patents Form No. 15. The application must be accompanied by a statutory declaration verifying the matters in the application. The application is required to be advertised. Provision is made for opposition to an application for restoration by sub-sect. 3; the notice of opposition is given on Patents Form No. 16 (Rule 55), and must be given within two months of the advertisement of the application. On notice of opposition being given to the Comptroller, he will notify the applicant and hear the case. Provision is also made for inserting matter in the restoration order for the protection of persons who have availed themselves of the subject-matter of the patent after the announcement that the patent was void (sub-s. 5).

The Comptroller will have to decide in each case whether the application has been made *without delay*. The condition to relief that the omission should have been *unintentional* will be strictly construed, and it will not do for a patentee to allow his patent to lapse because he is not sure that it is worth keeping, and then, on finding that it is a valuable asset, to come and ask for its restoration. Thus, where the patentee thought that the subject-matter of one of his patents

was included in a later patent which he had taken out, and therefore allowed the older patent to lapse, he cannot be said to have unintentionally neglected to pay the renewal fees (a).

The section is intended to remedy a *mistake in fact*. Error in ascertaining the date and number of the patent, or illness, or negligence, or misconduct of agents, are all matters which the patentee can plead under the section. The true test is: Was it present to the mind of the patentee, or person who should have paid the fees, that they were payable, and did he deliberately neglect to pay them? If so, the omission is not unintentional (b). The patentee's reasons for not paying are entirely immaterial.

The former procedure for restoration was by Private Act of Parliament. The conditions which were usually thereunder imposed on restoration are the same as those which are ordered to be imposed by Rule 58, in accordance with sub-sect. 5 of sect. 20; but it would seem that the Comptroller may insert other conditions also if he thinks fit.

The opponent to restoration must give notice and leave declarations in accordance with Rules 55 and 56, and the procedure thereafter will be the same as in an opposition case under sect. 11 (Rules 57, 43, 46, 47). From the similar wording of the sects. 11 and 20, it follows that the opponent will have to show the same interest before he will be heard as under sect. 11 (see page 42). The *opposition* to a restoration order is not confined to the questions of "undue delay" in applying and "intentional omission" to renew; these are grounds for refusing the application, but they are not exclusive grounds of opposition or refusal. The opponent to restoration may advance any of the grounds of opposition given under sect. 11, *i.e.* (a) That the invention was obtained from him; (b) Anticipation by a prior patent; (c) Insufficiency of description; (d) Disconformity; or any other ground, for the Act does not confine him to any: for example,

(a) *Land's Pat.*, 27 R. C. P. 481; 27 R. P. C. 1910, I.

(b) *Ibid.*

"incorrectness of the application for restoration" is a ground of opposition to restoration. The section may be regarded as the converse of sect. 26, which deals with revocation upon the grounds upon which opposition under sect. 11 might have been taken; but there is this difference, that under sects. 11 and 26 the Comptroller has a power of amendment, but under this section he has no such power. The only alternatives under this section are to dismiss the application or restore the patent. Hence it is impossible to consider any question of partial anticipation, for that would be ground for amendment. For the same reason the Comptroller will not attempt to piece together several specifications which are each a partial anticipation.

To sum up, any ground of opposition may be taken to an application under sect. 20, and the opponent must satisfy the Comptroller that there is some reason for not restoring the patent. But the Comptroller will not consider subject-matter and piece together specifications, and an anticipation to be successfully pleaded in opposition must be a complete anticipation (c). If opposition is taken to restoration, and conditions are asked for in order to protect opponents who have been manufacturing after the lapse of the patent in question, the sufficiency of the protection given by Rules 58, 59 should be considered before making any order (d).

(c) *Re Simmances Abady's Pat.*, No. 19,477 of 1899, 10 Dec., 1908, unrep.

(d) *Ibid.*

CHAPTER VIII.

REVOCATION.

IN order to protect the public and other patentees against being hampered by the grant of patents which ought never to have been granted, or which are unfairly used, the Act provides for revocation. Revocation may be applied for under sects. 24, 25, 26, or 27. Sects. 24 and 25 treat of the remedy where the requirements of the public have not been satisfied by the patentee who has unfairly prejudiced the trade of this country; and the remedy where the patent has been previously published, or the patentee was not the true inventor, or fraud is alleged against the patentee. But these sections do not provide for application to the Comptroller, and are, therefore, not treated in detail here.

REVOCATION UNDER SECT. 26.

The section gives a right of application for revocation of a patent, within two years of the grant, to any one who might have opposed the grant under sect. 11 (*q.v.*), or to the "successor in interest" of such person, except where an infringement action or proceedings for revocation are taking place in respect of the patent.

The application is made on Form 22 (Rule 75), accompanied by an unstamped copy, for transmission by the Comptroller to the patentee. Evidence *must* be left with the application if the applicant alleges that the patentee obtained the invention from him, otherwise evidence *may* be left (Rule 75). The procedure as to the evidence and hearing then follows that on opposition under sect. 11 (Rule 76).

The Comptroller may revoke the patent if the circumstances are such as would have entitled him to refuse it under sect. 11, or he may amend it in any manner or dismiss the application (sub-s. 2). The section virtually prolongs for two years the effect of sect. 11. The patentee may, after the application to revoke has been made, offer to surrender his patent (Form 23); and if the Comptroller accepts the offer the patent will be revoked and the revocation advertised (s. 26 (3); Rule 77).

The proviso making this procedure inapplicable when proceedings are pending in any "Court" will, it seems, not apply when revocation proceedings under sects. 26 and 27 or any other proceedings are pending before the "Comptroller" (a), for these are not proceedings before the Court, (s. 92 (1)); nor will it apply to appeals from the Comptroller to the Court (see page 79). Whether proceedings under sect. 24 for *compulsory license* are within the proviso it is difficult to say; probably they are as the Court considers them. Proceedings started under this section will not be stayed by subsequent proceedings before the Court. This proviso is to the same effect as the provision of sect. 11 (8); and for further information on the facts necessary for its operation, see page 79.

The words "successor in interest" must not be taken as enlarging the class of those who may apply beyond the classes of opponents under sect. 11. This is so, as if the section gave a larger right to dispose of the patent on revocation than there is in opposition under sect. 11 it would have said so clearly, the remedy being stronger and more stringent. These words "successor in interest" include:—

- (A) The legal representatives of a person who could have opposed under sect. 11 (a), and who has died within the two years allowed by sect. 26. "Legal representatives" means the executors and administrators, and does not include assignees or those holding under a power of attorney.

- (B) The assignees of the patent rights (and of manu-

(a) *Cochrane's Pat.*, Gr. P. C. 304.

factures giving interest) which belonged to the person who might have opposed under (b) and (d) of sect. 11 (b).

The right given by sect. 26 is unassignable; still less will it pass by the assignment of the invention before the patent is granted, by which indeed nothing passes, as till a patent is granted there is nothing to assign (c). The words "successor in interest" were probably used instead of more precise words in order to cover the applicant who applies under a manufacturing interest (d).

It has been mentioned that this section is practically an extension of sect. 11, and the practice under the two sections will, therefore, be the same, and arguments which either side may bring forward under sect. 11 will be relevant under sect. 26 (see page 39). The opponent is confined to the opposition grounds of sect. 11, namely: (a) That the invention has been obtained from him; (b) Anticipation by prior patents; (c) Insufficiency of description; (d) Disconformity. He will have to show the same interest which he would have to show in advancing these grounds in opposition under sect. 11 before his application for revocation under sect. 26 will be heard. There are, however, these differences between the procedure under sect. 11 and under this section:—

A patent cannot under sect. 26 be granted to the *opposing parties as joint patentees*; hence it follows that in cases where this would be done under sect. 11 the corresponding practice under sect. 26 will be to make an order for revocation, unless the patentee consents to terms (e). In the case quoted the terms imposed were the payment of royalties to the opponent by the patentee; the application was made on the ground that the patentee had obtained the invention from the applicant. It was here found as a fact that the opponent did communicate the idea of the invention to the patentee; so that without this communication the patentee's mind

(b) *Gascoigne's Pat.*, 27 R. P. C. 79; 26 R. P. C. 1909, III.

(d) *Ibid.*

(c) *Gascoigne's Pat.*, 27 R. P. C. 79.

(e) *Gascoigne's Pat.*, 22 July, 1909, 22,479 of 1907, unrep.

would never have been directed to the invention. *The patentee*, in proceedings under this section, *will be given the benefit of the doubt* perhaps more strongly than under sect. 11. Thus, even when it was found that no new result was discovered or described by the patentee's invention, for each part thereof performed an old function, the applicant failed to obtain revocation on the ground of prior patenting, for it was still possible that there might be invention (*f*). Greater leniency will also be shown to the patentee in the matter of the amendments required under this section (26) than is shown in proceedings under sect. 11 (*g*).

REVOCATION UNDER SECT. 27.

This section makes entirely new law ; and for this reason the procedure under it and the construction of its provisions, both before the Comptroller and on appeal, have been considered in some detail.

This section provides that any person may apply to the Comptroller for the revocation of a patent on the ground that it is employed *exclusively or mainly* outside the United Kingdom. When this fact is established, unless the Comptroller is satisfied that the patent is employed to an *adequate extent* in the United Kingdom or that there are *satisfactory reasons* why this is not done, the patent will be revoked either *forthwith* or after an *interval* which is provided to enable the patentee to obtain the cancellation of the revocation order by bringing himself outside the section. But no revocation order contrary to any *treaty* with a foreign state shall be made under sect. 27. The text of the section will be found on page 170.

POLICY OF SECTS. 24 AND 27.—“The mischief which sects. 24 and 27 are directed to is to prevent letters patent, which are monopolies contrary to the spirit of the Common Law as being in restraint of trade, and which were only

(*f*) *Hermann Aron's Pat.*, 9289 of 1908, 18th May, 1910, unrep.

(*g*) *Low's Pat.*, 18,628 of 1908, Feb. 21, 1911, unrep.

excepted from the Statute of Monopolies for the encouragement of trade and inventions useful in trade, being used to prevent the development of new industries or to fetter existing industries in this country" (*h*). The Common Law was unable to meet this abuse, and could not prevent patentees from importing largely from abroad and using their patents in this country only to restrain manufacture (*i*), or, without importing from abroad, from defying the reasonable requirements of the public in the use of their patent (*k*). Special legislation was necessary to remedy these abuses: "Sect. 24 deals with the case where the trade of this country has been injured by an abuse of monopoly, irrespective of anything done abroad; while sect. 27 deals primarily with the cases where the object or effect of the use of such rights, in the way they have been used, has been to favour the development of industries abroad at the expense of the industries of the United Kingdom. . . . The sections may sometimes overlap, but this is the broad dividing line between them. Sect. 27 is simple but drastic; the keynote of the section is forfeiture for abuse of monopoly, at the instance of even a common informer; the abuse of monopoly being in certain cases presumed unless disproved" (*l*). The policy of sect. 27 is often popularly said to be that of "Protection"; this is not so. It is fair play which is demanded, and not preferential treatment of any sort. "The policy of sect. 27 is directed to secure fair play between foreign industries and the industries of this country, and not to secure to the latter during the period of the patent a protection which they would not enjoy if no patent had been granted" (*m*). The use of the word "exclusively" and not "entirely" points to this conclusion. A common purpose runs through sects. 24, 27, and 38 (*n*); sect. 27 in particular is directed to ensure that patent rights

(*h*) Parker, J., in *Hatschek's Pat.*, 26 R. P. C., p. 239.

(*i*) *Badische Anilin, etc. v. Thomson*, [1904] 21 R. P. C. 473.

(*k*) *Incandescent Gas v. Cantelo*, 12 R. P. C. 262; *Incandescent Gas*

v. Brogden, 16 R. P. C. 179.

(*l*) *Hatschek's Pat.*, ante, at pp. 239, 240.

(*m*) *Hatschek's Pat.*, ante.

(*n*) *Bremer's Pat.*, 26 R. P. C. 454.

shall not be taken out and maintained in this country, without any intention of working them here, but to obstruct manufacture here and hinder importation by others than the patentee (o).

THE NATURE OF THE INVESTIGATION.—The jurisdiction of the Comptroller is bound by certain well-defined limits. Once the applicant makes out a *primâ facie* case of manufacture exclusively or mainly abroad, the conduct of the patentee comes into question. Has he failed in his obligations to the traders of this country? "The first thing that a patentee has to do is by full disclosure of the way in which he has exercised his patent rights to free himself from the suspicion of having done anything to hamper the industries of the United Kingdom . . . he will then have gone a long way towards proving what he has to prove" (p). Though what is manufactured by others than the patentee is material to the inquiry (q), if the patentee can show his *bona fides* and fairness to home trade he will escape the section. The Act is not intended to penalise want of success (r). The section does not mean revocation, because revocation would lead to a new industry in this country (s). Though it is no part of the Comptroller's duty to examine into validity under this section, yet it is his duty to see what the patented article really is, and whether it is that particular manufacture or process which the patentee has or has not been attempting to bring about here (t).

"ANY PERSON."—No interest in the invention is required under the section on the part of the applicant for revocation, and it does not matter whether the applicant is or is not interested in the invention (u). The applicant applies in accordance with the Rules (page 121), and the patentee is then on his defence. But the applicant must make out a *primâ*

(o) *Hatschek's Pat.*, 26 R. P. C. 1. R. P. C. 449.

(p) *Hatschek's Pat.*, ante.

(s) *Hatschek's Pat.*, ante.

(q) See *Fiat Motors*, 27 R. P. C. 762.

(t) *Weber's Pat.*, 26 R. P. C. 307; *Lake's Pat.*, 26 R. P. C., 446.

(r) *Bremer & Hogner's Pat.*, 26

(u) *Hatschek's Pat.*, 26 R. P. C. 1.

facie case. Until a *primâ facie* case (under sect. 27 (1)) that the patent is used mainly or exclusively abroad is made out by the applicant in accordance with the decision in *Hatschek's Pat.* (x), the patentee cannot be called upon to produce his witnesses for examination or cross-examination by the Comptroller, *i.e.*, until this onus is satisfied the applicant has no *locus standi* (y). Thus if the applicant proves that a certain article is made abroad mainly or exclusively, but, on the construction of the specification by the Comptroller, this article is found not to be the article patented, then the applicant has not discharged the onus on him (z). Even if the patentee does not appear, it seems that the applicant must make out a *primâ facie* case before the order for revocation is made (a).

The onus on the applicant being satisfied, the patentee is on his defence and it lies on him—

- (1) To show that the patented article or process is not manufactured or carried on mainly or exclusively abroad; or,
- (2) (failing 1). To show that the extent of manufacture at home is adequate, or to give satisfactory reasons for the foreign and greater manufacture.
- (3) He may also show that any order for revocation in the case is prohibited by the proviso of sub-sect. 2.

The application may be made at any time, and delay on the part of the applicant is not relevant.

“PATENTED ARTICLE OR PROCESS.”—The words “patented article” are not confined to articles either made in or imported into this country, nor is the comparison instituted by sub-sect. 1 between what is done in this country and abroad whether by the patentee, his licensees or agents. But the comparison is between the extent to which the article or process, the subject of the patent, is manufactured or carried on in this country and the extent to which it is

(x) 26 R. P. C. 228.

(z) *Lake's Pat.*, 26 R. P. C. 446.

(y) *Lake's Pat.*, 26 R. P. C. 444;
Boulton's Pat., 26 R. P. C. 424.

(a) *Jonkerghouw's Pat.*, 26 R. P. C.
540.

manufactured or carried on abroad, whether the articles so manufactured or resulting from the process are or are not imported into this country (b). For the bearing of the nature of the patented article or process on the meaning of "adequate extent" and "satisfactory" reasons, see page 119.

"MAINLY OR EXCLUSIVELY" (c).—Exclusively is plain and is a matter of fact; it remains to consider what mainly means.

The two words are to be read perfectly literally, and in construing them and the facts presented a narrow construction should not be given. For example, that there has been no manufacture in the United Kingdom a week or a day before the application to revoke is made is by no means conclusive; the neglect to manufacture may be due to some temporary cause, as to floods (d). The section does not include every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom. If the article or process be manufactured or carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is done abroad, the state of circumstances contemplated by subsect. 1 does not exist (e). That is to say, if the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected, having regard to the industrial development of other countries, no presumption against the patentee can fairly arise (f). Something more than a mere percentage below the half of the total manufacture must be shewn to found the Comptroller's jurisdiction (g).

What anybody and not only what the patentee, his

(b) *Hatschek's Pat.*, 26 R. P. C.; 228, Parker, J.; *Mercedes Daimler Co.*, 27 R. P. C. 409; *Högnér's Pat.*, 26 R. P. C. 149.

(c) Revocability under sect. 27 may be alleged as a matter of defence in an infringement action. As to particulars which must be given see

Saccharin v. National, 26 R. P. C. 739.

(d) *Jonkergouw & Destrez's Pat.*, 28 R. P. C. 423.

(e) Parker, J., *Hatschek's Pat.*, 26 R. P. C. 228.

(f) *Ibid.*

(g) Comptroller's Report for 1909.

licensee or agent does abroad is to be considered, provided that there is a *primâ facie* abuse of monopoly (*h*). Similarly, what anybody does in this country is to be considered (page 117). And the preliminary question raised by the applicant, who must satisfy the Comptroller that the patent is carried on exclusively or mainly abroad, has in itself nothing to do with the conduct of the patentee nor with the extent to which the article, the subject of the patent, is or is not imported. The Comptroller under this sub-section is neither concerned with the question whether the manufacture or use here or abroad has the consent or licence of the patentee; nor with questions concerning the rights *inter se* of the patentee and others; nor with questions whether the manufacture or use here or abroad is in derogation of the patentee's rights (*i*). These may all be matters for consideration when reasons come to be given under sub-sect. 2; but sub-sect. 1 deals with the plain fact necessary to establish the applicant's *primâ facie* case which the patentee will have to answer.

A *primâ facie* case will arise if the price charged by the patentee for articles made in this country is greater than the price charged for the same article made by him abroad (*k*).

“ADEQUATE EXTENT”—“SATISFACTORY REASONS.”—There can be no rigid definition of “adequate” or “satisfactory.” The terms are mutually dependant, and in the following notes will be treated together. “It is left to the Comptroller to say in each case (subject to appeal to the Court), whether adequate and satisfactory reasons are advanced. The patentee is on his defence, and I do not think that the extent of the manufacture is adequate, if the manufacture is less than it would have been but for the fact that the patentee has exercised his patent rights to the hurt of British industry,” *e.g.* the manufacture is not adequate if he has given foreign traders a benefit over British traders; “nor that reasons are

(*h*) *Hatschek's Pat.*, 26 R. P. C. 762.

228.

(*k*) *Kent's Pat.*, 26 R. P. C. 666.

(*i*) *In re Fiat Motors*, 27 R. P. C.

satisfactory which do not account for the inadequacy of manufacture here by causes operating irrespective of any abuse of the monopoly granted by the patent. The Comptroller should bear these facts in mind" (l).

All the circumstances must be considered, including the nature of the patented invention (m), e.g. a simple case of improvement of machinery already at work is considered differently from that of a complicated machine (n). When demand and supply in this country are considered, it must be remembered that an absence of demand for the article or the home-made article in this country is not a conclusively adequate or satisfactory reason, and it will not do for the patentee to say that by buying the home-made article the public will be put off with the inferior goods, for the public can look after itself (o). But a patentee who has allowed part of the demand in this country to be supplied by the importation of foreign goods has not precluded himself from showing adequacy (p). The true questions are: Is the manufacture here inadequate through any fault of the manufacturer? Could he have created a demand? (q) Thus absence of demand by itself, with the admission by both parties that at present there is no practical utility in the invention, constitutes a satisfactory reason for not working (r).

As the policy of the section is to secure fair play, the applicant will not succeed by showing that the patented article is not manufactured anywhere, at home or abroad (s). That accessories are manufactured in this country will be disregarded (t): the essential features of the invention must be manufactured here to an adequate extent; in the case quoted a small number of substituted parts were put in here, and this was decided to be insufficient. "Adequate" does not mean necessarily sufficient for the demand in this country,

(l) *Hatschek's Pat.*, 26 R. P. C. 241.

(m) *Ibid.*

(n) *Boult's Pat.*, 26 R. P. C. 386.

(o) *Johnson's Pat.*, 26 R. P. C. 52.

(p) *Hatschek's Pat.*, ante.

(q) *Ibid.*

(r) *Osborn & Another*, 26 R. P. C. 819.

(s) *Boult's Pat.*, 26 R. P. C. 424.

(t) *Johnson's Pat.*, 26 R. P. C. 52.

for the foreign manufacture might be preferred by a section of the public (*u*); but is it no satisfactory reason that the patent was manufactured here to satisfy the demand left over after a large importation by the patentee or his licensees (*x*). That smaller profits are possible here is no satisfactory reason at all (*y*). A foreigner must not expect to obtain necessarily the same terms here as in his own country (*z*). It is never sufficient for the patentee to say that he cannot start an industry here with any chance of profit, neither the patentee's profits nor convenience are "reasons" in themselves (*a*); and the question is, Could he have done so if he had used his monopoly fairly? (*b*)

It is no argument for continued inaction in this country that there is no demand for the process here and that the manufacturers are too conservative, for there must come a time when the patentee should himself set up here, and it is the duty of the patentee to devise different treatment for this country if necessary (*c*). It may be that by creating a manufacture the patentee will create a demand: the patentee must make an effort (*d*) which must be real. Vague offers to sell or license are insufficient (*e*). It is not entirely correct that "cannot carry on here" is an excuse. The strongest evidence will be required that manufacturers and workmen here cannot do the work (*f*); and as a rule arguments based on an impossibility of manufacture here will not be accepted (*g*), for they do not explain why the necessary tools were not imported (*h*).

Where the patentee succeeds in clearly establishing such circumstances as (*i*):—

(1) Repeated and *bonâ fide* efforts to sell or license here.

- (*u*) *Hatschek's Pat.*, ante.
- (*x*) *Bremer & Hogner's Pat.*, 26 R. P. C. 449.
- (*y*) *Hatschek's Pat.*, ante.
- (*z*) *Boul't's Pat.*, 26 R. P. C. 386.
- (*a*) *Hatschek's Pat.*, 26 R. P. C. 1; *Johnson's Pat.*, 26 R. P. C. 52.
- (*b*) *Hatschek's Pat.*, ante.

- (*c*) *Weber's Pat.*, 26 R. P. C. 308.
- (*d*) *Boul't's Pat.*, 26 R. P. C. 383.
- (*e*) *Hatschek's Pat.*, 26 R. P. C. 1.
- (*f*) *Ibid.*
- (*g*) *Kent's Pat.*, 26 R. P. C. 666.
- (*h*) *Johnson's Pat.*, 26 R. P. C. 52.
- (*i*) See *Boul't's Pat.*, 26 R. P. C. 383.

- (2) That he treated this country fairly and gave no preference to foreigners ;
- (3) That failure to work was due to conservatism of British manufacturers ;
- (4) That he entered into a *bonâ fide* contract giving an option to purchase the patent, an application to revoke will fail.

Generally the efforts which a patentee must make to carry out the obligations imposed upon him by the Act must "conform to the standard which an intelligent business man in this country would place before himself and adopt," and not only be sufficient in his own estimation (*k*).

Thus a patentee who endeavours to complete his machine in his own (another) country is entitled to consideration, for this is a reasonable thing to do ; similarly, if it is shown that there will be a satisfactory output here in a short period (*l*). Or it may be a sufficient reason for importation that as yet there is no manufacture here, and the patentee did not want to prejudice his sales. But the patentee must not endeavour to stifle home industries by charging a high price for the home article—the price must be *bonâ fide* (*m*)—or by granting a licence to a British manufacturer, and then importing more than his licensee makes (*n*). Even if satisfactory reasons are given they may be rebutted by proof of abuse of monopoly (*o*).

It may be mentioned that the German decisions on the meaning of a phrase corresponding to "adequate and satisfactory" in the German Patent Law were considered early in the litigation under this section (*p*). See Dr. Paul Kent's Commentary of German Patent Law.

DEFENCE THAT THE ORDER IS CONTRARY TO ANY TREATY.
—The patentee may also urge that an order for revocation would be at variance with any treaty, convention, arrangement, or engagement between this country and another.

(*k*) *Boulton's Pat.*, 26 R. P. C. 383.

(*l*) *Ibid.*

(*m*) *Kent's Pat.*, 26 R. P. C. 666.

(*n*) *Hügner's Pat.*, 26 R. P. C. 149.

(*o*) *Osborn & Another*, 26 R. P. C. 819.

(*p*) *Johnson's Pat.*, 26 R. P. C. 52.

The Convention which is here aimed at in particular is the International Convention of 1902, which in Article 2 enacts: "That a patent, in each country, shall not be liable to forfeiture on account of failure to utilise it, until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided that the patentee cannot show reasonable cause for his inaction."

There are, of course, several other articles of this Convention (*q*) and of other treaties and arrangements which *might* become matters of defence hereunder.

CONDUCT OF THE PATENTEE—*Bona fides*.—If the patentee has acted in good faith and done all in his power the patent will not be revoked. Thus, *bonâ fide* attempts to establish industries in this country by the grant of licences for example, even if they fail, will excuse. For the Act is not intended to penalise want of success (*r*). Again, if the patentee imports, but gives a British company a licence also penalising his own importation by royalties, his patent will not be revoked (*s*). Also, in the case where the Court is satisfied with the stability and *bona fides* of the patentee, and it is shown that manufacture will shortly take place, no revocation order under sub-sect. 2 (b) will be made (*t*). And where the patentee had placed a small installation in London, and had circularised firms and obtained an agreement for a licence, a revocation order under sub-sect. (2) (b) was discharged (*u*); but the demand for the patented article in this case was limited.

At the same time the patentee may be perfectly *bonâ fide* in his own manufacture, and yet be brought within the section by the acts of his licensees or others holding under him: their acts are, for the purpose of the section, considered as his acts. Thus manufacture here on a small scale by the

(*q*) The text of this Convention may be purchased at Messrs. Wyman & Son's, Fetter Lane, E.C.

(*r*) *Bremer & Hogner's Pat.*, 26

R. P. C. 449.

(*s*) *Ibid.*

(*t*) *Jottrand's Pat.*, 26 R. P. C. 830.

(*u*) *Weber's Pat.*, 27 R. P. C. 300.

patentee and importation on a large scale by his licensees will be grounds for revocation (*x*). It is no use for the patentee to argue that he suffers hardship, since he cannot control the acts of his licensees: the answer is that they have as great a stake as he in preserving the patent (*y*).

But, on the other hand, the manufacture by infringers or licensees in this country must be taken into account in favour of the patentee (*z*); and it is not material to the inquiry whether what has been done in the United Kingdom is or is not in derogation of the patentee's rights under the patent (*a*).

Mala fides.—A presumption of *mala fides* arises if the patentee delays to take any steps to comply with the section until after the commencement of proceedings to revoke (*b*); or until just before the end of the year of grace allowed by the section (*c*). It will be no excuse to say that he misapprehended the meaning of the section (*d*); ignorance of the law does not excuse.

But this presumption may be rebutted by good reasons shown, as in the circumstances set out on page 115. Or in the circumstances that negotiations for sale were commenced within four years of the sealing of the patent, which resulted in the assignment to a British company, who had manufactured a few articles before the hearing and could at the time of the hearing manufacture to a substantial extent; these circumstances are satisfactory reasons (*e*). Also, the difficulty of starting a new manufacture here (*f*) is an answer in such circumstances as where the patentee has made only one machine here, another being completed and others almost completed at the date of the hearing (*g*).

But a patentee ought not to use the period prescribed

(*x*) *Bremers' Pat.*, 26 R. P. C. 114.

(*y*) *Ibid.*

(*z*) *In re Mercedes Daimler Co.*, 27 R. P. C. 409.

(*a*) *In re Fiat Motors*, 27 R. P. C. 762.

(*b*) *Boult's Pat.*, 26 R. P. C. 336.

(*c*) *Fell's Pat.*, 27 R. P. C. 25.

(*d*) *Worring & Kortenbach's Pat.*, 26 R. P. C. 163.

(*e*) *Jottrand*, 26 R. P. C. 830.

(*f*) *Bremer & Hognor's Pat.*, 26 R. P. C. 449.

(*g*) *Kent's Pat.*, 26 R. P. C. 666.

by sect. 27 (1) for the development of foreign industries as opposed to the industries of the United Kingdom, and at the end of the period seek to defend himself by offering to grant licences here. If he exercises his rights to give other countries four years' start he is not acting fairly. He must at least take as much pains to develop the new industries here as he does abroad (*h*).

Any one acquiring the patent rights is in no better position to defend the patent against revocation than was the patentee (*i*).

The applicant must also act *bonâ fide*, and the Comptroller will endeavour to defeat *malâ fide* applications (see page 117). A dishonest application under sect. 27, even if fully proved, need not be granted by the Comptroller (*k*).

INQUIRY INTO THE NATURE OF THE PATENTED ARTICLE.—

As mentioned on page 112, it is material to an inquiry under sect. 27 to consider the nature of the patented article (*l*). The principle being that to come within the meaning of "adequate" the process must be in substantial use here for the primary purposes of the invention. It seems that the applicant will fail to discharge the onus imposed upon him by sub-sect. 1 by proving that for another purpose satisfactory use is not made here of the invention (*m*). In this case the patentee's counsel stated that for the other purpose licensees had been obtained. If the real invention is manufactured here, but a subsidiary thing claimed in combination is not, and of which subsidiary thing no particular form is specified, it is not necessary for the subsidiary thing to be manufactured here (*n*). A patentee's claims, if too widely drawn, may stop him from showing that the matter complained of is only subsidiary (*o*).

As a general rule, the patentee ought not to be called

(*h*) Parker, J., in *Hatschek's Pat.*,
26 R. P. C. 228.

(*i*) *Hatschek's Pat.*, 26 R. P. C. 1.

(*k*) *Ilgner's Pat.*, 26 R. P. C. 198.

(*l*) *Weber's Pat.*, 26 R. P. C. 307.

(*m*) *Boult's Pat.*, 26 R. P. C. 424.

(*n*) *Lake's Pat.*, 26 R. P. C. 444.

(*o*) *Ibid.*

upon to manufacture something which he has not specifically described or claimed in his specification (*p*). What the patented article is in each case must be determined after an examination of the whole specification, which is to be construed like an ordinary legal document.

The matter can be analysed thus (*q*) :—

If the patentee claims a wholly new machine he must manufacture it here.

If the patentee claims a new improvement on an old machine he must manufacture the improvement here.

If the patentee claims a new improvement in combination with an old machine he must manufacture the improvement here, and put the whole together here.

If the patentee claims a new combination of old parts he must put the whole together here.

It is not material to consider the date of the patent, except as regards the year of grace given by the section and the four years given by sub-sect. 1. All patentees are in the same position whether their patent was granted before or after the Act, though to a limited extent there may be reasons which are satisfactory in the one case but not in the other (*r*). But perhaps a less rigorous standard will be applied to patentees before 1907, as the Act of 1902, which, in fact, contained a similar remedy, was not strictly enforced (*s*).

“FORTHWITH OR AFTER AN INTERVAL.”—The patent will be revoked forthwith when the applicant establishes his case; but in exceptional cases, as when there is reason to suppose that the manufacture is being so arranged that in a short time it will no longer be within the section, and/or when there appear to be real efforts on the part of the patentee, the order for revocation will be made to take effect after an interval, so that the patentee shall have an opportunity of righting himself in the interval. By showing adequacy during the interval he may obtain a cancellation of the order

(*p*) *Lake's Pat.*, 26 R. P. C. 444.

26 R. P. C. 239.

(*q*) *Ibid.*

(*s*) *Boult's Pat.*, 26 R. P. C. 386.

(*r*) Parker, J., in *Hatschek's Pat.*,

at a hearing which will be given to allow him to show this (*t*). If after the interval allowed, the section is still not complied with by the patentee, a further extension of time (not exceeding twelve months, s. 27 (3)) may be obtained on satisfactory reasons being given by the patentee. But the order will not be made to take effect after an interval, or the time extended, merely to allow time on the chance of an industry springing up here (*u*). Nor is there reason for making the order "after an interval" when it is definitely shown that there will be adequate manufacture in a short period: the order should then be made forthwith or not at all (*x*).

PROCEDURE: CONSIDERATION AND ENQUIRY.—The special Rules, which by virtue of sect. 86 (2) have the force of statute, regulating the procedure under this section are: Rules 78, 79, 80, and 81 of the Patents Rules, 1908 (see Appendix).

The statutory Rules provided the following process:—

Application by anyone on Form 24.

Declaration in answer by the patentee.

Declaration in reply by the applicant.

This course of procedure left the loophole that the section could be made machinery for fishing interrogatories directed to obtain particulars of the patentee's (*i.e.* the applicant's trade competitor's) business. This follows, for should the patentee fail to answer the applicant's Form 24 his patent will, following these Rules, be revoked. When this point first came up the Comptroller decided that there was a conflict between the Act and the Rules, and he held that there was no onus on the applicant to prove manufacture exclusively or mainly outside the United Kingdom (*y*). This conclusion was, however, declared by the High Court to be contrary to the spirit of the Act, and it was decided that the Act and Rules threw upon the applicant the duty of establishing a *prima facie* case (*z*).

(*t*) *Weber's Pat.*, 27 R. P. C. 300.

(*y*) *Ilgner's Pat.*, 26 R. P. C. 198.

(*u*) *Hatschek's Pat.*, 26 R. P. C. 247.

(*z*) *Hatschek*, 26 R. P. C. 228;

(*x*) *Boult's Pat.*, 26 R. P. C. 386.

Lake's Pat., 26 R. P. C. 444.

This being so, it is clear that the Comptroller must be satisfied from the application that there is a *primâ facie* case, or else he must appoint a preliminary hearing to decide this point before calling on the patentee for his particulars. It is also clear that the patentee's declaration need not in this first instance specify any details whatever of his business; it seems that he could deny the applicant's allegations by his declaration, and submit that there is no case for him to answer. This course, however, will only be advisable when the applicant's case is fishing. If the applicant has made out a *primâ facie* case the patentee can only cause delay, and possibly suffer in costs, by not giving at once full particulars in answer. Even if there is no *primâ facie* case, but the patentee sees or knows that a case can be made out, and will eventually be made out, he had better at once give full particulars; for if one application be dismissed another can be brought, and he may defeat and so daunt his opponent owing to the opponent's insufficient particulars in a carelessly made application (a).

In accordance with the interpretation of the law given in the cases quoted above, rules were made by the Patent Office. Though the Comptroller has a general authority over the Patent Office and the procedure thereat (s. 62), these rules have not the authority of statute: they may be said to interpret Rules 78-81, and they have the authority of the judgment of Parker, J., in *Hatschek's Case* (b). For these rules see Appendix (page 284).

Under these rules the Comptroller will first consider if the applicant has made out a case, and then will inquire into the matter at a hearing; but in the ordinary case, where the patentee admits the applicant's first statement of manufacture abroad, the consideration and enquiry of sect. 27 (2) will be the same. Since the matter to be considered and inquired into is the same, this is a convenient practice. Should the patentee elect to fight the matter out by contesting the fact of manufacture abroad only and then fail, the Comptroller

(a) *Kent's Pat.*, 26 R. P. C. 666.

(b) 26 R. P. C. at p. 247.

will grant him an adjournment, in a proper case, to allow him to file further evidence to prove adequacy and satisfactory reasons (c).

PRACTICE UNDER SECT. 27.—The general practice discussed in Chapter X. is applicable to proceedings under this section. The following are the special details which apply to and have arisen out of sect. 27 proceedings.

Under Rule 81 the Comptroller has wide powers to call for other assistance. If there is any reason to suspect that an application is *malâ fide*, the Comptroller will fix a *preliminary hearing* (d) and stay the proceedings; if he finds *mala fides* he will be able to penalise the applicant in costs. After any preliminary hearing, which may be held to decide such questions as whether there is a case for the patentee to answer, the Comptroller will adjourn the case as, and as often as, he thinks fit. Thus an applicant may be granted an adjournment on terms as to costs to give him time to consider whether he will proceed (e), or to file fresh evidence (f). Separate applications made in respect of separate patents may be consolidated into one application: this is usually done by agreement between the parties (g).

There is no reason why the defendant in an infringement action should not apply under sect. 27 while the action is pending or being tried (for the provisos of sects. 21 and 26 are omitted from sect. 27); but this is a matter for the discretionary powers of the Comptroller, and the defendant must not be allowed to fish out a case by means of the section (h).

Evidence.—The Rules, 78 to 81 and 1 to 6 of the Patent Office Rules, show clearly what evidence must be filed and when it must be filed. Witnesses may be examined *vivâ voce* (under sect. 77) (i). Whether an expert who has not made a declaration in the case should be examined *vivâ voce* was

(c) *Ilgner's Pat.*, 26 R. P. C. 198.

(d) *Ibid.*

(e) *Boult's Pat.*, 26 R. P. C. 384.

(f) *Hatschek's Pat.*, 26 R. P. C. 1.

(g) *Hatschek's Pat.*, 26 R. P. C. 1.

(h) *Ilgner's Pat.*, 26 R. P. C. 198.

(i) *Hatschek's Pat.*, 26 R. P. C. 1;

Johnson's Pat., 26 R. P. C. 52.

doubted in *Högner's Pat.*, 26 R. P. C. 149. An extension of time for filing evidence may be granted in accordance with Rule 79 (*k*).

If the patentee consents to revocation and files no evidence under Rule 79, there will be no hearing though the applicant may desire one (*l*). If a party has not complied with the Rules, and this is disputed, a preliminary hearing will take place to decide the matter (*m*).

Procedure on Appeal.—This book is not properly concerned with appeals under this section, for they are appeals to the Court. But for the sake of completeness, and since the section and decisions quoted are recent, the notes of practice from the reported cases on appeal are included. As a general rule, on appeal, the patentee (and presumably the applicant) ought to be confined to the case made before the Comptroller, and not allowed to set up a fresh case or adduce fresh evidence (*n*).

Evidence on Appeal.—The evidence used on appeal is the same as that placed before the Comptroller; but the Court has power to allow further evidence on appeal under Order 53A, Rule 6, and in a proper case leave to give it will be granted. But the Court must be informed what sort of evidence is proposed to be given, as it will not give leave generally for fresh evidence. Thus (*o*) Parker, J., gave leave to file evidence in a case where no evidence had been given nor appearance made before the Comptroller. The circumstances here were that, the patentee being bankrupt, the patent had fallen into the hands of a liquidator shortly before the case was heard by the Comptroller, and the liquidator had no means of adducing evidence. But, though a general leave for fresh evidence will not be given, it does not follow that the fresh evidence may not alter the whole complexion of the case, as indeed it did in the case quoted (*p*). Any one purchasing *pendente lite* (*q*) in a

(*k*) *Brooke's Pat.*, 26 R. P. C. 162;
Hatschek's Pat., 26 R. P. C. 228.

(*l*) *Muller's Pat.*, 26 R. P. C. 209.

(*m*) *Boult's Pat.*, 26 R. P. C. 384.

(*n*) *Hatschek's Pat.*, 26 R. P. C.
 247.

(*o*) *Green's Appn. in re Jonker-*

gouw's Pat., 28 R. P. C. 28.

(*p*) *Jonkergouw's Pat.*, 28 R. P. C.
 423.

(*q*) The liquidator in the case quoted had sold the patent, on the day before the hearing before the Comptroller, to a purchaser.

revocation case (*i.e.* after the application in such case) will be in no better position than the vendor either as regards the indulgence for fresh evidence or otherwise (*r*).

Costs.—Costs will be usually granted to the successful party, but a special order will sometimes be made. Thus, when there was no manufacture, at the date of the application in this country, but there was such manufacture at the date of the hearing, the application failed, but no costs were given to the patentee(*s*). No costs will be given if the patentee admits the truth of the application promptly (following the practice of Official Notice of Procedure, page 284) (*t*). That the applicants had justifiable grounds for applying will be considered in giving costs (*u*); and if the case is proper to be brought before the Comptroller under sect. 27, the patentee is not entitled to costs up to the date of the hearing (*x*).

Where no costs are given on appeal the costs of the Attorney-General, if he appear, may be divided between the parties (*y*).

(*r*) *Green's Appn. in re Jonker-
gouw's Pat.*, 28 R. P. C. 28.

(*s*) *Boult's Pat.*, 26 R. P. C. 424.

(*t*) *Taylor's Pat.*, 26 R. P. C. 381;
but see *Brooke's Pat.*, 26 R. P. C. 162.

(*u*) *Jottrand's Pat.*, 26 R. P. C. 830.

(*x*) *Osborn & Another*, 26 R. P. C.
819.

(*y*) *Bremer & Hogner's Pat.*, 26
R. P. C. 449.

CHAPTER IX.

REGISTER OF PATENTS.

SECT. 28 provides that a book called the Register of Patents be kept at the Patent Office. The purpose of the register is to provide all the information regarding a patent in a form easily accessible to the public, and for this purpose the register is made *primâ facie* evidence of all the matters entered therein (s. 28 (3)). This register may be inspected by the public at the Patent Office during the hours of business (s. 67 ; Rule 94). Into this register are entered the names and addresses of the patentees, amendments, extensions, revocations, and all matters such as licences and assignments affecting the proprietorship of patents. No document can be entered until the patent is actually sealed.

The patentee may alter his name or address by Form 25 (Rule 84). An entry of payment or non-payment of fees is to be made (Rules 92 and 93). A request for entry on the register must state particulars regarding the applicant and his interest (Rule 87), and is made on Form 27 or 28 and signed by the applicant or his agent (Rule 86). Names of individual members of firms should be set out in the form of request for entry. The Comptroller must have the documents giving evidence of title produced to him (Rule 88), and a copy must be left for the Office (Rule 89). The original document must be stamped in accordance with the Stamp Act, 1891, and the copy must bear a shilling impressed stamp, and be written on foolscap paper, on one side only. The register may be rectified on application to the Court (s. 72). Certified copies of entries in the register may be obtained on application (s. 67).

ENTRY OF INTERESTS ON THE REGISTER.—Sect. 71 provides for entry on the register of two classes of interests:—

- (1) As proprietor: in this class are included the legal owners of the patent only (sub-s. (1)).
- (2) As a person interested: in this class are entered mortgagees, licensees, etc. (sub-s. (2)).

But no notice of a trust may be entered on the register (s. 66).

The person entered on the register as proprietor may deal with the patent absolutely (sub-s. (3)). Entry in the class of sub-sect. (2) gives no rights of proprietorship, and operates merely to give notice to any one who examines the register of an interest in the patent.

It is not the Comptroller's duty to inquire into the validity of any deeds or documents which are presented to him for registration. Neither will he consider whether they have been obtained by fraud. If they are properly executed he will inquire no further (*a*). He might, however, postpone the entry on the register, upon a sworn statement of facts, pending an action to set documents aside (*b*). It will be noticed that sect. 72 gives a remedy, for any wrongful insertion or refusal to insert, by application to the Court, the application being by motion to any judge.

Entry under the first sub-section is given to those in possession of a complete legal interest only (*c*). The second sub-section may be read thus: Any person entitled to an interest as mortgagee, licensee, or by any properly executed document known to the law, may be registered (*d*). Thus equitable assignments of the whole or part of the patent may be entered on the register under sub-sect. (2) (but not under sub-sect. (1)), as documents affecting the proprietorship of the patent (*e*).

No entry can be made with regard to patents which have

(*a*) 27 R. P. C. 1910, E.

(*b*) *Ibid.*

(*c*) *E. R. Bowden v. Smith*, 21 R. P. C. 439; *Stewart v. Casey*, 9

R. P. C. 9; 27 R. P. C. 1910, E.

(*d*) *Stewart v. Casey*, 9 R. P. C. 9;

27 R. P. C. 1910, E.

(*e*) *Ibid.*

lapsed or expired (*f*). If it is desired to enter on the register the assignment of a patent which is not yet sealed, such an assignment being equitable cannot be entered under sub-sect. (1)(*g*); it is doubtful whether it can be entered under sub-sect. (2). There may, however, be documents *dated* before the grant which may be entered on the register after the patent is granted; an agreement as to ownership is such a document; so long as such a document (*) contains sufficient proof of title it may be entered. The document entered on the register must be completed, or completed by another document which will be entered with it. It will not do that an incomplete document is completed by a parol agreement. Thus, a letter granting a licence "on the terms to be agreed upon" does not give a legal or equitable interest in the patent and cannot be registered (*h*). Mortgagees are entered as mortgagees, not assignees, and it seems from *Van Gelder Co. v. Sowerby* (7 R. P. C. 41, 208) that the mortgagee and mortgagor constitute together the proprietor.

Examples of what may be entered on the register are:—

- | | |
|---|--|
| 1. Names and addresses of grantees of patents. Payment of fees. | Law Officer regarding a patent. |
| 2. Notifications of assignments. | 10. Orders in Council affecting a patent. |
| 3. Licences under patents. | 11. Certificates of enlargements of time for the payment of renewal fees. |
| 4. Amendments of patents. | 12. Notifications of the expiry of patents. |
| 5 Extensions " " | 13. Documents affecting the ownership of patents, <i>e.g.</i> assignments, agreements to sell. |
| 6. Revocations " " | |
| 7. Applications for the amendment of specifications. | |
| 8. Notices of oppositions to specifications. | |
| 9. Decisions of the Comptroller or | |

Any person interested in a particular patent may lodge a request at the Patent Office, asking that he may be informed

(*f*) 27 R. P. C. 1910, E.

(*g*) *Bowden v. Smith*, ante.

(*) *Parnell's Pat.*, 5 R. P. C. 126.

(*h*) *In re Fletcher's Pat.*, 10 R. P. C.

252: *Haslett v. Hutchinson*, 8 R. P. C. 457.

of any subsequent application for registration in the matter of the particular patent. Upon a subsequent application being made by another, the Comptroller will notify the person making such a request, and delay the further registration for a few days to enable objection to be taken to that registration. A person who has lodged such a request and is aggrieved by an attempted registration should notify the Office and apply to the Court to serve early notice of motion, which leave he will obtain as a matter of course (*i*).

EFFECT OF ENTRY ON REGISTER.—As has been mentioned, the register is *primâ facie* evidence of matters entered therein, but the register is not conclusive evidence. In an infringement action the Court decided that the defendant who appeared, from the register, to be entitled to a licence under the patent was not so entitled (*k*). Further, the register is not notice to the whole world; thus, if a limited licence within a district is entered on the register, this entry is not a notice to an innocent purchaser living outside that district (*l*). It has been pointed out that the person entered under sub-sect. (1) may deal with the patent absolutely (p. 127), and therefore an assignee or vendee who neglects to register his interest is in danger; for the patent may be assigned behind his back by the previous registered owner and he will have an equitable remedy only (s. 71). It would seem from *Hassall v. Wright* (L. R. 10 Eq. 509) that registration is retrospective in that, being merely evidence of title, it relates back to the date of an assignment. This view is strengthened by the case of *Ellwood v. Christy* (17 C. B. N. S. 754, 18 C. B. N. S. 494). It is doubtful if an assignee can sue on the patent before registration, since the proviso of sect. 35, Act of 1852, is now repealed; but see *Chollett v. Hoffman*, 7 Ell. & B. 686, and *Hassall v. Wright*, L. R. 10 Eq. 509.

(*i*) *Viola v. Sharpe*, 22 R. P. C. 23.

(*l*) *Heap v. Hartley*, 5 R. P. C. 603;

(*k*) *Actien Gesellschaft v. Temler*, 6 R. P. C. 495.

18 R. P. C. 14.

CHAPTER X.

DETAILS OF PRACTICE BEFORE THE COMPTROLLER.

THE practice at the Patent Office and on appeal therefrom is regulated by the Patents and Designs Act of 1907 and the Patents Rules of 1908. These Rules have the authority of statute by sect. 86 (2) of the Act, under which the Board of Trade has authority to make rules. Three further sets of directions for regulating the procedure under sect. 7, sect. 8, and sect. 27 respectively of the Act have been issued by the Comptroller (see Appendix); but these last rules have no statutory authority. They regulate procedure, and as the Comptroller has a general power over the procedure before him they should be followed. Below will be found some miscellaneous notes of practice and procedure not included under the former separate headings.

OPPOSITION CASES (see p. 44).

An amendment of notice of opposition under sect. 11 (1) (b) may be made at any time, even after the two months specified by the section (Rule 40 does not prevent this): but this does not remove the obligation on the opponent to give his case at the earliest possible moment (*a*). The section would be satisfied by stating generally on the notice the grounds of opposition (*b*). The statement of the amendments desired under Rule 40 may properly specify alternative remedies (*c*).

In opposition cases under (b) and (c) of sect. 11 (1) experiments are sometimes necessary in order to decide the matter. The Comptroller has power to ask for experimental proofs,

(a) 26 R. P. C. 1909, No. VI.; 27
R. P. C. 1910, C.

(b) *Ibid.*

(c) 27 R. P. C. 1910, H.

but he should not do so unless disclaimers, references, and amendments are useless, and experiments are clearly necessary (*d*). The experiments should be carried out in the presence of both parties and, preferably, of an expert chosen by the Comptroller (*e*).

EXERCISE OF DISCRETIONARY POWERS.

"The proceedings before the Comptroller have always been conducted on wide and not unduly formal lines, and I think it desirable that this should be continued" (*f*). It will follow, therefore, that the Comptroller will probably use the very wide discretionary powers given him by the Act to vary the Rules to suit the justice of any particular case. He is forbidden by sect. 72 to use these powers adversely to an applicant for a patent or an amendment without granting a hearing to him; no mention is here made of the opponent or the applicant for revocation; presumably it would be within the Comptroller's authority to exercise these powers adversely to them and give no hearing.

The Act explicitly gives the Comptroller discretion to take the opinion of the Law Officer when in doubt (s. 74), and to refuse to grant a patent the use of which is contrary to law or morality (s. 75).

In the exercise of these and other discretionary powers given him, the Comptroller must give the applicant 10 days' notice of hearing (Rule 102), and in five days the applicant shall notify if he desire to be heard (Rule 103). The Comptroller will then call on the applicant for a statement (Rule 104), and will finally notify his decision to the applicant (Rule 105).

Such indulgences as adjournments and amendments of notices can almost always be obtained for reasonable cause shown: and as a matter of course with the consent of the other side (except in cases of collusion). The Comptroller has a general power to enlarge times for doing things under the

(*d*) 27 R. P. C. 1910, D.

(*e*) *Ibid.*

(*f*) *Per* the Comptroller in *Ilgner's Pat.*, 26 R. P. C. 198.

Act and Rules (Rule 109). The Comptroller will waive irregularities of procedure or allow documents to be amended where it appears that no substantial injustice is being done (Rule 108). For example, notices of opposition to amendments not signed by the opponent, before their acceptance in accordance with the Rules, were allowed to be signed subsequently (*g*). Again, a notice of opposition not signed by the opponent but by his agent was allowed to be amended and signed by the principal (*h*). And further, where a notice of opposition did not give the date and title of the patent as required by the Rules (see Form 8, Rules of 1908), the notice was allowed to be amended at the hearing (*i*). Similarly, where the notice was bad in that it stated that the invention or *material parts thereof* had been patented, etc., an amendment by the omission of the words in italics was allowed (*k*).

The Comptroller will dispense with a signature or an act required by the Act or Rules for reasonable cause shown (Rule 112; sect. 83). The Statute intends the procedure to be in the prescribed form; but if at any time a new case arises not contemplated by the Act or Rules, the Statute should not be allowed to fail in its operation because a form has to be slightly modified (*l*).

But an opponent under sect. 11 will be confined to his ground or grounds of opposition. If he alleges a prior grant, he cannot on that ground argue disconformity of the provisional and complete (*m*). Though he might apply for amendment of his notice and an adjournment.

Also if the notice has miscarried, though delivered according to the Statute or Rules, and consequently a party does not appear and the case goes against him, the Comptroller will not reopen his case on the application of the defeated party, for that would be unfair to the successful party. Justice is here secured by the existence of an appeal:

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|---|---|
| (<i>g</i>) <i>Codd's Pat.</i> , Gr. P. C. 305 | 1 P. C. 10. |
| <i>Daniel</i> , 5 R. P. C. 413. | (<i>k</i>) <i>Re Fawcett</i> , April 16, 1889, unrep.: see Goodeve P. C. 10, and p. 57. |
| (<i>h</i>) <i>Lake</i> , Gr. A. P. C. 35. | (<i>l</i>) <i>Grenfell & Macevoy</i> , 7 R. P. C. 151. |
| (<i>i</i>) <i>Re Airey</i> , 5 R. P. C. 348; <i>Re Welch</i> , Apr. 15, 1889, unrep.; Goodeve | (<i>m</i>) <i>Newman</i> , Gr. A. P. C. 40. |

upon these facts the Law Officer would send the case back to the Comptroller for rehearing (*n*).

In cases of opposition on separate patents it is often decided by the Comptroller to reserve his decision on one case till he has heard the other (*o*). By agreement between the parties a case, say of opposition, may be allowed to stand over till an amendment case in the same matter is heard (*p*).

AGENCY : APPEARANCE.

The proceedings regarding letters patent are usually entrusted by the patentee to a "patent agent." A Register of Patent Agents is kept by the Chartered Institute of Patent Agents in accordance with the Register of Patent Agents' Rules made by the Board of Trade (1908), (see page 291). Any one knowingly giving himself out as "patent agent" and unregistered is liable to a fine (*s*. 84).

A party to any proceeding before the Comptroller may communicate with him or appear before him by any agent duly authorized to the satisfaction of the Comptroller (Rule 9). But certain documents must be signed by the principal (*q*), and the Comptroller is not bound to recognise any particular agent (*s*. 85), and may require the signature of the principal to any document (*r*). A party usually appears at a hearing in person, by counsel or by a patent agent, but any person may appear as his agent, though he is not entitled to describe himself as a patent agent (*s*). Sometimes, as in *Johnson's Case* (*t*), a party will indicate his case by letter. The interests of a party who is unable to appear are well protected by the Comptroller.

EVIDENCE.

The evidence given in any proceeding before the Comptroller will usually be by statutory declaration; but

(*n*) *Warman*, Gr. A. P. C. 43.

(*r*) *Ibid.*

(*o*) *Paterson's Pat.*, Gr. P. C. 295.

(*s*) *Graham v. Fanta*, (1892) 9

(*p*) *Heath & Frost's Pat.*, Gr. P. C. 311.

R. P. C. 164; *Graham v. Eli*, (1898) 15 R. P. C. 259; *s*. 84 (3).

(*q*) *Ibid.*

(*t*) 24 R. P. C. 694.

the Comptroller may, if he thinks fit, take evidence *vivâ voce*, or allow a declarant to be cross-examined instead or in addition (s. 77). When the Comptroller takes evidence *vivâ voce* he is, in this respect, in the position of an Official Referee; that is to say, in the words of Order 36, Rule 49: "The evidence shall be taken . . . and the attendance of witnesses may be enforced by subpœna, and every such trial shall be conducted as nearly as the circumstances will admit as trials are conducted before a Judge" of the High Court.

When the case is a case of fact, and must be decided on conflicting evidence, the Comptroller will require *vivâ voce* evidence. He cannot decide a conflict of evidence on declarations alone; he is in the position of a jury, and it is necessary that he should see the demeanour of the witnesses. A case of opposition on ground (a) of sect. 11 will nearly always have to be decided on *vivâ voce* evidence. If declarations have been filed in these cases, the declarations will be regarded as examination in chief, so that each party will put his witnesses in the box for cross-examination and re-examination (u).

Provisions as to the form of statutory declaration used before the Comptroller, and the manner in which and persons before whom they are to be taken, will be found in Rules 106, 107. The particular regulations affecting this matter of evidence will be found in the rules dealing with the separate proceedings: *e.g.* "opposition"; Rule 41 *et seq.*

A party should be careful to see that the declarations filed on his behalf meet the contentions of the other side.* If at the hearing he finds himself with no case because of failure to do this, an extension of time will usually be granted him, but he will suffer in costs. Thus in *Hodgkins' Appn.* (x), an opponent's case (under s. 11 (1) (b)) was that the inventions were identical up to a certain point, and beyond that there were left only matters of detail. The

(u) *Field & Burns' Appn.*, No. 2282 & 2283 of 1910, 20 July, 1911, unrep.

* If a party is to be represented by

counsel the declarations should be settled by counsel.

(x) 23 R. P. C. 527.

applicant admitted the identity up to the same point, but contended that, beyond that point, there were substantial and different matters in his own specification; but he did not file evidence in support of this second contention. He was granted an extension of time, but again failed to file the necessary evidence, and the patent was refused.

Parties should be careful to file sufficient evidence, but not an unnecessary multiplicity of declarations, and should take care to see that the declarations are confined to matters relevant to the issue. Where the Comptroller feels that unnecessary or irrelevant declarations have been filed he will endeavour to fix the costs and responsibilities of such declarations on the party responsible for them under sect. 39 (y). *Evidence may be sometimes entirely unnecessary.* When a specification is open to two constructions on the face of it, it is open to a party without giving any evidence to endeavour to satisfy the Comptroller that one of the possible constructions is the true construction, or that he wishes to limit it to one construction (z).

A specification not in evidence cannot be referred to at the hearing of an opposition or other case (a), unless 5 days' notice of it has been given, R. 47. But specifications referred to in declarations may be put in evidence for the purpose of construing a specification or determining the state of the art (b). A party cannot put in evidence specimens of the patented article which are not made exhibits in the case, but the Comptroller or Law Officer will usually look at them for his own assistance in construing the specification, but not in order to found his decision (c). A party should, therefore, be careful to make an exhibit of everything to which he may wish to refer.

EVIDENCE AFTER HEARING.—Further evidence, before the decision, will not be allowed after the case has been fully heard, unless that evidence could have been produced at

(y) Official notice of Patent Office, Jan. 19, 1895; *Brand's Appn.*, 12 R. P. C. 102.

(z) *Ryland's Pat.*, 5 R. P. C. 667.

(a) *L'Oiseau & Pierrard*, Gr. A. P. C.

36.

(b) *Jones*, Gr. A. P. C. 33.

(c) *Lancaster's Pat.*, Gr. P. C. 293.

A witness would be called to prove them, however.

the hearing, and is strictly relevant to the issue. Before allowing it the Comptroller will require to be satisfied on these two points. All such evidence is open to the suspicion that it is brought forward to meet difficulties raised at the hearing (*d*). In the case quoted the patentee desired to put forward fresh evidence; he was ordered to submit the evidence within ten days, after which the Comptroller, if he decided to consider it, would notify the other side and give them an opportunity for cross-examination.

PARTIES.

The Comptroller must be satisfied that he has the right parties before him before he decides a matter. For example, when an application for a patent or for the restoration of a patent has been made by joint parties, any further steps must be taken by the parties jointly. Thus the complete specification must be filed by them jointly. If they come with separate complete specifications the Comptroller will not accept either, for he has no jurisdiction to determine which is the right one; they must settle a form of complete between themselves or a complete will not be accepted (*e*). The complete specification or application for restoration must be signed by them or by their agents jointly, for neither party can assign his interest to the other, because there is nothing to assign before the patent is granted (see page 107), or after it has lapsed. For the purpose of signing the complete, one party could make the other party his agent: but this could not be done in the case of a restoration application (Rule 9). An amendment application or an application for duplicate letters patent or a surrender must also be signed by all the parties themselves (Rule 9), but one party could assign his interests in the patent to another party and so drop out. The assignment would have to be produced to the

(*d*) *Gascoigne's Pat.*, 22,479 of 1907,
13 July, 1909, unrep.; this was a
revocation case under s. 26.

(*e*) *Apostokoff & Freudenberg, in re
Hawkins' Appn.*, 13 R. P. C. 275.

Comptroller, and would have to be a document *primâ facie* valid; the Comptroller would not listen to any evidence to show that such a document was invalid, or accept other evidence in lieu of such a document. It is not his business to settle conflicting claims to property. Conflicting claims would have to be settled by the High Court, during which the Comptroller would stay the proceedings before him.

In *Grenfell & Macevoy's Pat.*, 7 R. P. C. 151, it was decided that "as a matter of form" the complete specification need not be signed by both of two joint applicants, where it is plain that they both join: in this case the formal difficulty had arisen from a change of patent agents. The whole question of the necessity for the presence of all the parties, and the powers of the Comptroller to consider their rights, is well illustrated in a recent case (*f*). In this case the joint applicants, A. & B., were employed by a company. A. had made an application with B.; A. signed the application as the true and first inventor, and subsequently signed the complete with B. A. then left the service of the company, and wrote from America to the Comptroller asking him to cancel the application. The Comptroller notified B. that this letter had been received, and B. asked that the grant might be made to him alone. This the Comptroller decided he had no power to do; nor could he grant to A. & B. jointly, as it is a well-established principle that no one can be forced to take a grant (*g*). It made no difference to his decision that an agreement was produced showing that both A. and B. were acting for the company in making their original application, and were bound by contract to assign to the company the benefit of their patent when granted, for the Comptroller decided that he could not consider such an agreement, and was confirmed in his decision by the Law Officer.

Grenfell & Macevoy's Case (*ante*) was distinguished in this case. In such circumstances as *A. & B.'s Appn.* (*ante*),

(*f*) *A. & B.'s Appn.*, 28 R. P. C. 454.

(*g*) *Wool Hide Syndicate v. Riches*, 19 R. P. C. 127.

the Court will grant an injunction preventing the retiring applicant from making the invention public till the conflicting rights of the applicants are decided (*h*).

HEARING.

The Procedure before and at the hearing is set out in Rules 40 to 47. It will be noticed that it is provided that the Comptroller shall decide the case even if neither party desires to be heard. This is provided because the public have an interest in the proceedings. From the same cause arises the rule that the Comptroller may refuse under sect. 11 (1) (b) on the strength of a patent not cited by the opponent, though the proper course, but not the essential, is to allow the opponent to amend his notice of opposition, under Rule 108, by inclusion of the patent (*i*). The Comptroller will not go into the question of utility on conflicting declarations (*k*); nor will he in general consider subject-matter, novelty or utility (see pp. 30, 57); nor will he enter into the contractual relations of parties before him: he has no jurisdiction to consider these matters (*l*). But it does not follow that parties having other remedies have no remedy before the Comptroller (*m*).

If a preliminary objection be taken, such as objection to the *locus standi* of opponent, and if the other side does not object, a special day may in an exceptional case be taken for the hearing of such preliminary matter (*n*).

A construction put on a specification by the Comptroller, Law Officer, or the Court in one proceeding will be followed in another and subsequent matter (*o*). The Comptroller is bound by the construction adopted by the House of Lords (*p*) or the Court.

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|---|--|
| (<i>h</i>) <i>Wool Hide Syndicate v. Riches</i> ,
19 R. P. C. 127. | <i>Riches</i> , 19 R. P. C. 127. |
| (<i>i</i>) <i>Hughes and Kennerly's Appn.</i> ,
27 R. P. C. 281. | (<i>n</i>) <i>Johnson's Appn.</i> , 24 R. P. C.
694. |
| (<i>k</i>) 27 R. P. C., 1910, D. | (<i>o</i>) <i>Re Bartlett</i> , 9 R. P. C. 511. |
| (<i>l</i>) <i>A. & B.'s Appn.</i> , 28 R. P. C. 454. | (<i>p</i>) <i>Parkinson's Pat.</i> , 13 R. P. C.
509. |
| (<i>m</i>) <i>Ibid.</i> ; <i>Wool Hide Syndicate v.</i> | |

THE RIGHT TO BEGIN.

Generally it may be said that the patentee should begin. Thus in opposition cases the applicant for a grant is entitled to begin, except in cases where the opponent bases his opposition solely on the ground (1) (a) of sect. 11; but even if the opponent bases his opposition on (1) (a) solely it may be that a point of construction arises which gives the applicant the right to begin (q). Revocation cases under sect. 26 and sect. 27 follow the same rules. The party beginning is allowed to reply (r). Whenever fraud is alleged the party who alleges fraud should begin, for the *onus probandi* is on him (s).

The practice as regards the order of hearing was well illustrated in *Field & Burns' Appn.* (t). In this case opposition was taken on ground (a), and the opponent alleged that the patent had been obtained from him, and exhibited a drawing of his which he said was made before the application was made, and which he alleged embodied the opponent's invention. It was not clear from the declarations filed whether the opponent alleged fraud on the part of the applicant or not.

The Comptroller stated that it was convenient for, and he should allow, the applicant first to explain his specification, and then the opponent could explain his drawing. The Comptroller then decided that there was a *primâ facie* case, and the applicant was allowed to begin on the declarations.

COSTS.

The Comptroller has full discretion as to costs and security for costs under sect. 39. As a rule the successful party will be given costs, except in cases where the proceedings brought by him have been unnecessary or vexatious. Where the proceedings though necessary are brought because of the carelessness or negligence of the successful party no costs will be given. For example:—

(q) 27 R. P. C. 1910, F.

(s) *Luke's Pat.*, Gr. P. C. 294.

(r) *Re Spinnerei Weberei, etc.*, Patent, March 11, 1910.

(t) No. 2282 and 2283 of 1910, 20 July, 1911, unrep.

- (1) In amendment proceedings, if the applicant has to rely on his intention at the time of drafting his complete specification, in order to render the amendment of his badly drafted specification possible (*u*):
- (2) or if the specification was originally drafted in such a loose manner that it is not surprising that rival traders oppose amendment (*x*):
- (3) or if a party has not shown good faith in the manner in which he has presented his case:
- (4) or if a party has not told the whole story in his declaration (*y*):

costs will not be given.

In general, any application or opposition, if unsuccessful, will not involve the payment of the other side's costs, if the application or opposition was justified (*z*).

A party who is substantially successful and is justified may get his costs, although he does not get all he asks. Thus, where the opponent required nothing less than refusal and the Comptroller decided on an amendment, the costs were given to the opponent (*a*). But if the opponent aims at the more drastic of two courses, and the other party offers to agree to the milder, the opponent will lose his costs if he fail in his more drastic course (*b*).

(*u*) *Allen*, Gr. A. P. C. 4.

cases.

(*x*) *Ashworth*, Gr. A. P. C. 6.

(*a*) 27 R. P. C. 1910, H.

(*y*) *Anderton*, Gr. A. P. C. 25.

(*b*) *Ibid.*; *Welch's Pat.*, Gr. P. C.

(*z*) *Hermann Aron's Pat.*, 18 May, 300.

1910, unreported, and many other

CHAPTER XI.

APPEALS.

APPEALS FROM THE COMPTROLLER.—An appeal lies to the Law Officer—

(A) In application cases where the patent is refused or amendment of the specification is required under sect. 3, sect. 6 or sect. 7, or in the matter of Convention applications under sect. 91. No appeal is provided for in decisions to insert a reference under sect. 8.

(B) In opposition cases under sect. 11.

(C) In amendment cases under sects. 21 and 22.

Also the Comptroller may apply to the Law Officer in any case of doubt or difficulty for directions (s. 74).

From the Law Officer there is no appeal: his decision is final on all matters which come before him (a) on appeal for the Comptroller, and in directing the Comptroller under sect. 74; his is not a Court in the ordinary sense, and no appeal lies from him therefore.

There is an appeal from the Comptroller to the Court in—

(D) Restoration cases under sect. 20.

(E) Revocation cases under sect. 27.

(F) Rectification of register under sect. 72.

If the Comptroller neglect to perform any statutory duty laid upon him he may be compelled to perform it by means of a mandamus of the High Court (b). If he does anything beyond his statutory powers he may be checked by a writ of prohibition (c).

(a) *Ex parte Tomlinson*, 16 R. P. C. 233. *Cos.*, 21 Q. B. D. 131.

(c) *In re Hall & Others*, 5 R. P. C. 306.

(b) *R. v. Registrar of Joint Stock*

APPEALS TO THE LAW OFFICER.

The procedure to be followed on appeals to the Law Officer is regulated by Law Officer's Rules (1907): see Appendix (page 282). The appellant must file a notice of appeal within 14 days signed by him or his agent (*d*), stating the matters particularly appealed against (Rules I. and II.), and send a copy to the Law Officer's clerk (Rule III.). The Comptroller or Law Officer may enlarge the time for appealing (Rule V.). The Law Officer will give at least seven days' notice of the hearing to the parties and the Comptroller, unless in a special case shorter notice be given (Rules VI. and VII.). If the notices are not sent as directed, the Law Officer will adjourn the hearing until they are sent (*e*).

The appeal is confined to the questions specifically raised in the notice of appeal (Rules I. and II.), and a party who desires to question other parts of the Comptroller's decision should amend the notice or give a counter-notice. If the original notice is delivered at the end of the time for appealing, the time for giving a counter-notice may be extended under Rule V. (*f*).

The Law Officer is given a general power over the procedure before him and as to costs (s. 40). Appeals are not to be encouraged, and therefore, unless the appellant is completely successful, no costs will be given him (*g*). The Law Officer expressed a doubt in *Sachse's Appn.* (*h*) whether he had jurisdiction to consider if the matter left in the specification by the Comptroller was patentable. In general the Law Officer has no wider jurisdiction than the Comptroller; for example, he cannot hear people who have no *locus standi* before the Comptroller (*i*). The Attorney-General

(*d*) Rule 9; *Anderson & Mackinnell*, Gr. A. P. C. 23.

(*e*) *Re Hill*, 5 R. P. C. 601.

(*f*) *Bairstow*, 5 R. P. C. 286.

(*g*) *Haddan*, Gr. A. P. C. 12;

Hookham, Gr. A. P. C. 32.

(*h*) 18 R. P. C. 221.

(*i*) *Stewart's Appn.*, 13 R. P. C. 627; *Ex parte Tomlinson*, 16 R. P. C. 233.

and Solicitor-General severally or together have the same powers when acting as Law Officer (*k*).

Evidence on Appeals to the Law Officer.—Rule VIII. of the Law Officer's Rules provides that the evidence used on appeal to the Law Officer shall be the same as that at the hearing before the Comptroller. Further evidence can, however, be given by the leave of the Law Officer; and at the request of either party the attendance of any witness who has made a declaration may be ordered for cross-examination, unless the Law Officer is of opinion that there is good ground for not making such an order (Rule IX.). Time will be granted and the hearing of the appeal adjourned in a proper case to allow the fresh evidence to be filed (*l*). But the Law Officer will not allow a fresh anticipating patent to be cited on an appeal in an opposition case: this is not fresh evidence, but a fresh ground of opposition (*m*); nor will he allow fresh evidence to be filed in support of the allegation of fraud which was not particularly alleged before the Comptroller (*n*).

Practice on Appeals to the Law Officer.—The Law Officer attaches importance to the ruling of the Comptroller on any matter which affects the Office (*o*). Generally, where the Comptroller has allowed a patent, the Law Officer must be very clear that the grant should be refused before he interferes with the decision (*p*).

If the opponent objects to the inclusion of certain words in an applicant's specification and the Comptroller orders them to be struck out, the opponent cannot ask for their reinsertion on appeal (*q*). When a case comes before the Law Officer on appeal and objection is taken by the appellant on some point, as *locus standi*, not raised before the Comptroller and which the appellant is successful in sustaining,

(*k*) *Ex parte Tomlinson*, 12 R. P. C. 233.

(*l*) *Hodgkins' Pat.*, 23 R. P. C. 527; *Arthur Hudson's Pat.*, 22 R. P. C. 218.

(*m*) *Bailey's Pat.*, Gr. P. C. 269.

(*n*) *Huths' Pat.*, Gr. P. C. 292.

(*o*) *In re Appn. under Sect. 103 of the Act of 1883*, 23 R. P. C. 788.

(*p*) *Glossop's Pat.*, Gr. P. C. 285.

(*q*) *Cheesebrough's Pat.*, Gr. P. C. 303.

nevertheless the Law Officer must be satisfied, before interfering with the Comptroller's decision, that, looking at the substance of it, it should be interfered with (*r*).

If the party not appealing wishes the Comptroller's decision to be varied on appeal he should file a cross-appeal asking for what he wants (for example, an applicant who desires the amendment of his specification), otherwise he is not sure to obtain it without the consent of the party appealing (*s*).

The Law Officer will follow the construction put by him on the specification in a previous and separate matter (*t*), and is bound by the construction put on the claim by the High Court (*u*).

If a party in an appeal does not appear, and has given no notice that he did not intend to do so, the Law Officer will adjourn the case at the expense of the absent party (*x*).

The time for appealing is fourteen days from the Comptroller's decision (Law Officer's Rules, V.), but the Comptroller may allow further time; it is the practice to count the fourteen days from the date when the Comptroller's definite order is made. For example, if the Comptroller impose alternative amendments, then the time runs from the time when the amendment, framed and selected by the applicant, is accepted by the Comptroller (*y*). It will not do to allow the time for appealing to elapse and then bring a fresh application on the same matter before the Comptroller and appeal from the result of that, if it be unfavourable. The Comptroller must not be left open to the nuisance of having to consider the same amendment several times (*z*); and it will not be a sufficient explanation if the applicant file declarations, to explain this, which state that he was unaware, until the second application was made, that there was an appeal from the Comptroller.

A case decided by the Law Officer will not be reopened

(*r*) *Heath & Frost's Pat.*, Gr. P. C. 509.
288.

(*s*) *Re Hall & Hall*, 5 R. P. C. 283.

(*t*) *Re Bartlett*, 9 R. P. C. 511.

(*u*) *Parkinson's Pat.*, 13 R. P. C.

(*x*) *Ainsworth's Pat.*, Gr. P. C. 269.

(*y*) *Chandler's Pat.*, Gr. P. C. 271;

Cooper & Ford's Pat., Gr. P. C. 276.

(*z*) *Arnold*, Gr. A. P. C. 5.

unless it can be shown that there has been fraud, serious mistake, or a miscarriage of justice (*a*).

Where the patent is opposed under sect. 11, and the decision of the Comptroller is appealed from, and where the opponent does not appear, or for some reason the opposition is withdrawn, it does not follow that the patent will be granted; for the mere withdrawal of the opposition does not entitle the applicant to a grant (*b*). The contest between the applicant and the opponent is one in which the public have an interest, though the opponent no doubt comes forward in his own interest (*c*). Thus where the opposition had been withdrawn pending appealing owing to an agreement between the applicant and the opponent, and the opponent produced a certified copy of such agreement at the hearing before the Law Officer, a patent was nevertheless refused on the ground that it was not proper subject-matter (*d*). In such cases a satisfactory explanation should be made by the applicant of the failure of the opposition, and the hearing will be adjourned for such an explanation. *A fortiori* if the appeal has been decided any agreement for the withdrawal of the opposition will not effect a reversal of the decision (*e*). But if the public interest is not imperilled, the failure of the opponent to appear will result in the dismissal of the appeal: as where on non-appearance it transpired that the opponent had asked the applicant for an adjournment which had been refused (*f*).

Costs on Appeals to the Law Officer.—The Law Officer has discretion as to costs (Rule XI.). The costs on appeal will as a rule be made to follow the event, but in special circumstances, or where further evidence or special matters are brought forward which might have influenced the decision of the Comptroller, this rule will not apply (*g*). If the Law Officer dismisses the appeal on other grounds than those upon

(*a*) *Thomas & Prevost's Appn.*, 15 R. P. C. 257.

(*b*) *Kempton & Mollan*, 22 R. P. C. 573.

(*c*) *Thomas & Prevost's Case*, 15 R. P. C. 257.

(*d*) *Kempton & Mollan, ante*.

(*e*) *Thomas & Prevost*, 15 R. P. C. 257.

(*f*) *Re Dietz*, 6 R. P. C. 297.

(*g*) *Webster, A.-G.*, in *Stubbs' Pat.*, Gr. P. C. 298.

which the Comptroller decided the case, then no costs will be given (*h*); or if the Comptroller make an order which is not asked for or insisted on by the respondent to the appeal, and when the appellant is justified in bringing the appeal, no costs will be given against the respondent (*i*). Costs will not be given to the opponent if the Comptroller thought that he was to blame for not inserting a disclaimer in the first instance (*k*). Costs are not usually given to such an amount as to indemnify the parties (*l*). The practical objection to (or advantage of) appeals to the L. O. is the delay, often great before they are heard, and consequent delay in sealing.

APPEALS TO THE COURT (see p. 124).

Appeals to the Court under sects. 20, 26, and 27 are regulated by Order 53A, Rule 4. The time given for lodging the appeal is one calendar month, or such further time as the Court may allow in special circumstances. The appeal is an ordinary appeal, and the Long Vacation does count in the month allowed. If the time allowed has expired, it will not serve to prove that the appellant's counsel was away and that his patent agents were unable to lodge the appeal in consequence (*m*). This book is, however, not concerned with a further consideration of these appeals to the Court.

SEALING OF THE PATENT AFTER THE HEARING OF AN APPEAL.

By sect. 12 a patent must be sealed within fifteen months of the date of application: this term may be further extended up to nineteen months by the Comptroller. But after the expiration of this period the patent can only be sealed by the direction of the Law Officer, and this direction will not be given unless the delay was caused by an appeal or opposition

(*h*) *Re Tattersall*, 9 R. P. C. 150.

(*i*) *Van Gelder*, 9 R. P. C. 325.

(*k*) *Welsh's Pat.*, Gr. P. C. 300.

(*l*) *Re Stuart*, 9 R. P. C. 452.

(*m*) *Beldam's Pat.*, 27 R. P. C. 759.

proceedings. If it cannot be said that the delay was not caused by such proceedings, or if the applicant's case does not rest upon the evidence filed after delay, the Law Officer will direct a patent to be sealed (*n*). But when the time for sealing has expired by reason of the applicant's neglect or endeavour to extend the time for sealing for his own purposes, the Law Officer will not direct a patent to be sealed. Thus, when the delay was caused by neglect to comply with the Comptroller's amendment order (*o*), and when the delay was caused by the applicant's endeavour to save his patent abroad (*p*), no patents were sealed. The last-mentioned case was strengthened by the fact that the opposition was filed at the last moment; extension of time to file evidence was obtained, but none was filed, and neither the applicant nor the opponent appeared before the Comptroller; finally an appeal was lodged, but again neither party appeared. Such collusive proceedings to gain time will prevent the Law Officer from directing the sealing; if collusion is suspected, satisfactory evidence of the nature of the proceedings will be demanded. Patent agents who enter bogus oppositions run the danger of being reported to the Board of Trade (*q*).

(*n*) *Re Kitson*, 7 R. P. C. 388.

(*o*) *A. & B.'s Appn.*, 13 R. P. C. 63.

(*p*) *A. & B.'s Appn.*, 19 R. P. C. 556.

(*q*) *Ibid.*

CHAPTER XII.

MISCELLANEOUS.

THE following miscellaneous matters affecting the proceedings at the Patent Office are inserted to complete this book. They are taken, with some few additions, from the Instructions to Applicants issued by the Office.

DURATION OF PATENT AND PAYMENT OF RENEWAL FEES FOR THE CONTINUANCE OF PATENT.—Every patent (other than a patent of addition) is granted for the term of 14 (s. 17) years from the date of application (s. 13), subject to the payment, before the expiration of the 4th and each succeeding year during the term of the patent, of the prescribed fee. The patentee may pay all or any of such prescribed annual fees in advance (Rule 52). The Comptroller will give a certificate of payment (Rule 53); and the Comptroller will give the patentee notice that the fee is payable one month before it is due (Rule 54). Payment must be made by way of Patents Form No. 13 duly stamped, which must be sent to the Patent Office for entry of the payment in the register. The production of letters patent at the Patent Office on payment of these fees is not required.

As the payment of these renewal fees is regulated by Act of Parliament, a fee cannot be received a *single day* after it is due; but if the payment has been omitted, application may be made to the Comptroller, on Patent Form No. 14, for an enlargement of time of one, two, or three months, as the case may be, to make such payment, but no enlargement can be allowed beyond three months.

EXTENSION OF TERM OF PATENT.—Under sect. 18 of the Act, a patentee may, after advertising in manner provided by

Rules of the Supreme Court, petition the Court for an extension of the term of his patent, but such petition must be presented at least six months before the time limited for the expiration of the patent. Notice may be given to the Court of opposition thereto.

SECRET PATENTS.—See sect. 30 and Rules 97 to 99.

LOST PATENTS.—See sect. 44 and Rule 100.

CORRECTION OF CLERICAL ERRORS.—A request for the correction of a clerical error in or in connection with an application for a patent, or in any patent or specification, or in the name or address of the proprietor of any patent, or in any matter which is entered upon the Register of Patents, should be made on Patents Form No. 30.

CERTIFICATES.—A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Act or Rules to make or do, should be made on Patents Form No. 31.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

EXHIBITION OF UNPATENTED INVENTIONS (s. 45, Rule 101).—Any person may exhibit an unpatented invention at an exhibition certified by the Board of Trade as industrial or international, during the period of the holding of the exhibition, without prejudicing in the United Kingdom his rights to apply for and obtain a patent in respect of the invention, or the validity of any patent granted on the application, provided (a) that he gives the prescribed notice on Patents Form No. 33 to the Comptroller of his intention so to exhibit it, and (b) that the application for a patent is made before or within six months from the date of the opening of the exhibition. It should be noted, however, that the protection is only given in the case of publication or use during the period of the holding of the exhibition. In the case

150 PRACTICE BEFORE COMPTROLLER OF PATENTS.

of exhibitions held out of the United Kingdom, in respect of which an Order in Council has been given, no notice of intention to exhibit is required to be given to the Comptroller.

For the purpose of enabling the invention to be subsequently identified, the inventor must furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may require.

International Office.—An International Office, in connection with the Convention, has been established at Berne, Switzerland, which publishes a monthly periodical, entitled “La Propriété Industrielle.” The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 centimes, and should be forwarded by money order to L’Imprimerie Co-opérative, Berne.

Information by Post.—Any person wishing to know whether a particular patent is still in force, the name of the present proprietor of a patent, or any similar details, may obtain an extract from the Register of Patents upon stating the number and year of the patent and forwarding the fee of one shilling by postal order. No information with reference to unpublished specifications can be given to any person other than the applicant.

Full-size Copies of Drawings.—Full-size copies of drawings printed by photolithography may be obtained at the under-mentioned rates :—

No. of Copies.	Whole sheets Imperial. (30 × 22.)	Half sheets Imperial. (15 × 22.)	Foolscap size. (13 × 16.)	Half-foolscap size. (13 × 8.)
	<i>s.</i> <i>d.</i>	<i>s.</i> <i>d.</i>	<i>s.</i> <i>d.</i>	<i>s.</i> <i>d.</i>
Single copies	25 0	15 0	15 0	10 0
Not exceeding 6 copies . .	28 0	18 0	17 0	12 0
“ 12 “	30 0	20 0	18 6	13 6
“ 25 “	32 0	22 0	20 0	15 0

If a satisfactory photograph cannot be obtained from the original drawing, an extra charge will be made to cover the expense of making a tracing.

When the original drawings are coloured there will also be an extra charge for colouring the copies.

Advice on Patent Matters, etc.—The Patent Office does not undertake to give legal advice or opinions on any subject connected with Patent Law which, like other laws, is left to the interpretation of professional men; nor does the Patent Office examine specifications or other documents before they are filed.

If an application for a patent has been *accepted*, the invention may be used and published between the date of application and the date of sealing the patent without prejudice to the patent; but an applicant is not entitled to institute proceedings for infringement until the patent has been granted, and no proceedings can be taken in respect of an infringement committed before the publication of the complete specification.

Searches other than those made in pursuance of the Act cannot be undertaken by the Patent Office, but must be made by the person requiring information, or by his agent.

The Patent Office cannot recommend any particular patent agent for employment by applicants, but a List of Registered Patent Agents may be obtained from Messrs. Eyre and Spottiswoode, Ltd., East Harding Street, London, E.C., or through any bookseller. Price (including postage), 1s. 1d. Communications between a patent agent and his client are not privileged (r).

Application for Assistance, Reduction of Fees, etc.—It is not within the power of the Comptroller to comply with any of the following requests:—

For pecuniary assistance to obtain patents.

For reduction or remission of any fee.

For purchase or acquirement of any interest in patented or other inventions.

For recommendation of any invention for purchase or use by a Government Department or by the public.

Use of the word "Patent."—The marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for

(r) *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.

the article, stamped, engraved, impressed on, or otherwise applied to the article, is not to be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent. See sect. 33 of the Act.

Any person who falsely represents that an article sold by him is a patented article is liable for every offence on summary conviction to a fine not exceeding five pounds. In a case decided by a Police Magistrate it was held, however, that a person was entitled to mark goods with the word "patent" after the complete specification had been accepted. (See sect. 89 of the Act, and 13 R. P. C. No. 17.)

Use of the Royal Arms.—The grant of a patent is not to be deemed to authorise a patentee to use the Royal Arms or to place the Royal Arms on any patented article (s. 90).

Patent Medicines.—Communications with respect to the preparation and supply of medicine stamps appropriated to a particular medicine, or as to the liability to Stamp Duty of so-called "Patent Medicines," should be addressed to the Secretary of Excise, Custom House, Lower Thames Street, E.C.

The use of medicine stamps does not have the effect of letters patent.

Applications for Patents, etc., in the British Colonies and Foreign States.—Applications for Colonial or Foreign patents, etc., must be made to the Government of the Colony or Foreign State in which protection is desired. A collection of Colonial and Foreign patent, design, and trade mark laws and rules may be seen in the Free Library of the Patent Office.

Patent Office Museum (s. 47).—The contents of the Museum were transferred in 1883 to what is now the Victoria and Albert Museum at South Kensington, where they have been added to the general Science Collections of that Museum. All communications relating to the Museum should be addressed to the Secretary, Board of Education, South Kensington, London, S.W.

Patent Office Library.—The Free Library of the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., is open daily, from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank Holidays. On the day observed as His Majesty's birthday, Christmas Eve, Easter Eve, and Whitsun Eve, the Library is closed at 4 p.m.

In addition to the Printed Specifications, Indexes, and other publications of the Patent Office, the Library contains a Collection of the leading British and Foreign Scientific Journals, Transactions of Learned Societies, and text-books of Science and Art, and the full or abridged Patent Specifications of the following countries:—Argentine Republic, Austria, Australian Commonwealth, Barbados, Belgium, Canada, Cape Colony, Denmark, Finland, France, Germany, Grenada, Hungary, Italy, Japan, Mauritius, Mexico, Natal, New South Wales, New Zealand, Norway, Portugal, Queensland, Russia, St. Lucia, St. Vincent, South Australia, Straits Settlements, Sweden, Switzerland, Trinidad, United States of America, Victoria, Western Australia.

Patent Office Publications (s. 46).—These may be consulted daily at the Free Public Library of the Patent Office; at the Science and Art Department, South Kensington; and at the Free Libraries of all the larger towns. They are also on sale at the Patent Office, 25, Southampton Buildings, W.C., and will be forwarded by post on receipt of the price and of the postage (if any is charged). *Sums amounting to 6d. or more must be remitted by Postal or Post Office Order payable to the Comptroller-General.* Postage stamps sent in payment of any amount exceeding 5d. will be returned. Deposit accounts may be opened, the minimum deposit being £2.

In ordering specifications, the price of which is 8d. each, the number and year of the patent must be given.

Unless a wrong number has been supplied through an error on the part of the Patent Office, specifications or other publications cannot be exchanged.

In searching for the invention of any particular person, the Name Indexes, published as part of the Illustrated Official Journal of Patents, should be consulted. In searching for patents in connection with a particular subject, the Abridgment Class and Index Key should first be consulted to ascertain where the subject is classified in the Patent Office publications. The corresponding Abridgment Volumes, each of which is furnished with Name and Subject Indexes, should then be examined. In the case of recent specifications for which Abridgment Volumes have not been published, the annual and monthly Indexes and the Illustrated Official Journal must be consulted. Searches other than those made in pursuance of the Act cannot be undertaken by the Patent Office.

Specifications of Foreign and Colonial Patents.—Specifications of Foreign and Colonial patents are not sold by the Patent Office. Applications for these should be made to the Patent Office of the country in which the patent was granted.

APPENDIX.

PATENTS AND DESIGNS ACT, 1907.

[7 EDW. 7, CH. 29.]

CHAPTER 29.

An Act to consolidate the enactments relating to Patents A.D. 1907.
for Inventions and the Registration of Designs and
certain enactments relating to Trade Marks.

[28th August 1907.]

BE it enacted by the King's most Excellent Majesty, by and
with the advice and consent of the Lords Spiritual and
Temporal, and Commons, in this present Parliament assembled,
and by the authority of the same, as follows :—

PART I.

PATENTS.

PART I. PATENTS.

Application for and Grant of Patent.

1.—(1) An application for a patent may be made by any Application.
person who claims to be the true and first inventor of an
invention, whether he is a British subject or not, and whether
alone or jointly with any other person.

(2) The application must be made in the prescribed form,
and must be left at, or sent by post to, the Patent Office in the
prescribed manner.

(3) The application must contain a declaration to the
effect that the applicant is in possession of an invention,
whereof he, or in the case of a joint application one at least of
the applicants, claims to be the true and first inventor, and for
which he desires to obtain a patent, and must be accompanied
by either a provisional or complete specification.

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PART I.
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Specifications.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

2.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

* (3) In the case of any provisional or complete specification where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

* (5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.

Proceedings
upon applica-
tion.

3.—(1) The Comptroller General of Patents, Designs, and Trade Marks (herein-after referred to as the comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

(3) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

* Indicates that the sub-section is new.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant. A.D. 1907.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection. PART I.
PATENTS.
Provisional protection.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application: Time for leaving complete specification.

Provided that where an application is made for an extension of the time for leaving a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

6.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner. Comparison of provisional and complete specification.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the comptroller may—

(a) refuse to accept the complete specification until it has been amended to his satisfaction; or

*(b) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

* Provided that where the complete specification includes an invention not included in the provisional specification, the comptroller may allow the original application to proceed so far as the invention included both in the provisional and in

* Indicates that the sub-section is new.

A.D. 1907.

 PART I.
 PATENTS.

the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.

(4) A refusal of the comptroller to accept a complete specification shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void :

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.

Investigation
of previous
specifications
in United
Kingdom on
applications
for patents.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public :

* Provided that the comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon.

* 8.—(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior application; and that section shall, subject to rules under this Act, have effect accordingly.

Investigation
of specifica-
tions published
subsequently
to application.

* (2) Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

* (3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

* Indicates that the sub-section is new.

A.D. 1907.

PART I.
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 PART I.
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 Advertisement
 on acceptance
 of complete
 specification.

 Effect of
 acceptance
 of complete
 specification.

 Opposition
 to grant of
 patent.

* (4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

9. On the acceptance of the complete specification the comptroller shall advertise the acceptance ; and the application and specifications with the drawings (if any) shall be open to public inspection.

10. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification : Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds :—

- (a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative ; or
- (b) that the invention has been claimed in any complete specification for a British patent which is † or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent ; or
- (c) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification ; or
- (d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the

* Indicates that the sub-section is new.

† The words "or will be" in 11 (1) (b) are new.

provisional specification and the leaving of the complete specification,

but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine.

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12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the comptroller shall cause the patent to be sealed with the seal of the Patent Office.

Grant and
sealing of
patent.

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

(a) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:

(b) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct:

(c) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death:

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* (d) Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.

Date of patent. 13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application : Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

Effect, extent, and form of patent. 14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man :

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim ; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Fraudulent applications for patents.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

(2) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked :

* Indicates that the sub-section is new.

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

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PART I.
PATENTS.Single patent
for cognate
inventions.

* 16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

* (2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.

Term of Patent.

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date. Term of patent.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

* 18.—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, Extension of
term of patent.

* Indicates that the sub-section is new.

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 PATENTS.

present a petition to the court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.

* (2) Any person may give notice to the court of objection to the extension.

* (3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

* (4) The court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

* (5) If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

Patents of
addition.

* 19.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

* (2) Where an application containing such a request is made, a patent (herein-after referred to as a patent of addition) may be granted for such term as aforesaid.

* (3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

* (4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned

* Indicates that the sub-section is new.

on the ground that the invention ought to have been the subject of an independent patent.

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 PART I.
 PATENTS.

Restoration of lapsed Patents.

* 20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the comptroller in the prescribed manner for an order for the restoration of the patent.

Restoration
of lapsed
patents.

* (2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

* (3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

* (4) Where such notice is given the comptroller shall notify the applicant thereof.

* (5) After the expiration of the prescribed period the comptroller shall hear the case and, subject to an appeal to the court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

Amendment of Specification.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

Amendment
of specifica-
tion by comp-
troller.

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any

* Indicates that the sub-section is new.

A.D. 1907.

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 PATENTS.

time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such a notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification.

(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

Amendment of
specification
by the court.

* 22. In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs advertisement or otherwise, as the court may think fit :

* Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the

* Indicates that the sub-section is new.

invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

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23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

 Restriction
 on recovery
 of damages.

Compulsory Licences and Revocation.

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

 Compulsory
 licences and
 revocation.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as

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exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met ; or

(b) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

Revocation
of patent.

25.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(a) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias ; or

* (b) a patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence ;

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

* Indicates that the sub-section is new.

(3) A petition for revocation of a patent may be presented—

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(a) by the Attorney-General or any person authorised by him ; or

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(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

* 26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed :

Power of
comptroller
to revoke
patents on
certain
grounds.

* Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

* (2) The comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application ; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

* (3) A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the

* Indicates that the sub-section is new.

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PART I.
PATENTS.Revocation
of patents
worked out-
side the
United
Kingdom.

offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

* (4) Any decision of the comptroller under this section shall be subject to appeal to the court.

* 27.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

* (2) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

* (a) forthwith ; or

* (b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent :

* Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

* (3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

* (4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

* Indicates that the sub-section is new.

Register of Patents.

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28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Crown.

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Patent to
bind Crown.

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention ; and the Secretary of State or the Admiralty may be a party to the assignment.

Assignment
to Secretary
for War or
the Admiralty
of certain
inventions.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements

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therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration) and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid.

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(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorized by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

* (13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Legal Proceedings.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it think fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs.

Hearing with
 assessor.

(2) The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

* Indicates that the sub-section is new.

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PART I.
PATENTS.Power to
counterclaim
in an action
for infringe-
ment.Exemption
of innocent
infringer
from liability
for damages.Order for
inspection, &c.,
in action.Certificate of
validity ques-
tioned and
costs thereon.Remedy in
case of ground-
less threats
of legal pro-
ceedings.

* 32. A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

* 33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent :

Provided that nothing in this section shall affect any proceedings for an injunction.

34. In an action for infringement of a patent, the court may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the court may see fit.

35. In an action for infringement of a patent, the court may certify that the validity of the patent came in question ; and, if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

36. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats

* Indicates that the sub-section is new.

related was not in fact an infringement of any legal rights of the person making such threats : A.D. 1907.

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

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PATENTS.

Miscellaneous.

* 37. Where after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate. Grant of patents to two or more persons.

* 38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be— Avoidance of certain conditions attached to the sale, &c., of patented articles.

* (a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees ; or

* (b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent ;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy :

Provided that this subsection shall not apply if—

* (i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on

* Indicates that the sub-section is new.

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PATENTS.

reasonable terms, without such conditions as aforesaid ; and

- * (ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

* (2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party ; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

* (3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

* (4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of

* Indicates, that the sub-section is new.

this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

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 PATENTS.

* (5) Nothing in this section shall—

- (a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person ; or
- (b) be construed as validating any contract which would, apart from this section, be invalid ; or
- (c) affect any right of determining a contract or condition in a contract exerciseable independently of this section ; or
- (d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

* 39.—(1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

Costs and
security for
costs.

* (2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act ; and in any proceeding before the law officer under this Part of this

Procedure on
appeal to
law officer.

* Indicates that the sub-section is new.

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 PART I.
 PATENTS.

Provisions as
to anticipation.

Act, the law officer may order costs to be paid by either party, and any such order made be made a rule of the court.

41.—(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

* (2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

Disconformity.

* **42.** A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

Patent on
application of
representative
of deceased
inventor.

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

Loss or de-
struction of
patent.

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time seal a duplicate thereof.

Provisions as
to exhibitions.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use

* Indicates that the sub-section is new.

of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(a) the exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

46.—(1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

Publication
of illustrated
journal,
indexes, &c.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

(3) The comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

Patent
Museum.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

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 PART I.
 PATENTS.

 Foreign
 vessels in
 British
 waters.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

PART II.

DESIGNS.

[This part of the Act, sects. 49 to 61, is omitted as irrelevant to the contents of this volume.]

 PART III.
 GENERAL.

PART III.

GENERAL.

Patent Office and Proceedings thereat.
 Patent Office.
 5 Edw. 7.
 c. 15.

62.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

* (4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

* Indicates that the sub-section is new.

63.—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

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PART III.
GENERAL.Officers and
clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Seal of
Patent Office.*Fees.*

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Fees.

Provisions as to Registers and other Documents in Patent Office.

66. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

Trust not to
be entered in
registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection of
and extracts
from registers.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production

Privilege of
reports of
examiners.

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PART III.
GENERAL.Prohibition of
publication of
specification,
drawings, &c.,
where appli-
cation aban-
doned, &c.

or inspection is desirable in the interests of justice, and ought to be allowed.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

* (2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

70. The comptroller may, on request in writing accompanied by the prescribed fee,—

* (a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification ;

* (b) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered ;

* (c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

* (2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other

* Indicates that the sub-section is new.

Power for
comptroller
to correct
clerical errors.Entry of
assignments
and trans-
missions in
registers.

person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

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 GENERAL.

72.—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

 Rectification
 of registers
 by court.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

73. Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

 Exercise of
 discretionary
 power by
 comptroller.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

 Power of
 comptroller to
 take directions
 of law officers.

75. The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

 Refusal to
 grant patent,
 &c., in certain
 cases.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or

 Annual
 reports of
 comptroller.

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GENERAL.

under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

*Evidence, &c.*Evidence
before comp-
troller.

* 77.—(1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *vivâ voce* in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

* (2) In case any part of the evidence is taken *vivâ voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

Certificate of
comptroller to
be evidence.

78. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Evidence of
documents
in Patent
Office.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Transmission
of certified
printed copies
of specifica-
tions, &c.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in

* Indicates that the sub-section is new.

Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

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(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post. Applications and notices by post.

82. Where the last day fixed by this Act for doing any- Excluded days.
 thing under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability. Declaration by infant, lunatic, &c.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act. Register of patent agents.

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GENERAL.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Agents for
patents.

* 85.—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c. of Board of Trade.

Power for
Board of
Trade to
make general
rules.

86.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) For regulating the practice of registration under this Act :

* Indicates that the sub-section is new.

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GENERAL.

- (b) For classifying goods for the purposes of designs :
- (c) For making or requiring duplicates of specifications, drawings, and other documents :
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents :
- (f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (g) For regulating the keeping of the register of patent agents under this Act :
- (h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

Proceedings
of the Board
of Trade.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or

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GENERAL.

to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as
to Order in
Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

* (4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

* Indicates that the sub-section is new.

* (5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

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GENERAL.

* 90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

Unauthorised
assumption
of Royal Arms.

(2) If any person, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds :

* Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the foreign state.

International
and Colonial
arrangements.

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state ; and

(b) Nothing in this section shall entitle the patentee

* Indicates that the sub-section is new.

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 GENERAL.

or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention ; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905 : Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period ; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful

for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

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 GENERAL.

Definitions.

92.—(1) In this Act, unless the context otherwise requires, “the court” means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England. Provisions as to “the court.”

* (2) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

93. In this Act, unless the context otherwise requires,— Definitions.

“Law officer” means the Attorney-General or Solicitor-General for England :

“Prescribed” means prescribed by general rules under this Act :

“British possession” does not include the Isle of Man or the Channel Islands :

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entitled to the benefit of a patent :

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention :

“Inventor” and “applicant” shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :

“Design” means any design (not being a design for a

* Indicates that the sub-section is new.

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PART III.
GENERAL.54 Geo. 3.
c. 56.

sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :

“Article” means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural :

“Copyright” means the exclusive right to apply a design to any article in any class in which the design is registered :

“Proprietor of a new and original design,”

(a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed ; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and

(c) In any other case, means the author of the design ;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Application to Scotland, Ireland, and the Isle of Man.

94. In the application of this Act to Scotland—

- (1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of

Application
to Scotland.

process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed :

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 GENERAL.

- (2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court :
- (3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act :
- (4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs ; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court :
- (5) Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary :
- (6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt :
- (7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for

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PART III.
GENERAL.Application
to Ireland.

the rectification, shall be served on the comptroller, and he shall rectify the register accordingly :

(8) The expression "injunction" means "interdict."

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only :

(2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term "the Court" means the High Court in Ireland :

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications :—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts :

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court :

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

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GENERAL.

97. Nothing in this Act shall take away, abridge, or pre-judicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Saving for
prerogative.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

Repeal and
savings.

(a) As respects the enactments mentioned in Part I. of that schedule, as from the commencement of this Act :

(b) As respects the enactments mentioned in Part II. of that schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation ;

(c) As respects the enactments mentioned in Part III. of that schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

and the enactments mentioned in Part II. and Part III. of that schedule shall, until so repealed, have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

Short title
and com-
mencement.

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Section 65.

SCHEDULES.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND
RENEWAL.*(a) Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification . . .	3	0	0			
				4	0	0
<i>or</i>						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation				1	0	0

(b) Further before end of four years from date of patent.

On certificate of renewal	50	0	0
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(c) Further before end of eight years from date of patent.

On certificate of renewal	100	0	0
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Or in lieu of the fees of £50 and £100 the following annual fees :

Before the expiration of the fourth year from the date		of the patent	10	0	0
„	„	fifth	10	0	0
„	„	sixth	10	0	0
„	„	seventh	10	0	0
„	„	eighth	15	0	0
„	„	ninth	15	0	0
„	„	tenth	20	0	0
„	„	eleventh	20	0	0
„	„	twelfth	20	0	0
„	„	thirteenth	20	0	0

SECOND SCHEDULE.

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ENACTMENTS REPEALED.

Section 98.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 . .	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901 . .	The whole Act.
2 Edw. 7. c. 34.	The Patents Act, 1902 . .	The whole Act.
7 Edw. 7. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (2) and (3) of section forty-seven and section forty-eight.

STATUTORY RULES AND ORDERS, 1907.

No. 950.

PATENTS.

THE PATENTS RULES, 1908, DATED DECEMBER 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as the "Act," the Board of Trade, hereinafter referred to as the "Board," do hereby make the following Rules :—

SHORT TITLE.

Short title.

1. These Rules may be cited as the Patents Rules, 1908.

COMMENCEMENT.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st December, 1907, with the exception of such of them as relate to procedure under Section 8 of the Act, which shall come into operation at such date as the Board may by Order direct.

INTERPRETATION.

Interpretation.

3. In the construction of these Rules—
 "United Kingdom" includes the Isle of Man ;
 "Foreign Application" means an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order in Council for the time being in force the provisions of Section 91 of the Act are applicable ;

“Convention Application” means an application in the United Kingdom under Section 91 of the Act ;

“Office” means the Patent Office ;

“Journal” means the Illustrated Official Journal (Patents).

FEEES.

4. The fees to be paid under the Act, so far as it relates to First Patents, shall be those specified in the list of fees in the First Schedule to these Rules.

FORMS.

5. The forms herein referred to are those contained in the Second Second and Third Schedules to these Rules and such forms Schedule. shall be used in all cases to which they are applicable, and shall be modified as directed by the Comptroller to meet other cases.

DOCUMENTS.

6. All documents and copies of documents, except drawings, Size, &c., of sent to or left at the Office or otherwise furnished to the documents. Comptroller or to the Board shall be written, type-written, lithographed, or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

At the top of the first page of a specification a space of about two inches should be left blank.

7. Any application, notice, or other document authorised Leaving and or required to be left, made, or given at the Office, or to the serving Comptroller, or to any other person under the Act or these documents. Rules, may be sent by a prepaid or official paid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In

proving such sending or service, it shall be sufficient to prove that the letter was properly addressed and put into the post.

A letter addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant for or opponent to the grant, revocation, or restoration of a patent at the address appearing on the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Address for
service.

8. Every applicant for and opponent to the grant of a patent or the revocation of a patent or the restoration of a lapsed patent or the amendment of a specification, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent or patentee.

If any patentee desires to have two addresses for service entered in the register a request therefor shall be made on Patents Form No. 26.

The Comptroller may require any existing patentee, who does not reside in the United Kingdom, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

AGENCY.

Agency.

9. With the exception of the signing of the following documents, namely, applications for patents, or for the revocation of patents or the restoration of lapsed patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all communications to the Comptroller under the Act and these Rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Act relating to patents from, any

person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents kept under the provisions of the Act, and not since restored, or any person who is proved to the satisfaction of the Board, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, or any company, which if it had been an individual, the Comptroller could refuse to recognise as agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

APPLICATIONS FOR THE GRANT OF PATENTS.

10. An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patent Forms, Nos. 1, 1A or 1B, as the case may be. An application for a Patent of Addition shall be made on Patents Form No. 1C, and an application for a Secret Patent on Patents Form No. 1D.

11. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of his will, or the letters of administration granted of his estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title as such legal representative and be supported by such further evidence as the Comptroller may require.

12. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

13.—(1) When a specification comprises several distinct

Form of application.

Application by representative of deceased inventor.

Order of recording applications.

One invention.

matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

Applications
for separate
patents by
way of
amendment.

Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Act and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings or any of them to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connexion with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

Claims.

14. The statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification.

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

15. Every Convention application shall contain a declaration Convention applications. that foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the Foreign States or British Possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

16. In addition to the specification left with every Convention application a copy or copies of the specification or specifications and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such Foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller, must be left at the Office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. Foreign specification, &c., to accompany application. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, drawings or documents shall be made on Patents Form No. 5.

17. If the complete specification left with the application Public inspection. be not accepted within twelve months from the date of the first foreign application, it shall be open to public inspection at the expiration of that period.

18. Save as aforesaid and as provided by Rule 83 all Proceedings. proceedings in connexion with a Convention application shall be taken within the times and in the manner prescribed by the Act or these Rules for ordinary applications.

DRAWINGS.*

General.

19. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 26. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself.

Require-
ments as to
paper, etc.

20. Drawings may be made by hand or lithographed, printed, &c. They must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings must not be used.

Size of
drawings and
arrangement
of figures.

21. Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to $8\frac{1}{4}$ inches or from 16 inches to $16\frac{1}{2}$ inches wide, the narrower sheets being preferable.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets, and should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct.

Drawings to
be suitable
for repro-
duction.

22. Drawings must be prepared in accordance with the following requirements:—

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.

* NOTE.—Copies of Instructions as to the Preparation of Drawings may be had on application to the Patent Office.

- (d) Shading lines must not contrast too much in thickness with the general lines of the drawing.
- (e) Sections and shading should not be represented by solid black or washes.
- (f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, &c., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words.

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after one or more provisional specifications, the numbers and years of the applications) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings.

Drawings to bear name of applicant, &c., but no descriptive matter.

24. A facsimile or "true copy" of the original drawings should be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that it may be on tracing cloth and the reference letters and figures should be in black-lead pencil.

Copies of drawings.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Marking of originals and true copies.

25. Drawings must be delivered at the Office so as to be free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Delivery of drawings.

26. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he should refer to them in the complete specification as those left with the provisional specification.

Provisional drawings used for complete specifications.

EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.

Extension of
time for
leaving
complete
specification.

27. An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

PROCEDURE UNDER SECTION 7 OF THE ACT.

Power of
Comptroller
to post-date.

28. If after the leaving of any complete specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by sub-section 1, and the Comptroller requires amendment of the specification and drawings, or any of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Provisional
report in
case of
complete
anticipation.

29. When the Examiner in prosecution of the investigation prescribed by sub-section 1, finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications within the meaning of the sub-section, he shall, without any further prosecution of the investigation, make a provisional report to that effect to the Comptroller.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-section 4. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in sub-section 3 or sub-section 4, as the case may require.

Time for
leaving
amended
specification.

30. The time within which an applicant may leave his amended specification under sub-section 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of sub-section 1.

31. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-section 1, and the time allowed for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what prior specification or specifications by way of notice to the public, and in the event of the invention claimed being wholly and specifically claimed in any specification to which the investigation has extended whether he should refuse to grant a patent.

32. When under sub-section 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows and shall be inserted after the claims :—

Reference has been directed in pursuance of section 7 sub-section 4, of the Patents and Designs Act, 1907, to specification No. of 1 .

Where the reference is inserted as the result of a provisional report under Rule 29, a statement to that effect shall be added to the reference.

PROCEDURE UNDER SECTION 8 OF THE ACT.

33. Where on the extended investigation provided for by section 8 of the Act it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply

Hearing by
the Comptroller under
sub-section 4.

Reference
to prior
specification.

Procedure
under
section 8.

for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

Hearing by
Comptroller.

If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and if so, what prior specification or specifications by way of notice to the public.

Reference to
prior specifi-
cation.

34. When, under sub-section 2, the Comptroller determines that reference to a prior specification ought to be made, by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—

“Reference has been directed, in pursuance of section 8, sub-section 2, of the Patents and Designs Act, 1907, to Specification No. of 1 .”

Advertise-
ment of
amendments.

35. When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the Journal.

CHEMICAL INVENTIONS.—TYPICAL SAMPLES AND SPECIMENS.

Chemical
inventions—
Typical
samples and
specimens.

36. Where under section 2, sub-section (5), of the Act before the acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or

specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the complete specification and in connexion with the advertisement of acceptance of same in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding 3 inches, and of an external diameter of $1\frac{1}{2}$ inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

ACCEPTANCE OF SPECIFICATIONS.

37. An application for extension of time for accepting a complete specification shall be made on Patents Form No. 7.

38. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the Journal.

Extension of time for accepting complete specification. Notice and advertisement of acceptance.

Inspection of
specification.

39. Upon such acceptance in the case of a complete specification the application and specification or specifications with the drawings (if any) may be inspected at the Office upon payment of the prescribed fee.

OPPOSITION TO GRANTS OF PATENTS.

Notice of
opposition.

40. A notice of opposition to the grant of a patent shall be given on Patents Form No. 8, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy, which shall be transmitted by the Comptroller to the applicant.

Copy for
applicant.

Statement of
amendments
desired.

Where the person giving notice of an opposition does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating so far as can conveniently be done the general nature of the amendments desired and the portions of the earlier specifications, if any, relied upon as necessitating such amendments.

Evidence in
support of
allegation
that inven-
tion has been
obtained from
opponent.

41.—(1) Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification or such further time as the Comptroller may in any special case allow, the opposition shall be deemed to be abandoned.

(2) Where the ground of the opposition is that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification, the notice of opposition should be accompanied by a written statement indicating so far as can conveniently be done in what respects the invention is alleged to be insufficiently or unfairly described or ascertained.

Opponent's
evidence.

42. Except in the case provided for in Rule 41 (1), statutory declarations need not be left in connexion with an opposition,

but the opponent may within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

43. Within fourteen days from the delivery of such copies, the applicant may leave at the Office statutory declarations in answer, and on so leaving shall deliver to the opponent copies thereof, and within fourteen days from such delivery the opponent may leave at the Office his statutory declarations in reply, and on so leaving shall deliver to the applicant copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Applicant's
evidence.

Evidence in
reply.

44. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Applicant's
evidence if
opponent
does not leave
statutory
declarations.

45. Within fourteen days from the delivery of such copies, the opponent may leave at the Office statutory declarations in answer, and on so leaving shall deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Office his statutory declarations in reply, and on so leaving shall deliver to the opponent copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Opponent's
evidence.

Evidence in
reply.

46. No further evidence shall be left on either side except by leave, or on the requisition, of the Comptroller.

Closing of
evidence.

47. On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard he shall as soon as possible notify the Comptroller to that effect. If either party desires to be heard he must leave Patents Form No. 9 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 9 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory

Hearing.

declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Comptroller shall decide the case and notify his decision to the parties.

SEALING OF PATENT AND PAYMENT OF FEE.

Sealing of
patent and
payment of
fee.

48. If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by section 12 of the Act pay the sealing fee by leaving at the Office Patents Form No. 10, duly stamped.

Where in consequence of the neglect or failure of the applicant to pay such fee, a patent cannot be sealed within the period allowed by section 12, the applicant may apply to the Comptroller on Patents Form No. 11 or Patents Form No. 12, as the case may be, for an extension of such period not exceeding three months where the period allowed for the sealing of the patent expires after the commencement of the Act, and not exceeding three months after the commencement of the Act where the period allowed for the sealing of the patent expired before the commencement of the Act.

The Comptroller shall consider such application, and if the circumstances of the case appear to him to warrant the granting of the extension, he may seal the patent within such extended period.

Where the period allowed for the sealing of the patent has expired before the commencement of the Act, no proceedings shall be taken in respect of an infringement committed after the failure to pay the fee and before the sealing of the patent.

FORM OF PATENT.

Form of
patent.

49. A patent, except in the cases provided for in Rules 50 and 51, may be in the Form A, in the Third Schedule to these Rules.

Form of
patent of
addition.

50. A patent of addition may be in the Form B, in the Third Schedule to these Rules.

51. Where after the commencement of the Act a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to shew clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

Form of patent to legal representatives of deceased inventor and others.

RENEWAL FEES.

52. If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by means of Patents Form No. 13. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 14.

Renewal fees.

53. On due compliance with the terms of Rule 52, the Comptroller shall issue a Certificate that the prescribed payment has been duly made.

Certificate of payment of fee.

54. At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

Notice as to renewal fees.

RESTORATION OF LAPSED PATENTS.

55. Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time the patentee may apply to the Comptroller on Patents Form No. 15 for an order for the restoration of the patent. Every such application shall be accompanied by one

Restoration of lapsed patents.

or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable. At any time within two months from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 16, and a copy of such notice shall be transmitted by the Comptroller to the applicant.

Opponent's
evidence.

56. Where such notice is given the opponent shall within 14 days after leaving the notice leave at the Office one or more statutory declarations verifying any evidence on which he relies in support of the grounds of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Further
procedure.

57. Upon such declarations being left and delivered the provisions of Rules 43, 46, and 47 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Order.

58. In every Order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage :—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was *bonâ fide* manufactured or made, or such mechanism, machine, machinery, process, or operation was *bonâ fide* made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time

thereafter by any person or corporation entitled for the time being under the preceding sub-section to use or employ any machine, machinery, mechanism, process, or operation or any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

59. The Order shall further provide that if any person Compensation. within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the *bonâ fide* belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

AMENDMENT OF SPECIFICATION.

60. A request to the Comptroller for leave to amend a Request for
leave to
amend. specification, except when such request is made under Rule 33, shall be made on Patents Form No. 17. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

Notice of
opposition.

Copy for the
applicant.

Opponent's
evidence.

Further
proceedings.

Applicant's
evidence if
opponent
does not leave
statutory
declarations.

Further
proceedings.

Require-
ments on
amendment.

Advertise-
ment of
amendment.

Petition for
grant of
compulsory
license or
revocation
of Patent.

61. A notice of opposition to the amendment shall be on Patents Form No. 18, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.

62. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

63. Upon such declarations being left, and such copies being delivered, the provisions of Rules 43, 46, and 47 shall apply to the case, and the further proceedings shall be regulated in accordance with such provisions as if they were herein repeated.

64. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within two months from the date of the first advertisement of the application for leave to amend leave at the Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

65. Upon such declarations being left, and such copies being delivered, the provisions of Rules 45, 46, and 47 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were herein repeated.

66. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Office a new specification and drawings as amended, to be prepared in accordance with Rules 6 and 19 to 25.

67. Every amendment of a specification shall be advertised forthwith by the Comptroller in the Journal, and in such other manner (if any) as the Comptroller may direct

COMPULSORY LICENSES AND REVOCATION OF PATENTS.

68. A petition to the Board for an order under sect. 24 of the Act shall be made on Patents Form No. 20 and shall show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms

upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

69. The petition and an examined copy thereof shall be left at the Office with a request on Patents Form No. 19 and shall be accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition together with any other documentary evidence in support, and the petitioner shall simultaneously with, or as soon as may be after the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support. To be left with evidence at Office.

70. The persons to whom such copies are delivered by the petitioner may give notice of opposition on Patents Form No. 21, and may, within fourteen days after being invited to do so by the Board, leave at the Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from such last-mentioned delivery leave at the Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply. Opponent's evidence.
Evidence in reply.

The times prescribed by this Rule may be altered or enlarged by the Board, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

71. No further evidence than as aforesaid may be left by either side at the Office except by leave or on requisition of the Board and upon such terms, if any, as the Board may think fit. Closing of evidence.

72. The Board shall consider the petition and the evidence, with a view to satisfying themselves whether a *primâ facie* case has been made out for proceeding further with the petition, and if they are not so satisfied they shall dismiss the petition. Power of Board of Trade to dismiss petition.

73. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to Arrangements between parties.

between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Court.

Reference of
petition to
the Court.

74. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties and are satisfied that a *prima facie* case has been made out by the petitioner, they shall refer the petition to the Court, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question and any other information in the possession of the Board which it appears to them may be of service to the Court in ascertaining what persons should be made parties to the proceedings before the Court, and the Board shall give written notice to the parties that the petition has been referred to the Court.

PROCEDURE UNDER SECTION 26 OF THE ACT.

Application
under
section 26 of
the Act.

75. An application for the revocation of a patent under section 26 of the Act shall be made on Patents Form No. 22, and shall be accompanied by an unstamped copy of the form, which shall be transmitted by the Comptroller to the patentee. Where the ground of application is that the applicant for the patent obtained the invention from the person applying for the revocation of the patent, evidence by way of statutory declaration in support of such allegation shall be left at the Office at the same time as the application for the revocation, or as soon as may be thereafter. In other cases such evidence may be so left by the applicant for revocation if he desires. Copies of any declarations left at the Office under this Rule shall be delivered by the applicant to the patentee.

Procedure.

76. Upon such declarations being left and delivered the provisions of Rules 43 to 47 shall apply *mutatis mutandis* to the furnishing of further evidence and to the hearing of the case before the Comptroller.

Surrender of
patent.

77. A notice of an offer by a patentee to surrender his patent under section 26 of the Act shall be given on Patents

Form No. 23, and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable.

REVOCATION OF PATENTS WORKED OUTSIDE THE UNITED KINGDOM.

78. An application for the revocation of a patent under Section 27 of the Act shall be made on Patents Form No. 24. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver, or cause to be delivered, to the patentee or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery. Revocation
of patents
worked outside
the United
Kingdom.

79. The patentee shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the patented article or process is manufactured or carried on in the United Kingdom; and setting out in the event of the article or process not being manufactured or carried on in the United Kingdom to an adequate extent, the reasons why it is not so manufactured or carried on. The patentee shall deliver, or cause to be delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery. Procedure.

Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the patentee or his agent copies thereof, and furnish the Comptroller with evidence of such delivery.

80. No further evidence shall be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit. Closing of
evidence.

81. On completion of the evidence or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and give the parties 10 days' notice at least of such appointment, and in the event of his deciding to Hearing.

take evidence *vivâ voce* in lieu of or in addition to the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person, whose evidence he may consider desirable.

REGISTER OF PATENTS.

Entry of
grant.

82. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and calling of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

Entry in
respect of
Convention
application.

83. The patent granted on any Convention application shall be entered in the register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application. The date of the application in this country shall also be entered in the register.

Alteration
of address.

84. If a patentee send to the Comptroller on Patents Form No. 25 notice of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Request for
entry of sub-
sequent pro-
prietorship.

85. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee, licensee or otherwise, a request for the entry in the register of his name as proprietor of the patent, or of a notice of such interest, as the case may be, shall be addressed to the Comptroller, and left at the Office.

Form and
signature of
request.

86. Such request shall be on Patents Form No. 27 or Patents Form No. 28, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent, and in the case of a body corporate by its agent.

Particulars
to be stated
in request.

87. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any interest therein, as the case may be, and the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims to have entered in the register his

name as proprietor or a notice of such interest, so as to show the manner in which, and the person or persons to whom, the patent, or such interest therein as aforesaid, has been assigned or transmitted.

88. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and he may call for such other proof of title as he may require for his satisfaction.

Production of documents of title and other proof.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

89. There shall also be left with the request an attested copy of the assignment or other document or copy above required to be produced.

Copies for Office.

90. The notice of interest in the patent of any person other than the proprietor entered in the register in pursuance of the request shall be such as may appear applicable to the circumstances of the particular case.

Entry of notice of interest.

91. Where it is desired to enter in the register a notification of any document purporting to affect the proprietorship of a patent an attested copy of such document shall be left at the Office with a request on Patents Form No. 29 that a notification thereof may be entered in the register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Entry of notification of document.

92. Upon the issue of a certificate of payment under Rule 53, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

Entry of date of payment of fees on issue of certificate.

93. If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, there shall be duly entered in the register a notification of such failure.

Entry of failure to pay fees.

94. The register of patents shall be open to the inspection of the public on every day on which the Office is open to the

Hours of inspection of register.

public during the time it is so open except at such times when the register is required for any purpose of official use.

CORRECTION OF CLERICAL ERRORS.

Correction of
clerical
errors.

95. A request for the correction of a clerical error in or in connexion with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 30.

CERTIFICATES.

Certificates
and certified
copies of
documents.

96. A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Act or any of these Rules to make or do, shall be made on Patents Form No. 31.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

SECRET PATENTS.

Secret patents.

97. When it has been decided by the Secretary of State for War or the Admiralty that it is advisable to take out a secret patent for any invention assigned under section 30 of the Act, and an application for such patent has been made on Patents Form No. 1D, accompanied by a certificate of the Secretary of State or the Admiralty, under section 30 (3) of the Act, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Act to be made in the case of other applications for patents.

Unless and until such invention is re-assigned to the inventor by the Secretary of State or the Admiralty—

- (1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.

- (2) The application for the patent, and the acceptance of any specification relating to the invention shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under section 11 of the Act; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.
- (3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Act for ordinary patents. Nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.
- (4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of 14 years from its date.

98. When an application has been made otherwise than as provided by the last preceding rule for a patent for an invention, and such application is still pending, and a certificate under section 30 (3) of the Act is furnished to the Comptroller by the Secretary of State or the Admiralty, the provisions of such rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Certificate of
secrecy after
application.

99. In the event of any secret patent being re-assigned to the inventor by the Secretary of State or the Admiralty, it shall be removed from the Confidential Register of secret patents; all fees that would have been thereafter payable if the same had not been a secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payment of fees and otherwise as if it had not been a secret patent.

Re-assignment.

LOST PATENT.

100. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 32, and in accordance with the directions thereon.

Lost patent.

INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

Industrial or
international
exhibitions.

101. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 33 of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

EXERCISE OF DISCRETIONARY POWERS BY THE COMPTROLLER.

Exercise of
discretionary
powers by
Comptroller.
Notice of
hearing.

102. Before exercising any discretionary power given to the Comptroller by the Act or these Rules adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

Notice by
applicant.

103. Within five days from the date on which such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

Comptroller
may require
statement, &c.

104. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Decision to
be notified
to parties.

105. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.

STATUTORY DECLARATIONS AND AFFIDAVITS.

106. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Form, &c.,
of statutory
declaration
and affidavit.

107. The statutory declarations and affidavits required by the Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows :—

Manner in
which and
persons before
whom, de-
claration or
affidavit is to
be taken.

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding ;

(b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding ; and

(c) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a judge or magistrate.

GENERAL.

108. Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

Power of
amendment,
&c.

109. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times for

General
power to
enlarge time.

lodging evidence referred to in Rules 68 to 74, or the times prescribed by Rules 16, 41 and 55, may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Days and
hours of
business.

110. The Office shall be open to the public every weekday except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following :—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

Excluded
days.

111. Whenever the last day fixed by the Act, or by these Rules, for doing anything shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Act and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Power to dis-
pense with
evidence,
signature, &c.

112. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

APPLICATIONS TO AND ORDERS OF COURT.

Applications
to Court.

113. Four clear days' notice of every application to the Court under Section 72 of the Act for rectification of the register of patents shall be given to the Comptroller.

Where any Order has been made by the Court under the Orders of Act revoking a patent or extending the term of a patent, or Court. allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent, the person in whose favour such order has been made shall forthwith leave at the Office an office copy of such order together with Patents Form No. 34. The specification shall thereupon be amended or the register rectified or the purport of such Order shall otherwise be duly entered in the register as the case may be.

REPEAL.

114. All general rules relative to Patents heretofore made Repeal. by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, and in force on the 31st day of December, 1907, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application or other matter then pending.

Dated the 17th day of December, 1907.

D. Lloyd George,
President of the Board of Trade.

THE FIRST SCHEDULE.

LIST OF FEES PAYABLE IN RESPECT OF THE GRANT OF
PATENTS AND OF OTHER MATTERS WITH RELATION THERETO.

	—	Corresponding Form.
	£ s. d.	
1. On application accompanied by provisional specification	1 0 0	Patents Form No. 1, 1A, 1B, or 1c.
2. On filing complete specification thereafter	3 0 0	Patents Form No. 3.
or		
3. On application accompanied by complete specification	4 0 0	" "
4. On appeal from Comptroller to Law Officer. By appellant	3 0 0	Patents Form No. 4.
5. For extension of time under Rule 16:— Not exceeding one month	2 0 0	Patents Form No. 5.
" two months	4 0 0	" "
" three months	6 0 0	" "
6. For extension of time for leaving com- plete specification not exceeding one month.	2 0 0	Patents Form No. 6.
7. For extension of time for acceptance of complete specification:— Not exceeding one month	2 0 0	Patents Form No. 7.
" two months	4 0 0	" "
" three months	6 0 0	" "
8. On notice of opposition to grant of patent. By opponent.	0 10 0	Patents Form No. 8.
9. On hearing by Comptroller. By appli- cant and by opponent respectively	1 0 0	Patents Form No. 9.
10. On sealing of patent	1 0 0	Patents Form No. 10.
11. For extension of time for sealing of patent where period allowed for the sealing of the patent will expire after the commencement of the Act:— Not exceeding one month	2 0 0	Patents Form No. 11.
" two months	4 0 0	" "
" three months	6 0 0	" "
12. For extension of time for sealing a patent, where period allowed for the sealing of the patent has expired before the commencement of the Act	10 0 0	Patents Form No. 12.

	—	Corresponding Form.
On certificate of renewal :—	£ s. d.	
13. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year	5 0 0	Patents Form No. 13.
14. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year	6 0 0	" "
15. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year	7 0 0	" "
16. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year	8 0 0	" "
17. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year	9 0 0	" "
18. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year	10 0 0	" "
19. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year	11 0 0	" "
20. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year	12 0 0	" "
21. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year	13 0 0	" "
22. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year	14 0 0	" "
23. On enlargement of time for payment of renewal fees :—		
Not exceeding one month	1 0 0	Patents Form No. 14.
" two months	3 0 0	" "
" three months	5 0 0	" "
24. On application for restoration of a lapsed patent	20 0 0	Patents Form No. 15.
25. On notice of opposition to application for restoration of lapsed patent	1 0 0	Patents Form No. 16.
26. On hearing by Comptroller. By appli- cant and by opponent respectively	1 0 0	Patents Form No. 9.
27. On application to amend specification :—		
Up to sealing. By applicant	1 10 0	Patents Form No. 17.
After sealing. By patentee	3 0 0	" "
28. On notice of opposition to amendment. By opponent	0 10 0	Patents Form No. 18.

		Corresponding Form.
29. On hearing by Comptroller. By applicant and by opponent respectively .	£ s. d. 1 0 0	Patents Form No. 9.
30. On application to the Board of Trade for a compulsory license. By person applying	1 0 0	Patents Form No. 19.
31. On opposition to grant of compulsory license. By opponent	1 0 0	Patents Form No. 21.
32. On application to Comptroller to revoke a patent under Section 26	2 0 0	Patents Form No. 22.
33. On hearing by Comptroller. By applicant and by patentee respectively .	2 0 0	Patents Form No. 9.
34. On offer to surrender a patent under Section 26	1 0 0	Patents Form No. 23.
35. On hearing by Comptroller. By applicant and by opponent respectively .	1 0 0	Patents Form No. 9.
36. On application under Section 27 to Comptroller to revoke a patent worked outside the United Kingdom	2 0 0	Patents Form No. 24.
37. On hearing by Comptroller. By applicant and by patentee respectively .	2 0 0	Patents Form No. 9.
38. For altering name or address or address for service in register	0 5 0	Patents Form No. 25.
39. For entry of two addresses for service in register	0 5 0	Patents Form No. 26.
40. On request to enter name of subsequent proprietor in the register of patents	0 10 0	Patents Form No. 27.
41. On request to enter notice of interest in the register of patents	0 10 0	Patents Form No. 28.
42. On request to enter notification of a document in the register of patents .	0 10 0	Patents Form No. 29.
43. On request to Comptroller to correct a clerical error:— Up to sealing	0 5 0	Patents Form No. 30.
After sealing	1 0 0	" "
44. For certificate of Comptroller under Section 78	0 5 0	Patents Form No. 31.
45. For duplicate of letters patent . . .	2 0 0	Patents Form No. 32.

	—	Corresponding form.
46. On notice to Comptroller of intended exhibition of an invention under Section 45	£ s. d. 0 10 0	Patents Form No. 33.
47. On notice of Order of Court for amend- ment of specification or rectification of register	0 10 0	Patents Form No. 34.
48. On postal request for printed specifica- tion	0 0 8	Patents Form No. 35.
49. Search or inspection fee	0 1 0	
50. For office copies . . . every 100 words (but never less than one shilling)	0 0 4	
51. For office copies of drawings, cost according to agreement.		
52. For certifying office copies, MSS. or printed each	0 1 0	

D. Lloyd George,
President of the Board of Trade.

Dated the 17th day of December, 1907.

Approved ;

Joseph A. Pease,
J. H. Whitley,
Lords Commissioners of
His Majesty's Treasury.

THE SECOND SCHEDULE.

Forms.	Page.	Corresponding Fee.
Patents Form No. 1.—Application for Patent . . .	234	£1
„ No. 1A.—Application for Patent communicated from abroad . . .	236	£1
„ No. 1B.—Application for Patent under International and Colonial arrangements . . .	238	£1
„ No. 1c.—Application for Patent of Addition . . .	240	£1
„ No. 1D.—Application for Secret Patent . . .	242	—
„ No. 2.—Provisional Specification . . .	244	—
„ No. 3.—Complete . . .	245	£3
„ No. 4.—Appeal to Law Officer . . .	246	£3
„ No. 5.—Application for extension of Time under Rule 16 . . .	247	£2, £4, or £6
„ No. 6.—Application for extension of Time for leaving Complete Specification . . .	248	£2
„ No. 7.—Application for extension of Time for acceptance of Complete Specification . . .	249	£2, £4, or £6
„ No. 8.—Opposition to grant of Patent . . .	250	10s.
„ No. 9.—Notice that Hearing will be attended . . .	251	£1 or £2
„ No. 10.—Notice of Desire to have Patent sealed . . .	252	£1
„ No. 11.—Application for extension of Time for sealing of Patent, where period allowed for sealing of Patent will expire after commencement of Act . . .	253	£2, £4, or £6
„ No. 12.—Application where period allowed for the Sealing of the Patent has expired before the commencement of the Act . . .	254	£10
„ No. 13.—Application for Certificate of Payment or Renewal . . .	255	£5 to £14
„ No. 14.—Application for Enlargement of Time for Payment of Renewal Fee . . .	256	£1, £3, or £5
„ No. 15.—Application for Restoration of a lapsed Patent . . .	257	£20
„ No. 16.—Notice of opposition to an application for restoration of a lapsed Patent . . .	258	£1
„ No. 17.—Application to amend Specification . . .	259	£1 10s. or £3
„ No. 18.—Opposition to Amendment of Specification . . .	260	10s.
„ No. 19.—Application for Grant of Compulsory License or Revocation of Patent . . .	261	£1

Forms.	Page.	Corresponding Fee.
Patents Form No. 20.—Petition for Grant of Compulsory License or Revocation of Patent	262	—
„ No. 21.—Opposition to Petition for Grant of Compulsory License or Revocation of Patent	263	£1
„ No. 22.—Application to the Comptroller for an Order for the Revocation of a Patent under Section 26 of the Act	264	£2
„ No. 23.—Offer to Surrender a Patent	265	£1
„ No. 24.—Application for Revocation of a Patent under Section 27 of the Act	266	£2
„ No. 25.—Notice of Alteration of Name or Address or Address for Service in Register	267	5s.
„ No. 26.—Request to enter two Addresses for Service in Register	268	5s.
„ No. 27.—Request to enter Name upon the Register of Patents	269	10s.
„ No. 28.—Request to enter Notice of Interest in the Register	270	10s.
„ No. 29.—Request to enter Notification of Document in Register	271	10s.
„ No. 30.—Request for Correction of Clerical Error	272	5s. or £1
„ No. 31.—Request for Certificate of Comptroller	273	5s.
„ No. 32.—Application for Duplicate of Patent	274	£2
„ No. 33.—Notice of Intended Exhibition of Unpatented Invention	275	10s.
„ No. 34.—Application for Entry of Order of Court	276	10s.
„ No. 35.—On postal request for printed Specification	277	8d.

PATENTS FORM No. 1.

PATENT.
£1.

PATENTS AND DESIGNS ACT, 1907.

(To be accompanied by two copies of Patents Form No. 2 or of
Patents Form No. 3.)

APPLICATION FOR PATENT.

(a) Here insert
(in full) name,
address and
calling of ap-
plicant or
applicants.

(a) I (or we) _____

_____ do hereby

declare that I am (or we are) in possession of an invention the title of

(b) Here insert
title of inven-
tion.

which is (b) _____

(c) In the case
of more than
one applicant,
state here who
is or are the
inventor or in-
ventors.

that (c) _____

claim to be the true and first inventor thereof; and that the
same is not in use by any other person or persons to the best of my
(or our) knowledge and belief; and I (or we) humbly pray that a
Patent may be granted to me (or us) for the said invention.

Dated the _____ day of _____, 19 _____

(d) To be
signed by ap-
plicant or
applicants.
In the case of
a Firm, each
member of the
Firm must sign.

(d) _____

NOTE.—One of the two forms on the back hereof or a separate
authorization of agent should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(1.) *Where application is made through an Agent (Rule 9).*

I (or we) hereby appoint _____
 of _____
 to act as my (or our) Agent in respect of the within application for a
 Patent, and request that all notices, requisitions, and communications
 relating thereto may be sent to such Agent at the above address.

Dated the _____ day of _____, 19 _____

* To be signed
 by applicant or
 applicants.

* _____

(2.) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and com-
 munications in respect of the within application may be sent to
 _____ at _____

Dated the _____ day of _____, 19 _____

† To be signed
 by applicant or
 applicants.

† _____

PATENTS FORM NO. 1A.

PATENTS AND DESIGNS ACT, 1907.

(To be accompanied by two copies of *Patents Form No. 2* or of
Patents Form No. 3.)

PATENT.
£1.

**APPLICATION FOR PATENT FOR INVENTION
COMMUNICATED FROM ABROAD.**

(a) Here insert
(in full) name,
address, and
calling of
applicant or
applicants.

(a) I (or we) _____
of _____
_____ do hereby declare that I
am (or we are) in possession of an invention the title of which is

(b) Here insert
title of inven-
tion.

(b) _____

(c) Here insert
name, address,
and calling of
communicator.

which invention has been communicated to me (or us) by (c) _____

that I (or we) claim to be the true and first inventor thereof; and
that the same is not in use within the United Kingdom of Great
Britain and Ireland and the Isle of Man by any other person or
persons to the best of my (or our) knowledge and belief; and I
(or we) humbly pray that a Patent may be granted to me (or us) for
the said invention.

Dated the _____ day of _____, 19 _____

(d) To be
signed by ap-
plicant or
applicants.

(d) _____

NOTE.—One of the two forms on the back hereof or a separate
authorization of agent should be signed by the applicant or applicants.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(1.) *Where application is made through an Agent (Rule 9).*

I (or we) hereby appoint _____
 of _____

to act as my (or our) Agent in respect of the within application for
 a Patent, and request that all notices, requisitions, and communications
 relating thereto may be sent to such Agent at the above address.

Dated the _____ day of _____, 19 _____

* To be signed
 by applicant or
 applicants.

* _____

(2.) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and com-
 munications in respect of the within application may be sent to
 _____ at _____

Dated the _____ day of _____, 19 _____

† To be signed
 by applicant or
 applicants.

† _____

PATENT.
£1.

PATENTS FORM NO. 1B.

PATENTS AND DESIGNS ACT, 1907.

(To be accompanied by two copies of Patents Form No. 3.)

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(a) Here insert
(*in full*) name,
address, and
calling of
applicant or
applicants.

(a) I (or we)

(b) Here insert
title of inven-
tion.

do hereby declare that I (or we) have made applications for protection of my (or our) invention of (b)

(c) Here insert
the name of
each Foreign
State, followed
by the official
date of the
application in
each respec-
tively.

in the following Foreign States and on the following official dates,
viz.: (c)

(d) Here insert
the name of
each British
Possession, fol-
lowed by the
official date of
the application
in each respec-
tively.

and in the following British Possessions and on the following official dates, viz.: (d)

(e) Here insert
the official date
of the earliest
foreign appli-
cation.

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (e)

(f) Here insert
the official date
of the earliest
foreign appli-
cation.

to the best of my (or our) knowledge, information, and belief, and I (or we) humbly pray that a patent may be granted to me (or us) for the said invention in priority to other applicants, and that such patent shall have the date (f)

(g) Signature
of applicant or
of each of
applicants.

(g) _____

NOTE.—One of the two Forms on the back hereof or a separate authorization of agent should be signed by the applicant or applicants.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(1.) *Where application is made through an Agent (Rule 9).*

I (or we) hereby appoint _____
of _____

to act as my (or our) Agent in respect of the within application for
a Patent, and request that all notices, requisitions, and communications
relating thereto may be sent to such Agent at the above address.

Dated the _____ day of _____, 19 _____

* To be signed
by applicant or
applicants.

* _____

(2.) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and com-
munications in respect of the within application may be sent to

_____ at _____

Dated the _____ day of _____, 19 _____

† To be signed
by applicant or
applicants.

† _____

PATENTS FORM NO. 1C.

PATENT.
£1.

PATENTS AND DESIGNS ACT, 1907.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3.)

APPLICATION FOR PATENT OF ADDITION.

(a) Here insert
(in full) name,
address, and
calling of appli-
cant or appli-
cants;

(a) I (or we), _____

_____, do hereby
declare that I am (or we are) in possession of an invention the title of
which is (b) _____

(b) Here insert
title of invention.

(c) In the case
of more than one
applicant, state
here who is or
are the inventor
or inventors.

that (c) _____ claim to be the
true and first inventor _____ thereof; that the same is not in use by any
other person or persons to the best of my (or our) knowledge and belief,
and that the said invention is an improvement in or modification of my
(or our) invention for which a patent was applied for on the _____,
and numbered _____, [for which I was the applicant _____] [of which
we were _____]

I am the patentee _____]; and I (or we) humbly pray that a patent
may be granted to me (or us) for the said invention, and request that
the term limited in such further patent for the duration thereof be the
same as that of the original patent, or so much of that term as is
unexpired.

Dated the _____ day of _____, 19 _____

(d) To be
signed by appli-
cant or appli-
cants. In the
case of a Firm,
each member of
the Firm must
sign.

(d) _____

NOTE.—One of the two forms on the back hereof, or a separate
authorization of agent, should be signed by the applicant or applicants.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(1) *Where application is made through an Agent (Rule 9).*

I (or we) hereby appoint _____

of _____

to act as my (or our) Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent _____ at the above address.

Dated the _____ day of _____, 19 _____

* To be signed
by applicant or
applicants.

* _____

(2) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to _____

_____ at _____

Dated the _____ day of _____, 19 _____

† To be signed
by applicant or
applicants.

† _____

PATENTS FORM NO. 1D.

PATENTS AND DESIGNS ACT, 1907.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3, and a certificate under Section 30 (3).)

APPLICATION FOR A SECRET PATENT.

(a) Here insert
(in full) name,
address, and call-
ing of applicant
or applicants.

(a) I (or we) _____

_____, do hereby

declare that I am (or we are) in possession of an invention, the title

(b) Here insert
title of invention.

of which is (b) _____

(c) In the case
of more than one
applicant, state
here who is or
are the inventor
or inventors.

that (c) _____

claim to be the true and first inventor _____ thereof; and that the same
is not in use by any other person or persons to the best of my (or our)
knowledge and belief; and I (or we) humbly pray that a secret patent
may be granted to me (or us) for the said invention.

Dated the _____ day of _____, 19 _____

(d) _____

(d) To be
signed by appli-
cant or appli-
cants. In the
case of a Firm,
each member of
the Firm must
sign.

NOTE.—One of the two forms on the back hereof, or a separate
authorization of agent, should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(1.) *Where application is made through an Agent (Rule 9).*

I (or we) hereby appoint _____
 of _____
 to act as my (or our) Agent in respect of the within application for a
 Patent, and request that all notices, requisitions, and communications
 relating thereto may be sent to such Agent _____ at the above address.

Dated the _____ day of _____, 19 _____

* To be signed
 by applicant or
 applicants.

* _____

(2.) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and com-
 munications in respect of the within application may be sent to
 _____ at _____

Dated the _____ day of _____, 19 _____

† To be signed
 by applicant or
 applicants.

† _____

PATENTS FORM NO. 2.

To be issued with Patents Forms Nos. 1, 1A, 1C, or 1D.

PATENTS AND DESIGNS ACT, 1907.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a) Here insert title verbally agreeing with that in the application form.

(a) _____

(b) Here insert (in full) name, address, and calling of applicant or applicants as in application form.

(b) (I or we) _____

(c) Here begin description of the nature of the invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of one inch and a half on the left-hand part of the paper. The specification and the duplicate thereof must be signed at the end, and dated (thus): "Dated the

do hereby declare the nature of this invention to be as follows :—(c)

day of
19."

PATENTS FORM No. 3.PATENTS AND DESIGNS ACT, 1907.

PATENT.

£3.

Where provisional specification or specifications have been left, quote No. or Nos., and date or dates.

No. _____
Date _____**COMPLETE SPECIFICATION.**

(To be furnished in Duplicate—one unstamped.)

(a) Here insert title verbally agreeing with that in the application form.

(a) _____

(b) Here insert (in full) name, address, and calling of applicant or applicants as in application form.

(b) I (or we) _____

(c) Here begin full description of invention. The continuation of the specification should be followed by the words: "Having now particularly described and ascertained the nature of my (or our) said

(c) _____

Invention, and in what manner the same is to be performed, I (or we) declare that what I (or we) claim is: "After which should be written the claim or claims numbered consecutively. The specification and the duplicate thereof must be signed at the end and dated (thus): "Dated the _____ day of _____, 19 ____."

NOTE.—In the preparation of the claim or claims careful attention should be paid to the terms of Rule 14 of the Patents Rules, 1908. Any unnecessary multiplicity of claims or prolixity of language should be avoided.

PATENTS FORM No. 4.

PATENTS AND DESIGNS ACT, 1907.

PATENT.
£3.

FORM OF APPEAL TO LAW OFFICER.

(a) Here insert
(*in full*) name
and address of
appellant or
appellants.

(a) I (or we) _____

hereby give notice of my (or our) intention to appeal to the Law Officer

(b) Here insert
"the decision"
or "that part of
the decision," as
the case may be.

from (b) _____

of the _____ of the _____ day of _____

(c) Here insert
"refused [or
allowed] applica-
tion for Patent,"
or "refused [or
allowed] applica-
tion for leave
to amend
Patent," or
otherwise, as
the case may be.

19_____, whereby he (c) _____

(d) Insert num-
ber and year.

No. (d) _____ of the year 1 _____ (d)

Signature _____

Date _____

NOTE.—This notice must be sent to the Comptroller-General at the Patent Office, London, W.C., and an unstamped copy of the same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

PATENTS FORM No. 5.

PATENT.
£2, £4 or £6.

PATENTS AND DESIGNS ACT, 1907.

FORM OF APPLICATION FOR EXTENSION OF TIME
FOR LEAVING COPY OR COPIES OF THE
FOREIGN SPECIFICATION OR SPECIFICATIONS,
DRAWINGS OR DOCUMENTS UNDER RULE 16.

I (or we) hereby apply for _____ month extension of time for
leaving copy or copies of the foreign specification or specifications,
drawings or documents under Rule 16 in respect of application
No. _____ of 1 _____

(a) To be
signed by appli-
cant or appli-
cants, or his or
their agents.

(a) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENT.
£2.

PATENTS FORM No. 6.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF APPLICATION FOR EXTENSION OF TIME
FOR LEAVING A COMPLETE SPECIFICATION.**

I (or we) hereby, in respect of application No. _____,
dated _____, apply for one month's extension of
time in which to leave a Complete Specification.

(a) To be
signed by appli-
cant or appli-
cants or his or
their agent.

(a) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 7.

PATENTS AND DESIGNS ACT, 1907.

PATENT.
£2, £4, or £6.

FORM OF APPLICATION FOR EXTENSION OF
TIME FOR ACCEPTANCE OF A COMPLETE
SPECIFICATION.

I (or we) hereby apply for _____ month _____ extension of time
for the acceptance of the Complete Specification upon application
No. _____ dated _____

(a) To be
signed by appli-
cant or appli-
cants, or his or
their agents.

(a) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 8.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

10s.

FORM OF OPPOSITION TO GRANT OF PATENT.

[To be accompanied by an unstamped copy.]

* Here state
(in full) name
and address.

*I (or we) _____

hereby give notice of my (or our) intention to oppose the grant of
Letters Patent upon application No. _____ of _____,
applied for by _____

† Here state
upon which of
the grounds of
opposition per-
mitted by sect.
11 of the Act the
grant is opposed.
Where the
ground or one
of the grounds
of opposition is
that the invention
has been claimed
in any complete
specification
which is or will
be of a prior date,
the number and
date of such prior
specification
should be stated.
Where the person
giving notice of
an opposition
does not desire
that the patent
should be refused,
but merely that
the specifica-
tion should be
amended by
disclaimer or
limitation, it is
desirable that
the notice of
opposition should
be accompanied
or supplemented
as soon as may
be by a written
statement to that

upon the ground † _____

My (or our) address for service in the United Kingdom is:—

† _____

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

effect indicating so far as can conveniently be done the general nature of the amendments desired, and the portions of the earlier specifications if any relied upon as necessitating such amendments.

† To be signed by opponent or opponents.

PATENTS FORM No. 9.

PATENT. £1 or £2.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF NOTICE THAT HEARING OF OPPOSITION
 BEFORE THE COMPTROLLER WILL BE
 ATTENDED.**

(a) Here insert
(in full) name
and address.

(a) I (or we) _____

hereby give notice that the hearing in reference to _____

_____ will be attended by myself (or ourselves)

or by some person on my (or our) behalf.

(b) Signature.

(b) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
 Chancery Lane, London, W.C.*

PATENTS FORM No. 10.

PATENT.
£1.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF NOTICE OF DESIRE TO HAVE PATENT
SEALED.**

(a) Here insert
name of appli-
cant or appli-
cants.

(a) I (or we) _____ desire to have a patent
sealed on my (or our) Application No. _____ of 19____, and I
(or we) hereby transmit the prescribed fee on sealing, and request
that the following may be entered on the Register as my (or our)
address for service :—

(b) Signature
of applicant or
applicants, or his
or their agent.

(b) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 11.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

£2, £4, or £6.

FORM OF APPLICATION FOR EXTENSION OF TIME
FOR THE SEALING OF A PATENT WHERE THE
PERIOD ALLOWED FOR THE SEALING OF THE
PATENT WILL EXPIRE AFTER THE COMMENCE-
MENT OF THE ACT.

I (or we) hereby apply for _____ months' extension of time for the
sealing of a patent upon application No. _____, dated _____.

The circumstances and grounds upon which this extension is applied
for are as follows (a):—

(a) The cir-
cumstances and
grounds must be
stated in detail.

(b) To be signed
by the applicant
or applicants, or
his or their agent.

(b) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 12.

PATENT.
£10.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF APPLICATION FOR EXTENSION OF TIME
FOR THE SEALING OF A PATENT WHERE THE
PERIOD ALLOWED FOR THE SEALING OF THE
PATENT HAS EXPIRED BEFORE THE COM-
MENCEMENT OF THE ACT.**

I (or we) hereby apply for an extension of time not exceeding three months after the commencement of the Act for the sealing of a patent upon application No. _____, dated _____.

The circumstances in and grounds upon which this extension is applied for are as follows (a):—

(a) The cir-
cumstances and
grounds must be
stated in detail.

(b) To be signed
by the applicant
or applicants, or
his or their agent.

(b) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 13.

[When stamped this Form must be sent at once to the Patent Office.]

PATENTS AND DESIGNS ACT, 1907.

PATENT.
£5 to £14.

APPLICATION FOR CERTIFICATE OF PAYMENT
OR RENEWAL.

I (or we) hereby transmit the fee prescribed for the continuation

* Here insert name of patentee. in force of * _____ Patent No. _____, of 1 _____ for a further period of _____

It is requested that the address for service of the patentee in the United Kingdom shall be :—

† Here insert name and full address to which Certificate is to be sent.

Name† _____

Address _____

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

[This part of the Form to be filled in at the Patent Office.]

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. _____ of 1 _____

This is to certify that _____ did this _____ day of _____ 19____, make the prescribed payment of £ _____ in respect of a period of _____ from _____ and that by virtue of such payment the rights of the patentee remain in force.*

* See sect. 17 of the Patents and Designs Act 1907.



The Patent Office, London.

PATENTS FORM No. 14.

PATENTS AND DESIGNS ACT, 1907.

PATENT.
£1, £3, or £5.

FORM OF APPLICATION FOR ENLARGEMENT OF
TIME FOR PAYMENT OF RENEWAL FEE.

I (or we) hereby apply for an enlargement of time for _____ month
in which to make the _____ payment of _____
upon my (or our) Patent, No. _____ of 1 .

(b) Here insert
name and full
address to which
receipt is to be
sent.

(b) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 15.

PATENT.
£20.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF APPLICATION FOR THE RESTORATION
OF A LAPSED PATENT UNDER SECTION 20 OF
THE ACT.**

I (or we) hereby apply for an Order of the Comptroller for the
restoration of the patent granted upon Application No. _____
dated _____

The circumstances which have led to the omission of the payment
of the fee of (a) _____ on or
before the (b) _____ are as follows :— (c) _____

(a) State
amount of fee.

(b) State last
day when fee
was due.

(c) The circum-
stances must be
stated in detail.

(d) To be signed
by the applicant
or applicants.

(d) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 16.

PATENT.
£1.

PATENTS AND DESIGNS ACT, 1907.

FORM OF NOTICE OF OPPOSITION TO AN APPLI-
CATION FOR THE RESTORATION OF A LAPSED
PATENT.

[To be accompanied by an unstamped copy.]

* Here state
(in full) name
and address of
opponent or
opponents.

* I (or we) _____

† Here state
reason of opposi-
tion.

hereby give notice of opposition to the application for restoration of
the patent granted upon Application No. _____, dated _____,
for the following reason :— † _____

My (or our) address for service in the United Kingdom is :—

† To be signed
by the opponent
or opponents.

† _____

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM NO. 17.

PATENTS AND DESIGNS ACT, 1907.

PATENT.
£1 10s. or £3.

FORM OF APPLICATION FOR AMENDMENT OF
SPECIFICATION OTHERWISE THAN UNDER
RULE 33.

* Here state
(in full) name
and address of
applicant or
patentee.

* I (or we) _____

seek leave to amend the specification of Letters Patent No. _____
of 1_____, as shown in red ink in the certified copy of the original
specification hereunto annexed.

† These words
are to be struck
out when Letters
Patent have not
been sealed.

† I (or we) declare that no action for infringement or proceedings
before the Court for the revocation of the Letters Patent in question
is pending.

‡ Here state
reasons for seek-
ing amendment;
and where the
applicant is not
the patentee,
state what in-
terest he pos-
sesses in the
Letters Patent.

My (or our) reasons for making this amendment are as follows ‡

My (or our) address for service in the United Kingdom is :—

§ To be signed
by applicant or
patentee.

§ _____

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

N.B.—No amendment is permissible that would make the invention
substantially larger or substantially different. See section 21 of the Act.

PATENTS FORM No. 18.

PATENT.

10s.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF OPPOSITION TO AMENDMENT OF
SPECIFICATION.**

[To be accompanied by an unstamped copy.]

* Here state
(in full) name
and address of
opponent or
opponents.

* I (or we) _____

hereby give notice of opposition to the proposed amendment of the
specification of Letters Patent No. _____ of 1 _____ for the following
reason: † _____

† Here state
reason of opposi-
tion.

My (or our) address for service in the United Kingdom is :—

† _____

† To be signed
by opponent or
opponents.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM No. 19.

PATENTS AND DESIGNS ACT, 1907.

PATENT. £1.

FORM OF APPLICATION FOR GRANT OF COMPULSORY LICENSE OR REVOCATION OF PATENT UNDER SECTION 24 OF THE ACT.

[To be accompanied by an unstamped copy.]

* Here state
(*in full*) name
and address of
applicant or
applicants.

* I (or we) _____

† Here state
name and address
of patentee, and
number and date
of his patent.

hereby request you to bring to the notice of the Board of Trade the
accompanying petition for the grant of a license to me (or us) by †

My (or our) address for service in the United Kingdom is :—

‡ To be signed
by applicant or
applicants.

‡ _____

NOTE.—The petition must clearly set forth the facts of the case,
and be accompanied by an examined copy thereof. See Patents
Form No. 20.

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 20.

PATENTS AND DESIGNS ACT, 1907.

**FORM OF PETITION FOR GRANT OF COMPULSORY
LICENSE OR REVOCATION OF PATENT.**

(a) Here insert
(*in full*) name,
address, and
calling.

To the BOARD OF TRADE.

(b) Here insert
title of invention.

THE PETITION of (a)

of

(c) Here state
fully the nature
of petitioner's
interest.

in the county of _____, being a person
interested in the matter of this petition as herein-after described :—

(d) Here state
fully in detail
the circum-
stances of the
case under sect.
24 of the Act,
and show that it
arises by reason
of the default
of the patentee, or
as the case may
be, of any other
person claiming
an interest in the
Patent as exclu-
sive licensee or
otherwise.

SH EWETH as follows :—

1. A patent dated _____
was duly granted to
for an invention of (b)

No.

2. The nature of my (or our) interest in the matter of this petition
is as follows :—(c)

3. (d)

The evidence (which I (or we) propose to leave at the Patent
Office) accompanying this petition is as follows :—(e)

Having regard to the circumstances above stated, the petitioner
alleges that the reasonable requirements of the public with respect to
the invention patented as above stated have not been satisfied.

Your petitioner therefore pray that an order may
be made granting to him (or them) a compulsory
license on the terms following, viz. :—(f)

or in the alternative that the said patent may be revoked.

(g) _____

(f) Here state
the terms as to
the amount of
royalties, secu-
rity for payment,
or otherwise,
upon which the
petitioner claims
to be entitled to
the relief in
question.

(g) Signature.

NOTE.—In pursuance of the requirements of Rule 69, the petitioner
must deliver to the patentee, and to any other person alleged to have
made default, copies of the petition and of the affidavits or statutory
declarations and other documentary evidence in support.

PATENTS FORM No. 21.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

£1.

**FORM OF OPPOSITION TO PETITION FOR GRANT
OF COMPULSORY LICENSE OR REVOCATION OF
PATENT UNDER SECTION 24.**

(a) Here state
(*in full*) name
and address of
opponent or
opponents.

(a) I (or we) _____

hereby give notice of opposition to the petition of _____

for the grant of a compulsory License under Patent No. _____ of
1 _____, or in the alternative, for the revocation of the said patent.

The grounds upon which I (or we) oppose the said application are
as follows, viz. :— (b)

(b) Here state
fully the grounds
of opposition.

My (or our) address for service in the United Kingdom is :—

(c) To be signed
by the opponent
or opponents.

(c) _____

NOTE.—In pursuance of the requirements of Rule 70, copies of the affidavits or statutory declarations in reply to the evidence left with the petition must be delivered to the petitioner.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM No. 22.

PATENTS AND DESIGNS ACT, 1907.

PATENT F.

£2.

FORM OF APPLICATION TO THE COMPTROLLER
FOR AN ORDER FOR THE REVOCATION OF A
PATENT UNDER SECTION 26 OF THE ACT.

* Here state
(*in full*) name
and address of
applicant or
applicants for
revocation.

* I (or we) _____

hereby apply for an Order for the revocation of the patent granted
upon Application No. _____, dated _____,

† The ground
or grounds of an
application for
revocation under
sect. 26 of the
Act must be any
one or more of
the grounds on
which the grant
of the patent
might have been
opposed. Where
the ground or one
of the grounds of
opposition is that
the invention has
been claimed in
any complete
specification
which is or will
be of a prior date,
the number and
date of such
prior specifica-
tion should be
stated.

on the following grounds: † _____

No action ‡ for infringement or proceedings for the revocation of
the patent are pending.

My (or our) address for service in the United Kingdom is:—

‡ If such an
action is pending
in any Court, the
application can-
not be made
without the leave
of the Court.

§ _____

§ To be signed
by the applicant
or applicants for
revocation.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM No. 23.

PATENT.

£1.

PATENTS AND DESIGNS ACT, 1907.

FORM OF OFFER TO SURRENDER A PATENT
UNDER SECTION 26 OF THE ACT.

* Here state
(*in full*) name
and address of
patentee or
patentees.

* I (or we) _____

hereby offer to surrender the patent granted upon Application No. _____

dated _____

† If any action
or proceedings
are pending,
state what is
their nature.

No action ‡ for infringement or proceedings for the revocation of
the patent are pending.

My (or our) reasons for making this offer are as follows: _____

My (or our) address for service in the United Kingdom is: _____

† To be signed
by the patentee
or patentees.

† _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 24.

PATENT.

£2.

PATENTS AND DESIGNS ACT, 1907.

FORM OF APPLICATION FOR REVOCATION OF A
PATENT UNDER SECTION 27 OF THE ACT.

* Here state
(*in full*) name
and address of
applicant or
applicants for
revocation.

I (or we) * _____

hereby apply for the revocation of Letters Patent No. _____ of 1 _____,
on the ground that the patented article (or process) is manufactured
[or carried on] exclusively or mainly outside the United Kingdom.

My (or our) address for service in the United Kingdom is: _____

† To be signed
by applicant or
applicants for
revocation.

† _____

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 25.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

5s.

**FORM OF NOTICE FOR ALTERATION OF A NAME
OR AN ADDRESS OR AN ADDRESS FOR SERVICE
IN REGISTER OF PATENTS.**

In the matter of Patent No. _____

of _____

(a) Here state
(in full) name
or names and
address of appli-
cant or appli-
cants.

(a) I (or we) _____

hereby request that _____ name, address [or _____ address for
service] now upon the Register of Patents may be altered to (b)

(b) Here insert
name or full
address.

(c) Signature of
applicant or
applicants.

(c) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 26.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

5s.

**FORM OF REQUEST FOR ENTRY OF TWO
ADDRESSES FOR SERVICE IN REGISTER OF
PATENTS.**

In the matter of Patent No. _____

of _____

(a) Here state
(in full) name
or names and
address of appli-
cant or appli-
cants.

(a) I (or we) _____

hereby request that the two following addresses for service may be
entered in the Register of Patents:—

(b) Here insert
full addresses.

(b) (1) _____

(2) _____

(c) Signature of
applicant or
applicants.

(c) _____

*To the Comptroller,**The Patent Office, 25, Southampton Buildings,**Chancery Lane, London, W.C.*

PATENTS FORM No. 27.

PATENT.

10s.

PATENTS AND DESIGNS ACT, 1907.

FORM OF REQUEST TO ENTER NAME OF PROPRIETOR UPON THE REGISTER OF PATENTS.

(a) Here insert
(*in full*) name,
address, and
calling.

(a) I (or we) _____

hereby request that you will enter my (or our) name (or names) in
the Register of Patents as proprietor of Patent No. _____ of 1 _____

(b) Here give
name and address
of person to
whom Patent
was granted.

granted to (b) _____

(c) Here insert
title of the in-
vention.

the title of which is (c) _____

(d) Here specify
the particulars of
such document,
giving its date,
and the parties
to the same, and
showing how the
claim here made
is substantiated.

I (or we) claim to be so entitled by virtue of (d) _____

(e) Here insert
the nature of the
document.

And in proof whereof I (or we) transmit the accompanying (e) _____

_____ with an attested copy thereof.

My (or our) address for service in the United Kingdom is:—

(f) Signature.

(f) _____

(g) Here state
in what capacity
the signatory is
acting.

(g) _____

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM No. 28.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

10s.

**FORM OF REQUEST TO ENTER IN THE REGISTER
OF PATENTS A NOTICE OF AN INTEREST IN
A PATENT.**

(a) Here insert
(in full) name,
address, and
calling.

(a) I (or we) _____

hereby request that you will enter in the Register of Patents a notice
of the following interest in a patent :—

(b) Here insert
the nature of the
claim, whether
by way of Mort-
gage License or
otherwise.

I (or we) claim to be entitled (b) _____
_____ to an interest in

(c) Here give
name and address
of person to
whom Patent
was granted.

Patent No. _____ of 1 _____, granted to (c) _____

(d) Here insert
title of the in-
vention.

the title of which is (d) _____

(e) Here specify
the particulars
of such docu-
ment, giving its
date and the
parties to the
same, and show-
ing how the
claim here made
is substantiated.

by virtue of (e) _____

(f) Here insert
the nature of the
document.

And in proof whereof I (or we) transmit the accompanying (f) _____
_____ with an attested copy thereof.

My (or our) address for service in the United Kingdom is :—

(g) Signature.

(g) _____

(h) Here state
in what capacity
the signatory is
acting.

(h) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM NO. 29.

PATENT.

10s.

PATENTS AND DESIGNS ACT, 1907.

FORM OF REQUEST TO ENTER NOTIFICATION OF
DOCUMENT IN THE REGISTER OF PATENTS.

(a) Here insert
a description of
the nature of the
document, giving
its date and the
names and ad-
dresses of the
parties thereto.

I (or we) HEREBY transmit an attested copy of (a) _____

under Patent No. _____ of 1 _____, as well as the original document
for verification, and I (or we) have to request that a notification thereof
may be entered in the Register.

(b) Signature.

(b) _____

(c) Here insert
full address of
party benefiting
under the docu-
ment.

(c) _____

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 30.

PATENT.
5s. or £1.

PATENTS AND DESIGNS ACT, 1907.

FORM OF REQUEST FOR CORRECTION OF
CLERICAL ERROR.

(a) or errors.

I (or we) hereby request that the following clerical error (a)

(b) Here state
whether in
application,
specification,
or register.

in the (b)

No. _____ of 1 _____, may be corrected in the manner shown in red

ink in the certified copy of the original (b)

hereunto annexed.

(c) Signature.

(c)

(d) Address in
full.

(d)

*To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 31.

PATENT.

5s.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR CERTIFICATE OF COMPTROLLER.

In the matter of the Patent No. _____

of 1 _____

I (or we) _____

of _____

hereby request you to furnish me (or us) with your Certificate to the

effect that (a) _____

(a) Here set out the particulars which the Comptroller is requested to certify.

(b) _____

(b) Name and full address to which Certificate is to be sent.

Dated the _____ day of _____ 19____.

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

R.P.

PATENTS FORM No. 32.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

£2.

APPLICATION FOR DUPLICATE OF PATENT.

Date

* Here insert
date, number,
full name, and
address of
grantee or
grantees.

I (or we) REGRET to have to inform you that the Patent dated *

No.

granted to

† Here insert for an invention the title of which is †
title of invention.

‡ Here insert has been ‡
the word "de-
stroyed" or
"lost," as the
case may be, and
state, in full, the
circumstances of
the case, which
must be verified
by statutory
declaration.

§ Here state
interest pos-
sessed by appli-
cant or appli-
cants in the
Patent.

I (or we) beg therefore to apply for the issue of a duplicate of such
Patent. §

|| Signature of
patentee or
patentees.

|| _____

To the Comptroller,

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS FORM No. 33.

PATENTS AND DESIGNS ACT, 1907.

PATENT.

10s.

 NOTICE OF INTENDED EXHIBITION OF AN
 UNPATENTED INVENTION.

* Here state
 (in full) name
 and address of
 applicant or
 applicants.

* I (or we) _____

 hereby give notice of my (or our) intention to exhibit a _____
 of _____ at the _____

† State
 "opened" or
 "is to open."

 Exhibition, which † _____ on the _____ day of
 _____, 19_____, under the provisions of the Patents and
 Designs Act, 1907.

‡ This descrip-
 tion of invention
 should be accom-
 panied by draw-
 ings if necessary.

 ‡ I (or we) herewith enclose a brief description of my (or our)
 invention _____

§ To be signed
 by the applicant
 or applicants.

§ _____

To the Comptroller,
 The Patent Office, 25, Southampton Buildings,
 Chancery Lane, London, W.C.

PATENTS FORM No. 34.

PATENT.

10s.

PATENTS AND DESIGNS ACT, 1907.

FORM OF APPLICATION FOR ENTRY OF ORDER
OF COURT IN REGISTER.

(a) Here state
(*in full*) name
and address of
applicant or
applicants.

(a) I (or we) _____

hereby transmit an office copy of an Order of the Court with reference

(b) Here state
the purport of
the order.

to (b) _____

(c) Signature.

(c) _____

To the Comptroller,

*The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS FORM No. 35.

PATENTS AND DESIGNS ACT, 1907.

POSTAL REQUEST FOR PRINTED SPECIFICATION.

To the Comptroller.

Please send one copy of Specification, No. _____ Year _____

to

(Name in full) _____

(Address) _____

PATENTS,
7½d.

½d.

*The Comptroller,**The Patent Office,**25, Southampton Buildings,**London, W.C.*

FORM A.

THE THIRD SCHEDULE.

FORM OF PATENT.

EDWARD VII, by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India : To all to whom these presents shall come greeting :

WHEREAS
hath declared that he is in possession of an invention for

that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief :

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention :

And whereas the said inventor (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention :

And whereas We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request :

Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these

presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned :

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us and the same may be revoked and made void accordingly : Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided ; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained : Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted : And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be
made patent and to be sealed as of the
one thousand nine hundred
and

* Here is to
be inserted the
name of the
Comptroller-
General.

*

*Comptroller-General of Patents, Designs,
and Trade Marks.*



FORM B.

FORM OF PATENT OF ADDITION.

EDWARD VII., by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India : To all to whom these presents shall come greeting :

WHEREAS
hath declared that he is in possession of an invention for

that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief, and that the said invention is an improvement in or modification of his invention for which a patent was applied for on and numbered and on which a patent (hereinafter called the original patent) has been granted for which he was the applicant (or of which he is the patentee).

AND WHEREAS the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention :

AND WHEREAS the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention, and has requested that the term limited in such patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

AND WHEREAS We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request :

KNOW YE, THEREFORE, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the day being the date of the said original patent No. , or so much of that term as is unexpired. AND to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned :

PROVIDED ALWAYS that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us, and the same may be revoked and made void accordingly : PROVIDED ALSO, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of the said original letters patent, or in respect of any matter relating

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the Chief Clerk, Law Officers' Department, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Chief Clerk, Law Officers' Department, all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the Chief Clerk, Law Officers' Department, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall

direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 40 of the Act.

XIII. All documentary evidence required or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Law Officers' Department.

XIV. Any notice or other document required to be given to the Chief Clerk, Law Officers' Department, under these Rules, may be sent by a prepaid letter through the post.

John L. Walton,
Attorney General.

W. S. Robson,
Solicitor General.

Law Officers' Department,
11th December, 1907.

Published in *Official Journal*, May 12, 1909.]

OFFICIAL NOTICE.

PATENTS AND DESIGNS ACT, 1907.

PROCEDURE UNDER SECTION 27 AND PATENTS RULES 78 TO 81.

In all cases of applications for revocation under Section 27 the following procedure will in future be adopted :—

(1) The applicant should simultaneously with his application on Patents Form 24 leave at the Office evidence by way of Statutory Declaration, stating the particulars upon which he relies in support of the allegations contained in the application ; the copy of the application delivered to the patentee or his

agent, in accordance with Patents Rule 78, should be accompanied with copies of such evidence.

(2) The Patentee should, within fourteen days from the delivery of such copy or within such further time as the Comptroller may allow, leave at the Office evidence by way of Statutory Declaration stating whether or not the allegations contained in the application are correct; and if they are incorrect giving the particulars upon which he intends to rely in answer to the allegations made by the applicant. Copies of such evidence should at the same time be delivered to the applicant.

(3) Should the applicant then decide to proceed with his application, he may then leave and deliver further Statutory Declarations in answer, in accordance with the provisions of the latter part of Rule 79.

(4) The Comptroller will then intimate to the parties whether, having regard to the circumstances of the case, he considers it desirable and intends to hold a preliminary hearing on the question whether a *prima facie* case has been made in support of the allegations in the application or whether he intends in ordinary course to deal at one hearing with the whole case, including the further questions whether the patentee can prove that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom or can give satisfactory reasons why the article or process is not so manufactured or carried on.

(5) Should the Comptroller think fit to hold a preliminary hearing as aforesaid, and as a result of such hearing decide that a *prima facie* case has been made in support of the allegations in the application, or should he determine to proceed in ordinary course to deal at one hearing with the whole case including the further questions mentioned in Head (4), then, and in either of the said cases, he will give to the patentee further time for leaving at the Office and delivering to the applicant pursuant to Rule 79 evidence by way of Statutory Declaration with regard to such further questions or either of them and will subsequently give to the applicant under Rule 79, and thereafter if necessary to the patentee under Rule 80 further time for leaving further evidence by way of Statutory Declaration with regard to such questions or either of them in answer or reply as the case may be.

(6) In the event of an application under Section 27 being uncontested by the patentee, the Comptroller in deciding whether costs should be awarded to the applicant will consider whether proceedings under the Section might have been avoided, if reasonable notice had been given by the applicant to the patentee before the application was filed.*

W. TEMPLE FRANKS,
Comptroller-General.

NOTE.—The above procedure, with the necessary modifications, will apply to applications under Section 58.

PATENTS AND DESIGNS ACT, 1907.

PROCEDURE UNDER SECTION 7.

In the earlier working of the Patents Act it was thought convenient not to insist too stringently upon a strict observance of Patents Rules 30 and 31. It has been found, however, in practice that this has occasioned increasing work to the Patent Office by the multiplication of correspondence, and other communications, and has tended to delay the progress of cases.

As a consequence, it has been found impossible to cope with the extra work entailed under the present procedure, and, in carrying out the Rules, the following Office practice will therefore in future be adopted on and after December 1st.

(1) Rule 30 must be complied with, but where good cause is shown, time will be allowed,—*e.g.* when the applicant is abroad or the complexity of the case requires it.

(2) The interviews and correspondence between Examiner and applicant will be restricted as far as possible to the absolute necessities of the case and will aim at bringing to a clear issue at the *earliest possible date* the differences between the applicant and the Examiner. A time limit will be imposed wherever practicable in accordance with the circumstances and complexity of the case.

(3) No hearing will be appointed unless there is a direct issue between the Examiner and the applicant, or unless the

* These rules are not to be found in the Comptroller's report for 1909 or 1910: see Section 76.

applicant fails to submit amendments or make a real endeavour to avoid the citations within the time limited. When the issues are defined or when agreement is clearly impossible, notice of a hearing for a future date will at once be given.

(4) If the applicant desires any amendments to be considered at the hearing, other than those which he has submitted to the Examiner under Rule 30, such amendments should be submitted seven days at least before the date of the hearing.

(5) At the hearing, whether attended or not by the applicant, the Comptroller may, as an alternative to the insertion of references, prescribe amendments which will be to his satisfaction under Section 7 sub-section (4), and in such case the applicant must elect within such time as may be fixed by the Comptroller whether he agrees to the prescribed amendments or to the insertion of a reference. If no communication is received within the time prescribed, the references will be inserted. In cases requiring special treatment a limited time may be allowed for the precise form of amendment to be settled, and the hearing adjourned, if necessary.

(6) As far as possible all questions between Examiner and applicant will be decided at the hearing and except as indicated herein, no further opportunity of amendment will be allowed to the applicant and the specification will only be accepted with the amendments or reference prescribed in the Comptroller's decision.

(7) If after the decision has been given or the applicant has made his election under Paragraph 5 the applicant desires to amend he must make a special application for that purpose to the Comptroller and for this purpose Form 17, having a 30/- stamp may be used. If the amendments suggested are satisfactory to the Comptroller a statutory reference may be removed.

Dated this 16th day of November, 1909.

W. TEMPLE FRANKS.

Comptroller-General.

PATENTS AND DESIGNS ACT, 1907.

AMENDMENT OF SPECIFICATIONS TO MEET OBJECTIONS BY
THE EXAMINER.

On and after January 1st next, in order that the progress of amendment of a Specification may be more clearly ascertained the following procedure should be followed in filing amended Specifications:—

(1) In all cases in which any page of a Specification is amended and is re-written, the cancelled page should be returned to the office amended so as clearly to show the alteration or addition embodied in the re-written page. Such amendment should be initialled and dated by the Applicant or his Agent on the returned cancelled page. If the whole or a greater part of the page is re-cast, and it is impracticable to indicate the amendments in detail, this should be stated on the returned cancelled page and the substituted passage should be clearly indicated by reference to page and lines of the amended copy.

(2) Where a new page is added to the Specification, which contains additional matter not shown on an omitted page as amended, a duplicate of the new page should be furnished.

(3) Where any page of the Specification is amended without being omitted or cancelled a covering letter should be sent drawing attention to the amendment made.

W. TEMPLE FRANKS,
Comptroller-General.

[Extract from Illustrated Official Journal (Patents) of
21st December, 1910.]

PATENT OFFICE, SALE BRANCH.

25, SOUTHAMPTON BUILDINGS, CHANCERY LANE, LONDON, W.C.

Specifications of Patents, &c.

Searches (other than those made in pursuance of the Act) cannot be undertaken by the Patent Office.

In Ordering Specifications, the *number* and *year* of the Patent must be given. These particulars can be obtained by searching the Indexes of Patents, or (for recent Specifications) the Illustrated Official Journal.

Date of Printing Specifications.—Specifications are printed fifteen days after the advertisement of the acceptance of the complete Specification, which may take place at any time within twelve (or, with extra fee, fifteen) months after the date of application. The acceptance and publication of the printed Specification are notified in the Illustrated Official Journal (Patents).

Public Inspection of Documents.—The provisional Specification (if any) and the complete Specification are not open to public inspection, for searches or for copying, until after the acceptance of the complete Specification, except in the case of an application made under the International or Colonial arrangements, where the complete Specification, if not already accepted, becomes open to public inspection at the end of 12 months from the date of the first foreign application. The Specifications of abandoned or void applications (except in the case of void applications under the International or Colonial arrangements) are not printed or open to inspection.

Uniform Price.—Specifications are sold at the uniform price of 8d., which includes postage to places within the United Kingdom. The postage to foreign countries is usually $\frac{1}{2}$ d. per Specification.

Reprinting Specifications.—Subject to the approval of the Comptroller-General the Specification of an expired patent, if out of print, will be reprinted upon prepayment by the purchaser of 4s., in return for which he will receive six copies.

Illustrated Official Journal (Patents).—Published every Wednesday, 6d., by post 8d. Annual subscription, including postage, £1 15s.; quarterly subscription, 8s. 9d.

Trade Marks Journal.—Published every Wednesday, 6d., by post 8d. Annual subscription, including postage, £1 15s.; quarterly subscription, 8s. 9d.

1876–1887. Nos. 1 to 509. 1s. each number.

1888. Nos. 510 to 561. 1s. 6d. each number.

1889 onwards. Nos. 562 to date. 6d. each number, by post 8d.

Abridgments of Specifications in Classes.—The volumes of illustrated abridgments arranged in classes are now complete for the fifty years 1855 to 1904, in eight different series, each containing 146 volumes. The price of each volume is 1s., including inland postage; the complete set of volumes relating to any class can be purchased, price 8s.

Postal Arrangements.—Specifications and other publications will be forwarded by post on receipt of the price and postage (if any is charged). *Sums of 1s. and above should be remitted by Postal or Post Office Order*, payable to the Comptroller-General. Postage stamps sent in payment of any amount exceeding 11d. will be returned. Deposit accounts may be opened, the minimum deposit being £2.

Return of Publications.—Unless a wrong number has been supplied through an error on the part of the Patent Office, Specifications or other publications cannot be exchanged.

Instructions to Applicants for Patents will be supplied gratis on application. They contain full information as to the mode of procedure to obtain patents in the United Kingdom, a list of Institutions receiving Specifications, Abridgments, Journals, Indexes, &c., and a list of publications. Instructions to persons who wish to register trade marks and designs will also be supplied gratis on application.

STATUTORY RULES AND ORDERS, 1907.

No. 951.

PATENTS.

THE REGISTER OF PATENT AGENTS RULES, 1908. DATED
DECEMBER 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as the Act, the Board of Trade, hereinafter referred to as the "Board," do hereby make the following Rules:—

1. These Rules may be cited as the Register of Patent Agents Rules, 1908.

2. A Register of Patent Agents shall be kept by the Chartered Institute of Patent Agents (hereinafter called the Institute), subject to the provisions of these Rules and to the Orders of the Board, for the registration of patent agents in pursuance of Section 84 of the Act. The Register of Patent Agents existing at the commencement of the Act shall be incorporated with and form part of the Register of Patent Agents under the Act. Register to be kept.

3. The Register shall contain in one list all patent agents who are registered under the Act and these Rules. Contents of Register.

Such list shall be made out according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the Council of the Institute may consider worthy of mention in the Register. The Register shall be in the Form 1 in Appendix A, with such variations as may be required.

4. The Institute shall cause a correct copy of the Register, but with the names arranged alphabetically, to be printed under their direction and published and placed on sale. Such correct copy shall be printed and published not later than the Printed copies to be published annually, and to be evidence of contents of Register.

end of February in each year. A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act or any Act repealed by the Act.

Registrar.

5. The Institute shall continue in office or appoint a Registrar, who shall keep the Register in accordance with the provisions of the Act and these Rules, and, subject thereto, shall act under the directions of the Institute, and the Board.

Registration of persons who were patent agents prior to the passing of this Act.

6. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the 24th day of December, 1888, he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board a statutory declaration in the Form 2 in Appendix A; provided that the Board may, in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration, or of such further or other proof to their satisfaction, as the case may be, the Board shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

Final qualifying examination for registration.

7. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board that prior to the 24th day of December, 1888, he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants from preliminary examination.

8. Any person who has been for at least five years engaged as a pupil or technical assistant to one or more registered patent agents, and any person for the time being entitled to practice as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered

without passing any examination other than the final examination provided for in the last preceding Rule.

9. Any person who is not qualified under Rule 8 must, in order to be entitled to present himself for the final qualifying examination, be—

Qualifications of persons generally for registration.

A person who has passed one of the preliminary examinations which the Institute shall by regulation prescribe.

10. The Institute shall hold at least once in every year, a final qualifying examination, which shall be the final qualifying examination required under Rules 7 and 8; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say,

Final qualifying examinations to be held by the Institute.

(a) The subjects for and the mode of conducting the examination of candidates;

(b) The times and places of the examinations, and the notices to be given of examinations;

(c) The certificates to be given to persons of their having passed the examinations;

(d) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(e) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

11. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name and address of any person registered.

Corrections of names and addresses in Register.

12. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of deceased persons.

13. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months,

Erasure of names of persons who have ceased to practise.

send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purpose of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of
name for
non-payment
of fees.

14. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: Provided that the name of a person erased from the Register under this rule may be restored to the Register by direction of the Institute or the Board on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board (as the case may be) may in each particular case direct.

Registrar
to act on
evidence.

15. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of
incorrect or
fraudulent
entries.

16. The Board may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of
names of
persons con-
victed of
crimes, and
persons found
guilty of
disgraceful
conduct.

17. If any registered person shall be convicted in His Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanour, or after due inquiry, is proved to the satisfaction of the Board to have been guilty of disgraceful professional conduct, or having been entitled to practice as a Solicitor or Law Agent shall have ceased to be so entitled, the Board may order the Registrar to erase from the Register the name of such person. Provided that no person shall be adjudged by the Board to have been guilty of disgraceful professional conduct unless such

person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

18. Where the Board direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board.

Restoration
by Board of
erased name.

The Board may in any case in which they think fit restore to the Register such name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board may from time to time fix, and the Registrar shall restore the name accordingly.

19. For the purpose of exercising in any case the powers of erasing from and of restoring to the Register the name of a person, or an entry, the Board may appoint a committee consisting of such persons as they shall think fit. Every application to the Board for the erasure from, or restoration to, the Register of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board.

Inquiry by
Board of
Trade before
erasure of
name from
Register.

20. The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

Restoration
by Institute
of erased
name.

21. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board.

Appeal to
Board of
Trade.

22. A person who intends to appeal to the Board under these Rules (in these Rules referred to as the appellant) shall, within 14 days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Notice of
appeal.

23. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Case on
appeal.

24. The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed

Transmission
of notice of
appeal to
Board of
Trade.

to the Secretary of the Board of Trade, 7, Whitehall Gardens, London.

Directions as to hearing appeal.

25. The Board may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

26. Seven days' notice, or such shorter notice as the Board may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Hearing and decision of appeal.

27. The appeal may be heard and decided by the Board, and such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Fees.

28. The fees set forth in Appendix B to these Rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board may from time to time alter any of, or add to, the fees payable under these Rules.

Alteration of regulations.

29. Any regulation made by the Institute under these Rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these Rules has come into force, the Board signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Report to Board of Trade.

30. The Institute shall once every year in the month of March transmit to the Board a report stating the number of applications for registration which have been made in the preceding twelve months, the nature and results of the final examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules as the Board may from time to time require.

Commencement.

31. These Rules shall come into operation from and immediately after the 31st December, 1907, and all general rules relative to the Register of Patent Agents in force on the 31st December, 1907, shall be and are hereby repealed as from that date without prejudice nevertheless to any thing done

under such Rules or to any application or other matter then pending.

Dated the 17th day of December, 1907.

D. Lloyd George,
President of the Board of Trade.

APPENDIX A.

FORM 1.

FORM OF REGISTER.

Name.	Designation.	Address.	Date of Registration.

FORM 2.

FORM OF STATUTORY DECLARATION.

PATENTS AND DESIGNS ACT, 1907.

Register of Patent Agents pursuant to Section 84.

I, *A.B.* [*insert full name, and in the case of a member of a firm add, "a member of the firm of "], of*
, in the county of *,* Patent Agent,
do solemnly and sincerely declare as follows:—

1. That prior to the 24th December, 1888, I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents:—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at

APPENDIX.

APPENDIX B.

FEES.

Nature of Fee.	When to be paid.	To whom to be paid.	Amount.
			£ s. d.
For registration of name of patent agent who had been bonâ fide in practice prior to the passing of the Act.	On application and before registration.	To the Registrar at the Institute.	5 5 0
For registration of name of any person other than as above.	Do. do.	Do. do.	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30th of each year, in respect of the year commencing January 1st following.	Do. do.	2 2 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do.	2 2 0

Dated the 17th day of December, 1907.

D. Lloyd George,
President of the Board of Trade.

FORM OF PROVISIONAL SPECIFICATION.

For the necessary form of the document, see page 244. This precedent and the next are only inserted by way of example, and can be altered to suit any particular case.

PROVISIONAL SPECIFICATION.

Improvements in *here state shortly the subject of the application.*

We, A. B. of , gentleman, C. D. of , chemist, E. F. of , engineer, and the X. Y. Syndicate, of , do hereby declare the nature of this invention to be as follows :—

This invention relates to here give a brief summary of the nature of the invention.

According to the present invention here describe the invention clearly, but not necessarily in detail.

The invention may be advantageously carried out as follows here describe a particular mode of construction. But note that this paragraph is completely unnecessary if the preceding paragraph is properly drafted.

Although the invention described is for , it may be employed for in this paragraph state any wider application of the invention not shown by what has preceded.

Dated this day of 19 .

Signature of the applicants or their authorised agent.

FORM OF COMPLETE SPECIFICATION.

For the necessary form of the document, see page 244. See note to previous form.

COMPLETE SPECIFICATION.

Improvements in *here state shortly the subject of the invention.*

I, P. Q. of , manufacturer, do hereby declare the nature of this invention, and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement :—

This invention relates here give a brief summary of the nature of the invention.

According to the present invention *here give a clear but general description of the invention and its possible modifications.*

The invention may be conveniently and advantageously carried into practice as follows *if there are drawings add the words "as shown in the accompanying drawings."* Then give a detailed description of the invention sufficient for a practical man to be able to carry out the invention therefrom; if there be drawings, first summarise them—e.g. in the accompanying drawings Fig. 1 is a plan, Fig. 2 is a section through the line ab—and then give the detailed description with reference to them.

Although the invention is for it may be employed for *here state any wider application not clear from what has preceded.*

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is :—

Here set out the particular claims in separate numbered paragraphs, being careful not to claim too much or too little, and remembering that one bad claim will make the whole grant bad.

Dated this day of 19 .

Signature of the applicant or his authorised agent.

Statements of the art, disclaimers or references are usually inserted either at the beginning of the paragraph of general description or at the end immediately before the claims.

In both the foregoing documents omit all matter not strictly necessary, and as far as possible all theories.

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